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WITH THE  
STATUTES, RULES, FORMS  
AND  
INTERNATIONAL CONVENTION.

BY  
HARRY KNOX, B.A. OXON.,  
*Of the Inner Temple, Barrister-at-Law,*

AND  
JESSE W. HIND, M.A. OXON.,  
*Solicitor of the Supreme Court.*

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To

SIR WILLIAM R. ANSON Bart., D.C.L., M.P.,

WARDEN OF ALL SOULS, OXFORD, AND

AFORETIME VICE-CHANCELLOR OF THE UNIVERSITY OF OXFORD,

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*Is (by permission) most respectfully Dedicated*

*BY THE AUTHORS.*



## PREFACE.

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IN bringing this Book before the public we have endeavoured to meet, so far as possible, the requirements of those who have not ready access to large libraries of reference; and with this object in view we have not contented ourselves with merely referring the reader to the cases which decide or illustrate the various principles of the Law of Designs, but have in many instances, and especially in the more important cases, set out the facts and quoted extensively from the judgments. We have also, in dealing with any doubtful points, discussed the cases and enactments bearing on that point and explained the conclusions which it appears to us should be drawn from them.

As many of the provisions of the Patents, Designs and Trade Marks Acts, 1883—1888, deal alike with Patents, Designs, and Trade Marks, Patent and Trade Mark Cases are referred to as authorities on all questions coming within the scope of those provisions, and also on all general points such as Practice, Costs, &c.; but otherwise we have confined ourselves as much as possible to the reported cases on Designs. For purposes of conciseness, only one reference is given in the text, and as practically all the cases relating to Designs since 1884 are to be found in the "Reports of Patent Cases," the

references in the text to cases since that date are usually made to those Reports ; but when cases are reported in other Reports the references to such Reports will be found in the List of Cases, which we have tried to make as complete as possible. In order to facilitate the turning up of references, in all cases where reference is intended to a particular passage in a reported case, the number of the particular page where the passage occurs is given, preceded by the letter "p"; in other cases the reference is given in the usual way.

Recognizing the fact that the Index is a very important part of a law book, we have given considerable attention to its compilation, and hope that it may prove a serviceable guide to the reader.

We also hope that the book may prove useful and intelligible to the large number of persons outside the legal profession to whom the Law of Designs is of practical interest.

HARRY KNOX.

JESSE W. HIND.

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# THE LAW OF COPYRIGHT IN DESIGNS.

## PART I. Law and Practice.

### CHAPTER I.

#### HISTORY OF THE LAW OF DESIGNS.

THERE were several enactments for the protection of new designs prior to the Patents, Designs, and Trade Marks Act, 1883, which is the principal Act now in force relating to designs. These earlier Acts are briefly set out in this chapter, but only the principal features of each are mentioned, as they are all now repealed by the Act of 1883. The Acts from 1842 to 1875 inclusive are still, however, of some importance, as many of their provisions were re-enacted, in some cases bodily, in others with slight modifications, by the Act of 1883, so that decisions under such of the provisions of these Acts as have been substantially re-enacted are still authorities of more or less weight. In construing the present Acts, moreover, it is often of great assistance to compare the language of these earlier Acts when dealing with the same points. These Acts are therefore set out in full in Appendix C.

A list is here given of the various statutes relating to designs:—

#### Repealed by Act of 1842—

1787. 27 Geo. 3, c. 38.  
1789. 29 Geo. 3, c. 19.  
1794. 31 Geo. 3, c. 23.  
1839. 2 & 3 Vict. c. 13.  
1839. 2 & 3 Vict. c. 17.

#### Repealed by Act of 1883—

1842. 5 & 6 Vict. c. 100.  
1843. 6 & 7 Vict. c. 65.  
1850. 13 & 14 Vict. c. 104.  
1858. 21 & 22 Vict. c. 70.  
1861. 24 & 25 Vict. c. 73.  
1865. 28 & 29 Vict. c. 3.  
1875. 38 & 39 Vict. c. 93.

#### STATUTES NOW IN FORCE.

1883. 46 & 47 Vict. c. 57.  
1885. 48 & 49 Vict. c. 63.

1886. 49 & 50 Vict. c. 37.  
1888. 51 & 52 Vict. c. 50.

The first statutory enactment dealing with designs and their protection was the Act 27 Geo. 3, c. 38. This enacted that any person who should invent, design, and print and become the proprietor of any new and original pattern for printing linens, cottons, calicoes, or muslins, should have the sole right of printing the same for two months from first publication, and that any other person knowingly printing, publishing, or selling the same within that period without the consent of the proprietor should be liable to an action for damages. This Act was only to continue in force for one year; but by an Act, 29 Geo. 3, c. 19, its operation was extended till July 1st, 1794. In that year the Act 34 Geo. 3, c. 23, was passed, by which the limit of two months was extended to three months, and, with that alteration, the Act of 27 Geo. 3, c. 38, was made perpetual. Then by an Act, 2 & 3 Viet. c. 13, the former Acts, which only applied to England and Scotland, were extended to Ireland, and their provisions were extended to fabrics composed of wool, silk, or hair, and to mixed fabrics composed of any two or more of the following materials:—linen, cotton, wool, silk, or hair.

Later in the same year another Act (2 & 3 Viet. c. 17) was passed which greatly extended the scope of the previous Acts. It enacted that every proprietor of a new and original design made for any of the following purposes should have the sole right to use the same for any such purpose for twelve months from the date of registration. The purposes were:—

- (a) For the pattern or print to be either worked into or worked on, or printed on or painted on, any article of manufacture being a tissue or textile fabric, except lace, and except linens, cottons, calicoes, muslins, and any other article within the protection of the four previous Acts mentioned above.
- (b) For the modelling, casting, embossment, chasing, engraving, or any other kind of impression or ornament on any article of manufacture not being a tissue or textile fabric.
- (c) For the shape or configuration of any article of manufacture, except lace, and except linens and the other articles excepted above in clause (a).

There was a proviso extending the time of protection to three years in the case of designs for modelling, &c. in metals.

Certain provisions were for the first time made as to registration, and the term "proprietor" was defined, the enactments on these points being very similar to those now in force. There were also provisions for the transfer of copyright, for the prevention and punishment of piracy, and for various points in connection with the registration of designs.

Then came the Act of 1842 (5 & 6 Vict. c. 100), which repealed all the previous Acts, but re-enacted them in a much wider form. It divided the articles to which designs might be applied and copyrighted into thirteen classes, with various terms of protection; and it contained provisions for the registration of designs, and the protection of designs so registered, similar in most respects to those now in force. This Act, like the previous Acts, only applied to ornamental designs. To remedy this the Act of 1843 (6 & 7 Vict. c. 65) was passed the next year, which extended the protection to useful designs applied to any article of manufacture, so far as the same should be for the shape or configuration of such article. It also made some trifling additions to, and alterations in, the Act of 1842.

Next came the Act of 1850 (13 & 14 Vict. c. 104), the principal object of which was to provide for the provisional registration of designs for a period of one year. The design might be published during the period of provisional registration, but a sale or exposure for sale of any article bearing the design would annul the provisional registration; the copyright itself, however, might be sold during that period. The Board of Trade was also given power to extend the term of copyright for a period of three years. The Act also contained some minor provisions for the amendment and extension of the Acts of 1842 and 1843.

The Act of 1858 (21 & 22 Vict. c. 70) extended the term of copyright for designs under Class 10 of the Act of 1842; enabled the proprietor of a design which had been infringed to bring his action in the County Court; and made some further regulations as to registration.

The Act of 1861 (24 & 25 Vict. c. 73) merely extended the Act of 1842, and the subsequent Acts, to designs applied, not only in the United Kingdom, but elsewhere, and whether the proprietor or inventor of the design was or was not a subject of Her Majesty.

The Act of 1865 (28 & 29 Vict. c. 3) provided for the protection of designs exhibited at industrial exhibitions certified by the Board of Trade, so that subsequent registration should not be prejudiced by such exhibition or by publication during that period.

The Act of 1875 (38 & 39 Vict. c. 93) transferred the powers and duties of the Board of Trade under the previous Acts (except the Act of 1865) to the Commissioners of Patents, and abolished the office of registrar under these Acts as a separate paid office.

All these Acts were repealed by the Act of 1883 (46 & 47 Vict. c. 57), which has since been slightly amended by the Acts of 1885 (48 & 49 Vict. c. 63), 1886 (49 & 50 Vict. c. 37), and 1888 (51 & 52 Vict. c. 50). These Acts are known as the Patents, Designs, and Trade Marks Acts, 1883 to 1888, and are set out in full (so far as they relate to designs) at pp. 149 *seq.*, *post.* The Board of Trade have, under the provisions of sect. 101 of the Act of 1883, from time to time published rules for regulating the practice of registration and the other business of the Patent Office, and for classifying goods. The Rules now in force are those of 1890, 1893, and 1898, which will be found at pp. 167 *seq.*, *post.*

The principal changes in the old law made by the present Acts are, that there is now only one term of protection (three years) for all classes of goods; that the term of copyright cannot be extended; that there is no provisional registration; and that there is no distinction between useful and ornamental designs.

## CHAPTER II.

## WHAT MAY BE REGISTERED.

UNDER sect. 47 of the Patents, Designs, and Trade Marks Act, 1883, any new or original design, not previously published in the United Kingdom, may be registered in accordance with the provisions of the Act, and is then, under sect. 50, protected during five years from the date of registration.

In considering what may be registered under the Act, we must ascertain, first, what is a design, secondly, what constitutes novelty or originality in a design, and, lastly, what constitutes prior publication.

(1.) *What is a "design."*

As to the meaning of "design," sect. 60, sub-sect. 1, of the Act says: "In and for the purposes of this Act, 'design' means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (54 Geo. 3, c. 56)."

It is to be noticed that sect. 60 does not profess to give any definition of the word "design"; it merely declares that *for the purposes of the Act* "design" means "any design applicable to any article of manufacture, &c."; or, in other words, it *restricts* the designs which can come within the scope of the Act to those

designs which can be applied to some article of manufacture, &c. (*a*), leaving the word “design” to be interpreted in its ordinary signification of something marked out—a plan or representation of something (*b*).

A design within the Act may be some ornament printed or produced in the flat, such as woven or printed designs in textile fabrics, paper-hangings, flooredoths, or the like; or patterns or designs etched or stamped, or cast or embossed, or cut or otherwise produced in metal articles, or glass, or plastic material, or furniture, or tiles; or worked or woven, as in lace; or it may be for artistic or beautiful shape or configuration, as in a lamp stand or lamp shade, or iron railing or gate; or for shape in which no appeal is made to a sense of beauty, as in a new shape or configuration of a grate-door, or oil-can, or cravat; or the design may contain two or all of the foregoing elements, *i.e.*, ornament, pattern, and shape or configuration (*c*).

The Act is confined to designs applicable to manufactured articles, &c., and to the application of such designs to such articles. The Act does not apply to the things to which a design is applied, but only to the design applied to them; and this distinction must be carefully borne in mind in considering what may be registered as a “design.” The distinction is obvious enough when a design is for a pattern or ornament; but when the design is for the shape of a thing, the distinction is reduced to the difference between the shape of a thing and a thing of that shape. A design applicable to a thing for its shape can only be applied to a thing by making it that shape (*d*).

On the question of what can be registered as “a design” within the meaning of the Act the following cases may be considered:—

**Mechanical contrivance or article of manufacture.**—If a person registers as a design something which is really a mechanical con-

(*a*) See *per* Rigby, L. J., in *Harper & Co. v. Wright, &c. Co.*, 12 R. P. C. p. 495.

(*b*) See *per* Lindley, L. J., in *Re Clarke's Design*, 13 R. P. C. p. 358. It should be noticed that colour cannot be the subject-matter of a design (see *per*

Chitty, J., in *Grafton v. Watson*, 50 L. T. (N. S.) p. 423; *per* Hall, V.-C., in *Nevill v. Bennett*, 15 R. P. C. p. 417).

(*c*) See *per* Lopes, L. J., in *Re Clarke's Design*, above, p. 361.

(*d*) *Per* Lindley, L. J., in *Re Clarke's Design*, above, p. 358.

trivance or an article of manufacture, the registration is bad, and the so-called design may be expunged from the register.

For example, where the design was of a new ventilator, consisting of an oblong pane of glass fixed in a frame which was inserted into an ordinary window frame, and was hinged at the top so as to open and admit the air by means of a screw acted upon by cords passing over its head, and having a half pane of glass fixed in the lower portion of the frame in which the ventilating frame ended, so as to prevent a downward draught, the claim of the inventor was said to be for the general configuration and combination of the parts, some of which were not original. This was held not to be a design for the shape or configuration of an article of manufacture within 6 & 7 Vict. c. 65, and therefore not the subject of registration, and a conviction for the infringement of such a registered design was quashed (*e*). Erle, J., in giving his opinion that the invention was not within the meaning of the statute, said: "It is a combination of means for the purpose of easily admitting air, and there is a skilful combination of means to produce this result. But the particular shape or configuration is accidental and wholly unimportant and unconnected with the purpose to be attained. An oblique pane is of no particular use; a square or circular pane and a straight or curved screen would produce the same result. If the prosecutor relies on the shape or configuration as producing a useful result (*f*), he fails in making out that the defendant had infringed his right, because there is no doubt that the shape of the defendant's invention varies materially from that registered by the prosecutor, in the one the pane being nearly square, and in the other oblong, and the screw being straight in the one and crooked in the other. The prosecutor intended to protect a combination of means producing a useful result, and that is within the law relating to patents, and not within the statute 6 & 7 Vict. c. 65."

Again, where a claim was made in respect of a shawl, and it was contended that there were five points in respect of which the shawl was new and entitled to protection, first, a reversible cloth with the two sides of different texture and colours, secondly, a

(*e*) *Reg. v. Bessell*, 15 Jur. 773; Cp. *Millingen v. Picken*, 14 L. J. C. P. 254.

(*f*) It should be noticed that this case

was decided under 6 & 7 Vict. c. 65, which protected designs having reference to some purpose of utility.

scollop pattern in parts of the shawl, thirdly, a particular border round the shawl, fourthly, a particular configuration of the corners of the shawl, fifthly, a newly-invented fringe to surround the shawl; and the evidence clearly showed that all these five points or designs had been in public use and had been applied to shawls before the registration of the plaintiff's shawl, but that the combination of them in the plaintiff's shawl was new, the Court held that such a combination was not a design within the meaning of the Act of Parliament (*g*). Lord Campbell, C. J., said: "The five points relied upon being all old, no distinction is to be made between them and any other in the texture, configuration, or ornament of the shawl. Therefore the combination supposed to constitute the design which the plaintiff now seeks to protect, comprehends all that is to be discovered on both sides of the shawl, colour as well as shape. The statute does not mention any 'article of manufacture' being a 'design,' but considers the design to be protected as applicable to the ornamenting of any article of manufacture. The design is always considered different from the article of manufacture or the substance to which it is to be applied. This is particularly to be observed in sect. 3, in which the articles of manufacture are enumerated to which the design is to be applied. Among these (Classes 7 and 8) are shawls: the 'shawl' is not the 'design' but 'the article of manufacture to which the design is to be applied.' An ornament for a lady's gown may well be a design to be protected, although the ornament be the result of a new combination of lace and ribands; but the gown itself could hardly be such 'a design,' although it be granted that the component parts and ornaments, before well known separately, are arranged according to a fashion entirely new. Such an extension of the statute is quite unnecessary for the object which the legislature seems to have had in view, and we need not point out the great public inconvenience which would ensue if we were to put such a construction upon it."

Similarly, when the design of a "protector label" consisted in making in the label an eyelet hole and lining it with a ring of metallic substance, through which a string attaching the label to

(*g*) *Norton v. Nicholls*, 5 Jur. (N. S.) 1203.



packages passed, it was held not to be within the protection of the statute (*h*).

But the design of a newly-invented brick, the utility (*i*) of which consisted in its being so shaped that, when several bricks were laid together in building, a series of apertures were left in the wall, through which the air might circulate, and a saving in the number of bricks effected, was held to form a proper subject for registration under the Act (*k*).

The distinction between "design" and "mechanical contrivance" and "article of manufacture" which is exemplified by these cases is not always very clear. Mr. Carmichael, of the Repertory of Patent Inventions, Lincoln's Inn, has endeavoured to explain the distinction, and he says: "In registering any new design for a table lamp, all which could be secured under such registration would be some peculiarity of form of an ornamental character in the stem or oil vessel, or in the glass shade, or some ornament applied thereto, if under the first-mentioned statute (*l*), or some novelty in the shape or configuration without reference to ornament, if under the second statute (*m*); no new mode of supplying oil to the wick, nor any new mode of raising the wick, nor any new apparatus for supplying air to support combustion could become the subject matter of a registration. The simple configuration, or contour, or ornament of the lamp, or some particular part of the lamp, would be the only subject for registration; and any person might, without infringing the registration, make the same description of lamp or parts acting mechanically in the same manner to produce the same end, so long as the outer configuration were not imitated. A patent on the contrary can scarcely ever be said to depend on shape; supposing a patent be taken for any improved construction of lamp—such for instance as an improved means of raising the oil from the stem or pillar of a table lamp—the patent would be equally infringed whether the external figure or design

(*h*) *Margetson v. Wright*, 2 De G. & Sm. 420.

(*i*) This case, like *Reg. v. Bessell*, p. 7, above, was decided under 6 & 7 Vict. c. 65.

(*k*) *Rogers v. Driver*, 20 L. J. Q. B. 31.

(*l*) 5 & 6 Vict. c. 100, which applied to designs for ornamentation.

(*m*) 6 & 7 Vict. c. 65, which applied to designs having reference to some purpose of utility.

be retained or not, so long as the means of raising the oil was preserved."

**Process of manufacture.**—Care must also be taken to distinguish between "design" and "a process of manufacture." Thus, where M. registered as a design a picture of a basket, stating his claim was for the pattern of a basket, consisting in the osiers being worked in singly, and all the butt ends being outside, the Divisional Court held that what the plaintiff had registered was in reality a process or mode of manufacture, and was not a design within the meaning of the Patents, Designs, and Trade Marks Act, 1883 (*n*).

Pollock, B., in giving judgment, said: "I cannot help thinking, the more I look at the question, and considering that it is under the Designs Act, that this was not the subject of a design. Here is a basket, a perfectly well known thing as an article of commerce, and as an article which is made for the carrying of a great number of things of all sorts and kinds, and made and shaped in different shapes for that purpose. But I do not gather from the evidence, and I do not gather from anything I know myself of baskets, or that anyone has suggested, that these baskets are treated as objects of art or as things that are pleasing to the eye, and that it matters therefore, for that purpose, whether the configuration is in one way or in another. It may be more convenient for certain purposes and to carry out the uses and objects for which they are intended, that one configuration should be adopted rather than another, and there may be a question as to the novelty of the configuration in that sense between one basket and another, but it seems to me to be *alio intuitu* altogether to speak of the word 'configuration' as applicable to things of this kind. One might go through a great number of instances in which an alteration, or a slight variation between one article and another article of a similar kind, would gain some purpose, but it never would be said for a moment it was in the mind of the person who made that alteration, that he intended to alter the configuration for the configuration's sake, or in any way to please the eye. It seems to me it is for an entirely

(*n*) *Moody v. Tree*, 9 R. P. C. 333.

different object, and therefore that this does not come within the Designs Act at all. It does not govern this case, but it does produce some effect on my mind when I see the history of this basket, and I cannot help thinking that what really occurred was this :—

“Here was a basket, which, if new and useful, would have been the proper subject of a patent, but being neither new nor useful, in the sense of a novel usefulness, it was found it could not be patented, and therefore the owner set to work and endeavoured to convert it into a design that could be registered under the Act. It seems to me that to allow that would be to do something that was entirely foreign to the Act itself, and would hamper commerce and interfere with trade unnecessarily, without giving any commensurate advantage to the trade or the world at large.”

In the same case Vaughan Williams, J., said : “It is plain that in order to enable the plaintiff to succeed in this action there must have been registered by the plaintiff, or by those through whom he claims, a design within the meaning of this Act of Parliament, and in my opinion it is plain, upon the undisputed facts of this case, that no design within the meaning of the Act of Parliament has been registered at all. I hold in my hand that which purports to be the design which has been registered, and when I come to look at that, it seems to me plain that that which has been attempted to be registered here is not a design within the meaning of the Act of Parliament at all, but a process or mode of manufacture. I do not think that a process or mode of manufacture can be registered as a design at all. If anyone is fortunate enough to invent a new process or mode of manufacture, he can then, if he is not prevented by want of novelty, or want of utility, or some such matter, get the benefit of his invention by means of the patent law as contained in this very statute ; but it was not the intention of the Act of Parliament that processes which could not, either for want of novelty, or want of utility, or some other reason, be protected as patent rights, should be protected by reason of an application to them of the law contained in this statute and the provisions contained in this statute with reference to designs.” After reading the definition of “design” in sect. 60, the learned judge went on to say : “In my view the designs within the terms of that definition must be capable of an existence outside the article

itself altogether. It must be something that one can apprehend, and something which, if one has it presented to one's eyes, one can see externally to the article to which it is to be applied, or to which it is intended to be applied. If that view is right, a mere mode of manufacture is not a design at all. It is not something which is capable of existence as a pattern, or as a shape or configuration, or as a piece of ornamentation to be applied to an article or class of articles, and when one looks at the thing which was registered as and for a design under this Act, one sees a mere picture of a basket, which is not intended to represent to anyone a peculiar shape or pattern of basket, or any form of ornamentation of basket."

Similarly, in the case of *Cooper v. Symington* (a), the plaintiff registered a design for the shape and configuration of that part of the corset in which the busks are inserted. From the evidence it appeared that previously busks, *i.e.*, the pieces of steel put into the front of the corset, were sometimes sewn into the corset, in which case there was some trouble in removing and replacing them when broken or bent, in other cases the busks were laced into the corsets so as to be easily removable, but that prior to the plaintiff's design the lacing was always at the outer edges of the corsets. It also appeared that corsets with sewn-in busks were sometimes fastened by lacing up the front. The plaintiff's busks were not sewn into the corsets but were laced in, the lacing being, however, at the inner side of the busks, so that when the corset was fastened together by clasps and studs the diagonal lacings which fastened in the two busks were brought into close proximity and presented the appearance of the corset being laced together, and gave a neat and ornamental effect. The appearance was, in effect, almost precisely similar to the appearance of the old laced-up corset. The actual method of lacing in the busks at the inner edges had not been previously used. The plaintiff sold his corsets with a ticket bearing the words "New method for removing and refitting busks for repairs, &c."

Chitty, J., held that the so-called design was not a design capable of being registered under the Act. In this case the

(a) 10 R. P. C. 264.

plaintiff, from the way in which he ticketed the goods, had evidently confused the term "design" as used in sect. 60 with the term "design" in another sense—in the sense of contrivance, or method, or process; and that, as we have seen in the preceding cases, however useful it may be, cannot be registered as a design under the Act (*p*).

**Design may be registered even if patentable.**—When the effect of the application of a new design to some article of manufacture is that some useful result is obtained, the fact that the design might have been registered as a patent, owing to its producing this useful result, is no objection to its being registered as a design if it is otherwise capable of being so registered (*q*); but in that case the statute gives no direct protection to the useful result (*r*).

In the case of *Walker, Hunter & Co. v. Falkirk Iron Co.* (*s*), Lord Shand in giving judgment said: "Now it is quite true the subject of registration must not be an article of manufacture itself, but a design to be applied to an article of manufacture or substance for pattern, shape, or ornament, and also that the branch of the statute which relates to the registration of designs does not afford or profess to afford protection to a mechanical principle or contrivance. The Act on this branch gives protection only to the shape or configuration, or to the design for the shape or configuration. The result of such protection may be, however, to secure important advantages such as attend a mechanical contrivance, if these advantages should be the result directly or indirectly of the shape or configuration adopted. Thus, in the present case, the new shape of fire-range door with the moulding as part of it has the particular advantages over the old shape of door which I have already noticed (*t*). These advantages are not directly the subject of protection, but inasmuch as they are dependent on and inseparable from the shape or configuration, they are indirectly secured by the registration of the design. It may be quite true that instead of

(*p*) Cp. *Re Plackett's Design*, 9 R. P. C. 436.

(*q*) *Rogers v. Driver*, 16 Q. B. 102; and see p. 9, *ante*.

(*r*) See p. 78, *post*.

(*s*) 4 R. P. C. 390. For the facts, see p. 78, *post*.

(*t*) These included the exclusion of cold air, radiation of heat, &c.

registering the design for its shape and so gaining protection for five years, the plaintiffs might rather have applied for letters patent and protection for the longer period of fourteen years for improvements in the manufacture of fire doors for convertible fire ranges, and have made, not the mere shape, but the mechanical action or contrivance the subject of protection by letters patent. But assuming that such letters patent might have been obtained, and that there was novelty, not only sufficient to validate the registration of the design, but to create an effectual patent, this would not, in my opinion, lead to the result that the design was not a proper subject for registration. On this subject Mr. Coppinger in his work on Copyright, at page 447, when treating of the provisions of the statute 6 & 7 Vict. c. 65, observes: 'It appears to be the received opinion that under this clause may be registered designs, the subjects of which could in many cases have obtained a patent, and in the case of *Rogers (u)*, an opinion to the effect was given by the learned judge of the Queen's Bench, and especially by Justices Coleridge and Erle.' The words of the statute then under consideration were these: 'Any new or original design for any article of manufacture having reference to some purpose of utility, so far as such design shall be for the shape or configuration.' These are very much the words in the present Act, having the difference only that it is not made necessary now to show that the shape and registered design does secure a useful purpose. So I am of opinion that the registration of the design in this case for its shape or configuration is effectual, securing as it does advantages directly resulting from the shape, and that, even though the plaintiffs could have obtained letters patent for improvements in the manufacture of fire-range doors which would have secured these advantages as an exclusive privilege."

**Design may be for part of an article.**—There is nothing to prevent the registration of a design which relates, not to an article complete in itself, but to an article which is to be used in combination with and as part of another article of manufacture, as for example a design of a door to be used in connection with a fire-range (*x*).

(u) 16 Q. B. 102.

(x) Per Lord Shand, in *Walker, Hunter & Co. v. Falkirk Iron Co.*, above, p. 394.

(2.) *Requirements of a design.*

The design to be registered must be—

(a) New or original;

(b) Not previously published in the United Kingdom;

and if a design possesses both these attributes it is a good subject for registration.

As the presence of each of these attributes is absolutely necessary in order to effect a good registration, it is proposed to consider them at some length.

(a) *Novelty.*

In the first place a design, to be a good subject for registration, must be either new or original; it must possess one of these characteristics or else it cannot be registered. It is not easy to determine what distinction is intended to be drawn between novelty and originality; but, perhaps, an original design may be defined as one that is of a kind that has never been produced before, one that differs wholly from all known designs; and a new design as one that has elements of novelty in it, and may be merely a new combination of old and well-known parts (*y*). It is not possible in all cases to say whether a design is “original” or only “new,” but the distinction is of no practical importance, for an “original” design must necessarily be “new,” and novelty is sufficient to satisfy the statute; a design need not be both new and original, so that, in all cases, it will be sufficient to inquire whether the design is “new” or not (*z*).

**What constitutes a new or original design.**—The first point to be noted is that it is not necessary for the “design” to be new or original in itself; it is sufficient if it is new or original *as applied to an article of manufacture*, &c. (*a*). For instance, in the case of, say, a lamp-shade in the shape of a rose, it is obvious that

(*y*) Cp. *per* Manisty, J., in *Sherwood & Cotton v. Decorative Art Tile Co.*, 4 R. P. C. 207; see p. 28, *post*.

Chitty, L. J., in *Re Rollason's Design*, 14 R. P. C. p. 914.

(*z*) See *per* Lindley, L. J., in *Re Clarke's Design*, 13 R. P. C. p. 358; *per*

(*a*) See also on this point, pp. 20, *seq.*, *post*.

there is nothing new in the shape of the rose; the *idea* is not novel, the novelty consists in its application to a lamp-shade, and as so applied it may well be a "new design." This point is clearly shown by the judgments of Lindley, L. J., and Bowen, L. J., in the case of *Saunders v. Wiel* (*b*), which practically reversed the decision in the earlier case of *Adams v. Clementson* (*c*), which was decided under the Act of 1842. In *Adams v. Clementson* the plaintiff had obtained from Cuba a portrait of General Martinez de Campos, Captain-General of Cuba, and had applied the portrait to earthenware, and registered the design under the Act 5 & 6 Viet. c. 100. It was held, in an action brought by him against the defendant for infringing the design, that a mere copy of a portrait that was common to all the world was not a new and original design within the meaning of that Act.

But in the case of *Saunders v. Wiel* the Court of Appeal disapproved of the decision in *Adams v. Clementson*. In that case the plaintiffs registered in Class 1, as a design for the pattern and shape of spoon or fork handles in metal, a representation of Westminster Abbey. A die was carved after this design from which a mould was made, and from this a metal copy of the design in relief was cast for handles of spoons and forks. The original design was made by an artist employed by the plaintiffs, from a photograph of the Abbey. The defendant made and sold metal spoons bearing on their handles a similar representation of the Abbey. On the plaintiffs bringing an action against him for infringement, the defendant contended that the design was not one that could be registered. The Court, however, held that the design was a proper subject for registration.

Lindley, L. J., said: "What we have to consider is this: whether this registered design—for a design of some sort, of course, it is—is a design applicable for the pattern and for the shape to things in Class 1, and in particular to forks and spoons, and whether it is a new or original design not previously published in the United Kingdom. Why is it not? Has such a design applicable to metals ever been seen before? If you ask that question you are told this: 'Yes, if you mean a view of public

(*b*) 10 R. P. C. 29.

(*c*) 12 Ch. D. 711.



buildings, or if you mean a view of cathedrals and churches, they are common enough; therefore there is no novelty in the idea.' But if you ask a little closer whether anybody has previously taken this particular aspect of Westminster Abbey, and used it as a design applicable to things in Class 1, or to any things like it, the answer is, 'No, that is new, and has never been published before.' That answer seems to me to bring the plaintiffs' case within the Act of Parliament, and I think the answer to the argument adduced by the defendant is this: he says the Abbey is not a design within the meaning of this Act of Parliament. In one sense, of course, it is a very valuable design. If an architect was thinking about building an abbey, having Westminster Abbey before him, it would be a very valuable design; but it is not a design within sect. 60 until you come to apply it as a design to some article of manufacture, and therefore you cannot say that abstractly, and as a general proposition, Westminster Abbey is a design. Then it is said the photograph is a design. The answer is, the photograph, whatever it may be in other Acts, is not a design within this Act until you apply it to something. The plaintiffs are not infringing the copyright of the photographer, or, if they are, we need not discuss that. What they are doing is this: they are making precisely the same use of the photograph which they might have made of the Abbey itself, and they are doing nothing more than taking that which anybody can see if he chooses to go down to Westminster Abbey, and applying what is there to be seen for a particular purpose. They bring themselves within both sect. 60 and sect. 47. There is no case which militates against anything which I have said, or the view which I am disposed to take of this matter, and which is the view of the learned judge, except the case before Vice-Chancellor Malins of *Adams v. Clementson*. That case turned on the older Act of 5 & 6 Vict. c. 100, s. 3, which is worded somewhat differently from the corresponding sections of the Act of 1883, and I strongly suspect, without knowing—for I have not looked into it—that the point which was not brought out with sufficient prominence in the case of *Adams v. Clementson* has led to a slight variation in the language of this Act of Parliament. I cannot help thinking that the Vice-Chancellor there, even under the old Act, slipped into an erroneous

view, and took 'design' rather as an abstract design instead of a design applicable to particular modes of manufacture. I cannot help thinking that he made a mistake in that respect, but the language of the Act there was by no means so pointed as it is here, and I rather suspect that the language has been made more pointed in order to prevent such a decision as that. However that may be, I am of opinion that the judgment in this case is right, and that the appeal must therefore be dismissed in the usual way."

Bowen, L. J., said: "I am of the same opinion. We must begin by asking ourselves the meaning of the term 'new or original design not previously published in the United Kingdom,' which is the term used in sect. 47 of the Patents, Designs, and Trade Marks Act. The argument for the defendant really does come to this, it seems to me, that what the Act requires is novelty in the idea itself. That is not the language of the section, in the first place. It deals with novelty or originality in the *design*; that is to say, in a combination calculated to produce a particular end—novelty in the way in which the idea is to be rendered applicable to some special subject-matter. But when you come to sect. 60, it becomes even more clear that that is the sense in which novelty in the design is used, because 'design' is, by the limitation of the interpretation clause, confined to designs which are applicable to any article of manufacture—to take only that portion of the definition which applies in the present case, and which is necessary for our present purpose. You cannot, therefore, wander away from the sections and the subject-matter of the Act, and consider whether an idea, which is totally remote from the subject-matter, is a novel idea or not. You must regard and test its novelty throughout as that novelty which is expected and demanded from a design intended to be applicable to an article of manufacture. When you get thus far, it is obvious, in the first place, that Westminster Abbey is not a design. The photograph is not a design. The photograph is that from which the design is taken, just as, if the step of the process of photography had been omitted and the artist had gone straight to the Abbey, he would have made his design from the Abbey, but he would not have converted the Abbey into a design. It seems to me that the novelty and originality in the design, within this section, is not

destroyed by its being taken from a source common to mankind. The novelty may consist in the applicability to the article of manufacture of a drawing or design which is taken from a source to which all the world may resort. Otherwise it would be impossible to take any natural or artistic object, and to reduce it into a design applicable to an article of manufacture, without altering the design so as not to represent exactly the original. You could not take a tree and put it on a spoon, unless you drew the tree in some shape in which a tree never grew, nor an elephant, unless you carved a kind of elephant which had never been seen. An illustration, it seems to me, may be borrowed from what we all know as the Apostle spoons. The figures of the Apostles are figures which have been embodied in sacred art for centuries, and there is nothing new in taking them as the idea; but the novelty of applying the figures of the Apostles to spoons was in contriving to design the Apostles' figures so that they should be applicable to that particular subject-matter. How does the case of a public building differ from the case of the figures of the Apostles? In no sense, it seems to me, and the photograph of a public building stands on the same footing. The answer to the whole argument of the appellant is, that it is not the natural object which is the design; that it is not the photograph which is the design. The novelty of the design consists in so contriving the copy or imitation of the figure, which itself may be common to the world, in such a manner as to render it applicable to an article of manufacture. With regard to *Adams v. Clementson*, I can only say that, unless some distinction can be drawn with respect to the Act under which the Vice-Chancellor was deciding, which renders it unlike this particular Act, in the absence of any clause like sect. 60, I doubt whether the decision was right. I also think that, although sect. 60 says what is the meaning of design in sect. 47, it would be possible to extract such a meaning from sect. 47 alone, when interpreted by common sense and by the scope and context of the Act of Parliament."

**Old design applied to different articles.**—As an extension of the principle laid down in *Saunders v. Wiet* (above) it should be noticed that even if a design has already been applied to an article of

manufacture, yet the same or a similar design may be registered and protected as applied to some other article of manufacture, provided that the latter article is so different from the former that there is some substantial novelty in such application. This statement must be taken subject to the proviso that if the design has been *registered*, that design, or a similar design, cannot be applied by other persons, even to different articles, in the class or classes in which it is registered, however novel such application may be, as the copyright extends to *all* articles in the class or classes of registration (*b*). Conversely, it cannot be registered in another class for application to similar articles of a different material (*c*); the mere difference of material is not sufficient to impart the quality of novelty, and such a registration would be expunged from the register on the ground of want of novelty (*d*).

The principal cases on this point are reviewed, and the principle very clearly expounded by Lindley, L. J., in his judgment in the recent case of *Re Clarke's Design* (*e*). He there said: "In considering the novelty or originality of a design, it must always be borne in mind that the applicability of the design to manufactured articles is the matter which has to be determined. This was pointed out in *Saunders v. Wiel* (*f*). From the wording of sects. 47, 58 and 60 it might be thought that if a design had never been applied to articles comprised in one of the classes of goods into which manufactured articles are divided for the purposes of the Act, such design might be protected for that class, even if it had been previously applied to goods of a different class (*g*). But it has been decided that if a design is really old in its application to some manufactured article, its application to a new substance will not necessarily entitle it to protection, although such substance may not fall within the class to which the first article belongs. In *Re Bach's Design* (*h*), a lamp shade in the shape of a rose, but made

(*b*) See sects. 58 and 60.

(*c*) The application, however, in a different class would not be an *infringement*; see p. 80, *post*.

(*d*) Sect. 90; see the Chapter on "Rectification," pp. 102, *seq.*, *post*.

(*e*) 13 R. P. C. p. 358.

(*f*) 10 R. P. C. 29; and see p. 16, *ante*.

(*g*) A registered design may always be *applied* without infringement to goods in any class in which it has not been registered, copyright only extending to the classes of registration. But it is quite a different question whether it can be *registered* in such class.

(*h*) 6 R. P. C. 376.

in linen, was registered for goods in Class 12; it was held that a lamp shade of the same shape, but made in china, which had been registered for goods in Class 4, was not entitled to protection. Although the substances were dissimilar, the shape was the same, and the articles having that shape were both lamp shades—that is, they were both of the same kind and used for the same purpose. Again, in *Read and Gresswell's Design* (i), a lamp shade made of paper, shaped like a chrysanthemum, was registered in Class 5; and a similar design for a lamp shade of the same shape was expunged from the register, although it was registered for goods in Class 12 and was made of linen and paper. In this last case Mr. Justice Chitty said that ‘to be capable of being registered, a design must be new or original in fact, and not, as suggested, new or original as to some particular class of goods. It cannot be said to be new or original if it is already being applied to articles of an analogous character.’ The learned judge was obviously referring to the classes of goods mentioned in the schedule to the Designs Rules; and the words referring to articles of an analogous nature show that the learned judge did not intend by the words ‘new or original in fact’ to decide that a design must be new or original in the sense of never having been seen before as applied to any article whatever.

“In the case of *Walker, Hunter & Co. v. Falkirk Iron Co.* (k), a design for the shape of an iron furnace door was protected, although wooden doors of the same shape for sideboards and other articles of furniture were old. The things shaped were for such different purposes, and their uses were so dissimilar, that the design for one of such things was held to be new or original, although it was old for the other. What then is the test to be applied to a case such as that before us? The design must be new or original with reference to the kind of article for which it is registered; meaning, by kind of article, not the class of article mentioned in the schedule to the Rules, but the kind of article having regard to its general character and use. A design may be new for a coal scuttle but not for a bonnet. On the other hand, a design for a shade of a gas lamp can hardly be new if it was old for an oil lamp. In the

(i) 6 R. P. C. 171.

(k) 4 R. P. C. 390.

present case, the design registered is for the shape of an electric lamp, or rather for the shade for an electric light. It follows from what has been stated above, that the shape may be new or original in its application to electric lamps, which are modern inventions, and yet be neither new nor original in its application to gas or oil lamps. If, when registered, the design was not new or original for all lamps, if the shape was common for such lamps as were used before electric lighting was invented, the design is one to which the Act does not apply, and the design ought to be expunged. Electric lighting being new, every lamp or lamp shade adapted to it for the first time may be said to be new or original, if attention is paid only to its application to the new method of lighting. But it is absurd to suppose that the application of an old shaped lamp or shade to an electric light could be protected under this Act. There must be some novelty or originality in the shape, as applied to sources of light, in order that a design for the shape of a lamp can be protected."

The principles which are explained by the cases quoted above may be summarized thus:—

- (a) A previously known design applied to certain articles of manufacture may be registered and protected as applied to *quite different* articles.
- (b) If the previously known design was registered, it may be registered by another person and protected as applied to *quite different articles in another class (I)*.

The articles must in both cases be quite different in order to have "novelty"; in the latter case they must also be in another class, as under sect. 60 copyright extends to *all* articles in the class or classes of registration.

We must now consider the question of novelty with regard to designs applied to the same or similar articles of manufacture.

**Substantial novelty necessary.**—In dealing with cases of designs the Courts are usually more liberal than in dealing with patents (*m*);

(l) See *per* Kekewich, J., in *Re Buch's Design*, 6 R. P. C. p. 378.

*Welch*, 28 Ch. Div. p. 36; *per* Malins, V.-C., in *Lazarus v. Charles*, 16 Eq.

(m) See *per* Fry, L. J., in *Le May v.* p. 121, and p. 28, *post*.

but, nevertheless, a design cannot be registered unless it has a clearly marked and defined difference from any design previously in use for the same or similar articles, and in such difference there must be some substantial novelty.

The question of "novelty" is always a question of fact, and has to be decided ultimately by the eye of the judge or Court, assisted, when necessary, by the evidence of experts (*n*).

As to the necessity of "substantial novelty," and as illustrative of what is necessary to constitute "substantial novelty," the following cases may be considered:—

In the case of *Le May v. Welch* (*o*), an action was brought for the infringement of a registered design for a shirt collar. The advantages claimed for the design were the height of the collar above the stud which fastened it in front, the cutting away of the corners in the segment of a circle, and the absence of a band.

It was shown that a collar had been previously in use which had no band, and in which the corners had been cut away in arcs of circles. It was held that the design was not new or original within the meaning of the Act. Lord Justice Fry, in giving judgment, said: "The meaning of the words 'novel or original' is this, that the design must either be substantially novel or substantially original, having regard to the nature and character of the subject-matter (*p*) to which it is applied."

In the same case Lord Justice Baggallay said: "In order to justify the registration of a design, especially with reference to such matters as collars and other articles of dress which are in constant and daily use, there must, according to my view of the case, be some clearly marked and defined difference between that which is to be registered as a new design, and that which has gone before. If the difference of half an inch in the placing of a stud, or any other similarly trifling difference from previous designs, were to be taken as justifying registration of a design for a collar, no one could have a collar made in his own house by his servants without

(*n*) See *per* Chitty, J., in *Cooper v. Symington*, 10 R. P. C. pp. 265, 267; and in *Re Rollason's Design*, 14 R. P. C. p. 914; *per* Lindley, L. J., in *Re Clarke's Design*, 13 R. P. C. p. 360; see also pp. 66, 67, *post*, and the cases referred to there.

(*o*) 28 Ch. Div. 21.

(*p*) *I.e.*, the article to which the design is applied.

running the risk of infringing some registered design." Lord Justice Bowen also said: "It is not every mere difference of cut, every change of outline, every change of length or breadth or configuration, in a simple and familiar article of dress like this, which constitutes novelty of design. . . . There must be, not a mere novelty of outline, but a substantial novelty in the design, having regard to the nature of the article."

Again in *Re Plackett's Registered Design* (q), which was an application to expunge a lace design from the register, Mr. Justice Chitty said: "Minute differences are not sufficient, having regard to the subject-matter, to justify the Court in saying that these minute differences are such as to constitute novelty or originality within the 17th section of the Act."

In the case of *Smith v. Hope Bros.* (r), the plaintiffs, who had registered a design for a scarf called the "Negligé Scarf," the alleged novelty in which consisted in the stitching of the outer sides of the two limbs in a special manner, so as to produce creases and depressions and give a *négligé* appearance, brought an action for infringement against the defendants, and applied for an injunction against them.

Stirling, J., after referring at length to the case of *Le May v. Welch* (s), said: "It seems to me that if I were to hold that this was a registered design which would prevent anybody from making that which came as near it as the defendant's exhibit in this case, I should be holding that the difference of a few stitches constituted a proper subject-matter of registration under the Act. That seems to me inconsistent with the conclusion to which the Court of Appeal came in the case to which I have already referred (*Le May v. Welch*), and therefore I think that the motion fails and it must be refused."

In *Re Sherwood's Design* (t), the respondents had shown to a customer a design for a globe for a lamp stove, consisting of a pineapple shaped glass globe of ruby colour, the surface of the glass presenting the appearance of being covered with hexagonal facets with "slip fittings" to fasten it. The respondents sold two such globes to the customer, who exhibited them in his window. Subse-

(q) 9 R. P. C. 436.

(r) 6 R. P. C. 200.

(s) See page 23, *ante*.

(t) 9 R. P. C. 268.



quently the respondents, finding that the slip fittings were deficient in stability, designed another globe with a flange at its base, which they registered. The globes were exactly alike, with the exception of the slip fittings in the one, and the flange in the other. It was held by Chitty, J., that in view of the publication of the design with the slip fittings, the addition of the flange was not sufficient to make the registered design novel or original, and that the design must be expunged from the register.

As an instance the other way, reference may be made to the case of *Re Rollason's Design* (*u*) where the Court of Appeal, reversing the decision of the Court below, held that the design in question was novel. Illustrations of the design and the alleged anticipation are given in 14 R. P. C. at p. 894, and in (1898) 1 Ch. p. 238 (*x*).

**Combination of old designs.**—A new design may be made from the combination of two or more old designs, provided always that the combination produces some real novelty.

In the case of *Reg. v. Firmin* (*y*), the defendant was convicted before a magistrate under the Act of 1842, for having, after notice from the proprietor of a new and original design for a regulation button, and without his consent, sold a button which was a fraudulent imitation of it. On application for a writ of certiorari to remove the conviction into the Court of Queen's Bench for the purpose of quashing it, a case was stated by the order of the judge, from which it appeared that the alleged original design consisted of the royal arms surrounded by a garter bearing the inscription "The Royal Mail Steam Packet Company." The Court held that, as a new and original combination might be the result of simultaneously applying two old and known designs to the ornamenting of a button, the application to quash the conviction ought to be discharged. Coleridge, J., then said: "Suppose a jockey on one button, a horse on a second, and a third button

(*u*) 14 R. P. C. 893 and (on appeal) 909; see particularly pp. 912, 913.

(*x*) See also *Farley v. Knightly Iron Works Society, Ltd.*, 14 R. P. C. 169, and the illustrations there given of the impeached design and the alleged antici-

pations. Reference may also be made to the cases (on infringements) referred to on p. 69, note (*h*), and the illustrations of the designs in question in those cases.

(*y*) 15 Justice of the Peace, 710.

having such a jockey, as in the first button, mounted on such a horse as in the second. There would be a simultaneous application of two old designs, and the result would be a new combination. So here a scroll with writing therein is an old ornament of a button, so is the royal arms. Is not the union of the two, by causing the scroll to enclose the two, a new combination?"

In the case of *Harrison v. Taylor* (z), the plaintiff registered under the Act 5 & 6 Vict. c. 100, a design for woven fabrics. The design which was called "The Honeycomb pattern" was applied to a fabric woven in cells, and consisted of a combination of the large and small honeycomb, so as to produce a large honeycomb stripe on a small honeycomb ground. Neither the large honeycomb nor the small honeycomb was new, but they had never been combined before the plaintiff registered his pattern, so that the combination of the two patterns was novel. It was held on appeal by the Exchequer Chamber that the design was a new and original design within the meaning of the Act 5 & 6 Vict. c. 100.

In giving judgment, Cockburn, C. J., said: "The question is one of fact, namely, whether this is a new and original design . . . . It is true that in this case the design consists in using the honeycomb pattern alternately in small and large proportions, and I agree that it would not have been competent for the plaintiff to register this design as against a person having a copyright in the honeycomb pattern; but no person has a copyright, and as the matter is simply one in which the public at large are interested, there is nothing to prevent the plaintiffs from taking the original pattern and varying it to a certain extent, and registering the whole as a new design. That leads to the question, Is it in its present shape, viz., the combination of large and small patterns, a new design? That is a matter of which anybody may satisfy himself by looking at it. There is a new combination, which is in substance a new design." Wightman, J., also said: "The Act uses the words 'any new or original design.' That is not a project or idea in the nature of an invention, but the representation of something, which a draughtsman has for the first time produced. If that be the true meaning of the word 'design,' there is no doubt

(z) 3 H. & N. 301; reversed 4 H. & N. 815.

in this case that there was a design, for there was a drawing, and it was an original drawing. It is true that all its component parts had already been produced, but no one had produced such a pattern. It was said in the Court below that this was 'a mere combination in a manner well known'; so it is with a picture: all its parts may be old, but the combination forms a new design."

In *Mulloney v. Sterens* (*a*), the plaintiff had registered under the Act of 1842 a design for a badge to be worn on the Shakespere Tercentenary. The badge consisted of four ribbons, on one of which was a design of a portrait of Shakespere, on another a design of his birthplace, on the third a design of the church at Stratford-upon-Avon, and on the fourth, which was worked into a button, were the Arms of Shakespere. None of the designs were new, nor was the badge new, as badges of a similar shape had been made before in connection with other events. In an action for an injunction to restrain the defendant from making a similar badge, it was held to be so doubtful whether such a combination as that of the plaintiff's was a novel and original design within the meaning of 5 & 6 Vict. c. 100, that an injunction was refused.

In *Lazarus v. Charles* (*b*), the plaintiff registered under the Act 5 & 6 Vict. c. 100, a design designated as "a pictorial flap card basket" and described in the following way: "The case of the basket is formed by an octagonal piece of cardboard or other similar substance, and on each side of the octagon there are attached two pentagonal flaps, one above and the other below the octagonal base. These flaps can be folded down almost flat upon each side of the base, and by this means the entire basket can be packed into a box which is sold with the article. When the basket is required for use, the flaps are turned outwards till they are in contact at their edges, and are then connected by a cord passing through holes in each flap. Small medallion-shaped lithographs of objects of interest, or pictures, or verses enclosed in a medallion, are affixed to the inside of the upper set of flaps and to the outside of the lower set."

It was admitted that the basket was not in a new form as to the upper part, and that the only novelty was that it was a double

(*a*) 10 L. T. (N. S.) 190.

(*b*) 16 Eq. 117.

basket. It was held that the combination was not a new or original design within the meaning of the Act. Vice-Chancellor Malins in giving judgment said: "Though the Courts have shown much more liberality in dealing with cases under the Act for registration of designs than under the Act giving protection by means of patents, yet the same principle applies as to patents, and people who manufacture articles with only a slight alteration in form from other articles already manufactured, should not rush into the mistake of registering their design, thus causing an embarrassment to trade."

In the case of *Sherwood and Cotton v. Decorative Art Tile Co. (c)*, the idea of the plaintiff's design, which was registered in December 1881, was to take a flower and leaves not found in nature, to make the leaves the prominent feature, and to have the whole surrounded by a neat geometrical border. In order to get an artistic appearance, the leaves and flowers were made at several points to run into and to cover the border. It was held that the plaintiff's design was a new design. Manisty, J., in giving judgment said: "It is clear to my mind at all events that the plaintiff's design, which is now in question, was a new combination, a new arrangement of well-known parts. It is not what I think the Act of Parliament means by an original design, that is to say, suppose there had never been any ornamental tiles, and a designer had designed this very design, that would have been original. So in patents, you have cases where the whole principle is new, and you have cases where it is not a new principle, but a new arrangement or combination, which may or may not be usable, according as it does or does not infringe any former arrangement. But I am satisfied this is a new design; the arrangement and effect of it is new, and it seems to me that in this case the plaintiffs have gone, or rather their witnesses have gone, in some respects very far astray as to what was new and what was really a new invention. It is really a combination of well-known parts, but so new as to be a new design."

Again, S., in 1887, registered a design for fire screens constructed of three palm leaves tied or wired together in the form of the ace of clubs, and so as to hold a flower pot. In an action for

infringement Wills, J., in giving judgment, said: "It is a somewhat startling proposition, and almost of necessity must be to any mind which comes fresh to it, to hear it suggested that putting three leaves together in such an obvious manner as this would be likely to be considered a novelty, because it is an arrangement which anyone who took up the three palm leaves could hardly help so arranging, and therefore it is not a case in which, as it seems to me, one's natural impression would be in favour of novelty. One's natural opinion would be that, if invented at all, it was invented and known long before 1887. . . . But it is impossible to say that copying the trefoil can be a novelty such as to entitle a person to register a design like this, and so prevent the public using it." It was proved that in fact similar designs had been previously in use, and it was accordingly held that the design was not novel, and that the registration failed (*d*).

In the case of *Hothersall v. Moore* (*e*) the plaintiff claimed that his design as a combination was new and original, and not previously published in the United Kingdom; he alleged that the use of a red-coloured border on a body of yellow chamois leather cloth was entirely new, and constituted a design within the Act, and the mode in which he arrived at the design was not by drawing a pictorial production, but in this way. He took a piece of an old pattern (No. 20) long used for dusters, and directed Mr. F., who was the manufacturer of goods ordered by him, to work out the border of this duster (No. 20) in red, and then he took a duster (No. 19) and took from that a pattern of the so-called chamois leather cloths, and directed Mr. F. to work that out as the body of a duster with the borders like No. 20, only worked out in red. The border in No. 20 was a very old and common border, and that the chamois leather cloth was known at the time as a material was clear from the fact that the plaintiff alleged he took the pattern for the body of No. 2a (the design in question) from No. 19, and when the body of No. 2a was applied to a square forming part of the border of No. 19, this was apparent to the eye, the two things were, in fact, identical. Upon these facts V.-C. Bristowe said: "He (the plaintiff) takes an

(*d*) *Smout v. Slaymaker*, 7 R. P. C. 90.

(*e*) 9 R. P. C. 27.

old border from a well-known duster, and he applies that well-known border to a previously existing fabric. The border had been used over and over again: the fabric was not new. There is nothing in the slightest degree novel or original in this border; it is a mere stripe of colour and the material is already in existence, though of recent manufacture. What was there then new or original in this to constitute a design? I admit the difficulty of stating with precision what is a design within the Act, and many judges have previously found that difficulty; but independently of authority on the subject I cannot bring myself to the conclusion that there was, in the application of the border to the exhibit No. 20 (which was a common border) to a material forming part of No. 19, enough to constitute a design by way of combination within the meaning of the Act."

In the case of *Ricett v. Grimshaw* (*f*) the plaintiff had registered a design for a combination of a bassinette and mail cart, and it appeared that, though the different parts taken separately were old, there had been no cars in which the back seat, well, front seat, and boot, were all of the type of the plaintiff's design. It was held that the design was novel.

A similar case is that of *Heinrichs v. Bastendorff* (*g*), which was an action for the infringement of a design for a writing table. Day, J., in giving judgment said: "It is perfectly clear that no part of this article can be said to be by itself or in itself original. Every part of which it is composed is a thing which has previously existed and is well known, but it is the combination of the things—the putting them together—which constitutes the novelty and the originality of the thing, considered as a composite thing. There is no doubt that this thing is made up to a very considerable extent, at least, I do not say altogether, of things which are to be found in the two writing-tables which have been produced on behalf of the defendants here to-day. I refer to the one with the folding-doors and the one with the flap. There are very few parts of the registered article which are not to be found in one or other of those two writing-tables. But what I do not find in any writing-table which has been described to me or produced before

(*f*) 11 R. P. C. 351.

(*g*) 10 R. P. C. 160.

me is that combination of these things which I find in the registered writing-table. I find there a thing which appears to be novel in its arrangement, novel in its details as a combination, and novel also in its general design and appearance. This does seem to me to present a novelty and originality which, as I understand the subject (I speak with great diffidence, but I am obliged to express my opinion as far as I understand the subject), is necessary, and alone necessary, to constitute a subject fit for registration under this statute. It seems to me, therefore, that this article is an article of novelty and originality. This article, considered simply as a composite article, is an article that does present that novelty and originality which is requisite for registration" (*h*).

It appears from these cases that, when a design consists of a combination of old designs, the combination must result in the production of some real novelty, otherwise the design will not be a proper subject of registration. It is not sufficient that a mere combination be effected; there must be a new arrangement of old parts. The old designs must be so combined as to produce a new design, and, unless this result is achieved, the design will be incapable of registration. The question in all the cases quoted above was, whether the combination of the old designs was of such a character that the design resulting from such combination was new. No rule can be laid down as to what is or what is not a novel combination; it is a question of fact in each case, to be decided by the eye.

A design may also be valid within the Act although all the parts are old, except some particular part only which is new or original, if the novelty or originality of the particular part is sufficient to impart the character of novelty or originality to the whole (*i*). But in that case only the design as a whole is protected, and any one can reproduce the old parts of the design, omitting the new part (*k*).

It seems possible that even the omission of something from an

(*h*) Compare *Birkin & Co. v. Pratt, Hurst & Co., Ltd.*, 12 R. P. C. 371; *Nevill v. Bennett & Sons*, 15 R. P. C. 412; and the judgments in the recent case of *Re Clarke's Design*, 13 R. P. C. 351.

(*i*) See *per* Chitty, J., in *Walker & Co. v. Scott & Co.*, 9 R. P. C. 482; cp. *Knowles & Co. v. Bennett & Sons*, 12 R. P. C. p. 147.

(*k*) *Walker & Co. v. Scott & Co.*, above.

old design may result in a new or original design which may be protected (*l*) ; but this would not apply to a case where the original design consisted of two or more distinct parts, and the only novelty in the later design was the omission of one of those parts (*m*) ; and the omission must, of course, be such as to result in a substantially different design being produced.

**Utility immaterial in question of novelty.**—In considering the question of novelty it is quite immaterial whether a design is useful or not. In the case of *Hecht Foundry Co. v. Walker, Hunter & Co.* (*n*), Lord Watson in giving judgment said : “ It is quite immaterial for the purposes of registration under the Act of 1883 whether a design is useful or devoid of utility. All that the statute requires, in order to its registration and protection, is, that it shall be new or original, and shall not have been previously published in the United Kingdom ” (*o*).

It is equally immaterial in a question of novelty whether a design is more useful than previous similar designs. In the case of *Mundy v. Tree* (*p*), Baron Pollock in giving judgment said : “ I entirely agree with what is said by Mr. Terrell in this case, that we ought to reject *in toto* the question whether the basket, which is said to be new, is a better basket for commercial and practical purposes than baskets that have gone before.” In the case of *Tyler & Sons v. Sharpe Bros. & Co.* (*q*), however, Romer, J., in considering the question of the novelty of the plaintiff's design, and deciding in its favour, laid great stress on the fact that directly it was put on the market it acquired a large sale, while the alleged anticipations of that design were never practically sold at all. But it is suggested that the learned judge was wrong in giving any weight to this evidence, for large sale is evidence of utility and not necessarily of novelty (*r*) ; and the question of utility, as we have seen above, is quite immaterial in considering whether a design is novel. It is obvious that a trifling change in a design

*l* See *per* Lindley, L. J., in *Re Design*, above, p. 361.  
*Clarke's Design*, 13 R. P. C. p. 360. (*p*) 9 R. P. C. 333.

(*m*) *Ibid.*

(*q*) 11 R. P. C. 35.

(*n*) 6 R. P. C. 554.

(*r*) *Per* Kekewich, J., in *Bach's Design*,

(*o*) *Cp. per* Lopes, L. J., in *Re Clarke's* 6 R. P. C. p. 377.



might be sufficient to make it achieve some useful object which was not attained before, without so far altering the design as to impart any element of novelty; and looking at the cases cited above, and the clearly expressed decisions that the question of utility is quite immaterial, it is submitted that this case cannot be accepted as an authority.

It is also immaterial in a question of novelty to consider whether or not a design accomplishes the same object or purpose as earlier designs. The only question is, whether the design itself differs substantially from the earlier designs (*s*).

(b) *Prior publication.*

The final characteristic required to make a design a good subject for registration is the negative one that it must not have been published in the United Kingdom (*t*) prior to its registration. By publication is meant communication of the design to the public.

The most obvious instance of prior publication is the public use or exhibition (*u*) of the design or a similar design before it is registered. The communication of the design may, however, be only to individuals, not to the public generally, and in such cases the question whether or not such communication amounts to prior publication depends upon whether the communication is confidential or not. If the communication is made by the inventor to a person standing in a confidential or business relation to him, such as his partner, or his agent or servant, this would not be publication; otherwise considerable difficulty would arise in carrying on business. An inventor may also communicate the design to a manufacturer for the purpose of getting the article manufactured and the design registered, provided the communication is confidential and the inventor reserves his rights to the design, for

(*s*) See *Hecla Foundry Co. v. Walker, Hunter & Co.*, 6 R. P. C. p. 559, and p. 77, *post*.

(*t*) Sect. 47 (1). Under this sub-section it would appear that publication in the Isle of Man would not invalidate subsequent registration. But this seems

inconsistent with sect. 103 (2), which provides that *under certain circumstances* publication in the Isle of Man shall not invalidate subsequent registration.

(*u*) See *Re Sherwood's Design*, 9 R. P. C. 268, and p. 24, *ante*.

then the relations subsisting between the parties are considered confidential for the time being. And he may, in the same way, consult the person through whom he proposes to put the goods on the market (c).

The confidential nature of the communication must be a reality, and if the design is communicated to a large number of persons, the plea that the publication was confidential cannot be sustained.

How far the law allows publication in confidence is well explained by Kekewich, J., in his judgment in the case of *Blank v. Footman, Pretty & Co.* (x). "The plaintiff, Emilius Blank, through his agent in this country, registered the design in question. The defendants have infringed that design, that is to say, they have made, manufactured, or sold an article of that design. They insist that they are entitled to do so, and that is the legal question which I have to decide on the facts, as they are not entitled to do so if, as a matter of fact, this design was properly registered when it had not been previously published in the United Kingdom. The question to be decided is, therefore, whether the design was published previously to the registration.

"Mr. Blank may be treated as the manufacturer, though he does not manufacture in this country. He is the agent of manufacturers in Germany, and he is the seller in this country of their manufactured goods, and he may be treated as practically the manufacturer. Mr. Hummel is a commission agent. He sells these goods, and goods of this kind, and he has a bargain or understanding with Mr. Blank that he shall have the sole and exclusive right of selling goods of this class in the United Kingdom. Therefore Mr. Hummel has an interest in any design of Mr. Blank's in goods of this class, and though he is not a partner, or in any way a partner, he has that interest which makes him a person whom Mr. Blank would naturally consult before endeavouring to put any of that class of goods on the market. Mr. Blank therefore, having sketched this design, shows it to Mr. Hummel. I cannot conceive that in doing so he would be publishing the design in any sense which could be placed on that word. Even if

(c) *Nevill v. Bennett & Sons*, 15 R. P. C. 412.

(x) 5 R. P. C. 653.

that relation had not existed between the two parties, I see no reason why a designer should not call in an expert—a gentleman whom he knows to be experienced in the trade—likely to advise him well, and whom he can trust, for the purpose of advising him before incurring further expense and trouble. But the relation which I have described existing, there cannot be to my mind the slightest doubt about it. Therefore in calling in Mr. Hummel and showing him the sketch, and showing him the designs as altered from time to time—for they were altered over and over again—and consulting him respecting the cost and other details, I consider that Mr. Blank was only doing that which he was fairly entitled to do, the confidential character of the communications being a necessary incident of the relation between the two parties. If it had stopped there, I might have disposed of the case easily enough. But Mr. Blank was not content to stop there. Mr. Blank not only desired to get the full advice of Mr. Hummel, but he very naturally wished (and I cannot blame him, as a prudent man of business, for wishing as he did) to ascertain, before he went any further, whether this was a design which was likely to take. By what words, and on what occasion, and with what restrictions, I have no knowledge; but he certainly did intrust Mr. Hummel with the duty of soliciting orders (that is one expression), and ascertaining from likely purchasers whether orders could be got for this design when it had taken a material form, when there was trimming to be sold, and, according to the plaintiff's own view, when it had been registered. Mr. Hummel accordingly consulted three different gentlemen, and I think I must deal with them in two classes. First, there is Mr. Sewell, who was Mr. Hummel's largest customer. He was a manufacturer who apparently purchased a large quantity of trimmings of this kind, and was well known to Mr. Hummel, and was in constant communication with him. Determining not to enter into any question of conflict of evidence, and not wishing to infer anything which is not actually proved, I only assume on the facts before me that Mr. Hummel showed this design to Mr. Sewell to get his advice, and to ask him whether he would be prepared to give orders to be executed at a later period. He ascertained Mr. Sewell's views. He ascertained

from him that the price at that earlier date was, to his mind, excessive, and no doubt there were other criticisms. Now Mr. Aston has cited to me, and I am content to take, the statement of Lord Justice Bowen in *Humpherson v. Syer* (y) as to what must be established in order to take a case of disclosure (I avoid the word 'publication') out of that publication which will destroy a patent or design. Lord Justice Bowen says: 'I think when a man sends a patent to be made to a shop you must take what passes orally; you must take all the circumstances of the case, and ask yourself whether there was any confidential relation established between the two parties, whether it was an implied term of the employment that the information should be kept by the shopman to himself, or whether he might afterwards, without any breach of good faith, use the matter, and use it as he chooses.'

"It is to be observed that these words are applied by the Lord Justice with reference to the facts of the particular case before him—to information given to a shopman who is going to manufacture. That is to say, the Lord Justice is dealing with a case where, from the very necessity of the thing, some other person must be employed. The patentee, whether it be a chemical patent or a scientific patent, or a machinery patent, frequently (generally I might say) is unable to carry out the manufacture of the patented article in all its details himself personally. He must employ others, and for that purpose the Lord Justice says he is entitled to do so without in the slightest degree damaging his patented rights to claim protection, provided it is done confidentially. It is a step further to say that a man like Mr. Blank is entitled to take into his confidence a man like Mr. Hummel, who is only a commission agent, a man through whom the profits are to be made. He does not occupy to my mind a position at all similar to that of the shopman. But I think it is only a fair stretch of the same principle to say, as I have already said, that I think a man in Mr. Blank's position might consult with those through whom he would put goods on the market, particularly, as I say, having regard to the relations existing between them, and doing it confidentially, with-

(y) 4 R. P. C. 497 (a patent case).

out avoiding his rights to be obtained by registration. But is Mr. Hummel, when consulted in that way, to be entitled to go on to any other person or number of persons and still use the same confidence—a delegated confidence placed in him by Mr. Blank? If so I do not know where it is to stop. If Mr. Hummel consults Mr. Sewell, who is a very large manufacturer as I am told, and that is said to be in confidence, he again may consult many of the persons for whom he works, and so on to the end of the chapter. I see no limit to the confidence which might thus be placed in one person after another. What the Lord Justice Bowen says, which I read as a statement by reference to a particular instance of a broad principle, has in my mind no application to a case like this, where the one person taken into confidence, for his own purposes quite as much as for any other (I do not blame him for it), consults a manufacturer, perhaps in confidence. Mr. Hummel's interest was to sell this article. Mr. Hummel's interest was to ascertain that it would be saleable, and he might very well consult those whom he trusted. But whether he could do so without running the risk of publication is an entirely different question. However, nothing really was done, as I understand the evidence of Mr. Sewell, in the way of actually giving an order until very much later, when the thing had been completed, and I do not think it necessary to decide this case, I will not say on the mere exhibition, but on the mere disclosure (the word I used before) of the sample patterns by Mr. Hummel to Mr. Sewell. The other cases go a step further still. Here again we have another delegation of confidence illustrating what I said just now, namely that I really do not know where this confidence is to stop."

The learned judge then explained how Hummel went to Portsmouth and consulted two of his customers there, who gave orders, whether to be executed before registration or after. These two customers received samples but did not show them, yet his Lordship saw no reason why, if they had been disposed to act badly to Mr. Hummel, they should not themselves have had some of the designs manufactured for themselves, and if Mr. Blank had proceeded against them, they might have answered that if Mr. Hummel had committed a breach of confidence, it was he whom Mr. Blank must proceed against.

"I cannot understand what meaning to give the words 'previously published' if that is not publication. In truth the only ground on which the want of publication has been argued is the question of confidence, and that I have already dealt with. Even if there was no publication to Mr. Sewell (which I do not think it necessary to decide, though I think there was), in my opinion there was certainly publication at Portsmouth, and from that time forward it was impossible for Mr. Blank to register this design. This seems to me entirely conformable to the policy of the Act, which is intended as I understand it to protect those clever and industrious people who spend their time, their money, and their brains in designing a pattern which may or may not prove successful, but as a work of art is entitled to protection in order that it may also become a work of profitable commerce. But I see no reason for applying that principle to the case of a man who prefers to take his chance with the public, and who says, 'I will design and I will spend my time and my money when I am quite satisfied that I shall find a market.' That is not, to my mind, at all within the policy of the Act. Mr. Blank, not unnaturally, has attempted to avail himself of the provisions of the Act in order to get protection for that which the Act never intended to be protected. I think that when he registered the design it had been previously published in the United Kingdom" (z).

In *Winfield & Son v. Snow Brothers* (a), a buyer for Messrs. O. suggested to the plaintiffs to produce lace of a certain pattern. The plaintiffs accordingly had a design prepared by a designer, and they then manufactured a sample of lace according to the design and submitted it to the buyer. The latter approved of the design subject to a slight alteration, and gave an order for a certain quantity of lace, retaining meanwhile, with the consent of the plaintiffs, a portion of the sample as a pattern for insertion in his pattern book. A few days later the plaintiffs registered the design. On the plaintiffs bringing an action for infringement against the defendants, it was held that the communication of the design by the plaintiffs to the buyer was not of a strictly confidential character merely for the purpose of obtaining the latter's

(z) Compare *Henrichs v. Bastendorff*, Day, J., in that case, p. 163.  
16 R. P. C. 160, and the judgment of (a) 8 R. P. C. 15.

advice, but that it was a commercial transaction with the object of disposing of the lace, and amounted to prior publication, and that the registration was therefore bad.

If a person, to whom a design has been communicated in confidence, breaks that confidence and communicates the design to other people, this would apparently be publication and vitiate the subsequent registration (*b*).

**Is registration equivalent to publication?**—It seems to be a moot point whether registration of a design is of itself a publication. The question was raised but not settled in *Re Read and Gresswell's Design* (*c*). There is, in the case of trade marks, a special section (*d*) providing that application for registration shall be equivalent to public use; but “public use” in the case of trade marks is quite a different thing to “publication” in the case of designs, so that no argument can be based on the omission of any similar provision with respect to designs.

It is only after the copyright in a registered design has expired that the design is open to inspection by the public; till then, the design can only be inspected by the proprietor or by persons authorized by him, the Comptroller, or the Court, or by a person who has been refused registration on the ground that his design is similar to the one on the register (*e*); and no copies of the design may be made by the person inspecting. The policy of the Act is to keep the registration as secret as possible; and it seems on the whole most probable that mere registration of a design would not be considered equivalent to publication. It is more doubtful what would be the effect of an actual inspection under the provisions of sect. 52.

Exceptions to the rule that prior publication invalidates the registration of a design have been created by sects. 57 and 103 of the Act of 1883, and sect. 3 of the Act of 1886.

(*b*) See *per* Fry, L. J., in *Hutchinson v. Syer*, 4 R. P. C. p. 416. substituted for sect. 75 of the Act of 1883.

(*c*) 6 R. P. C. 471.

(*e*) Sect. 52 of the Act of 1883, and

(*d*) Sect. 17 of the Act of 1888,

sect. 6 of the Act of 1888.

Under sect. 57 of the Act of 1883, the proprietor of an unregistered design may exhibit such design, or an article to which such design is applied, at an industrial or international exhibition certified as such by the Board of Trade, or may publish a description of such design during the holding of such exhibition, without endangering his right to register the design, provided that he gives the comptroller seven days' notice (*f*) in writing of his intention to exhibit or publish the description of the design, and furnishes to him a brief description of the nature of the design accompanied by a sketch or drawing thereof, and any other information the comptroller may require (*g*), and provided that the proprietor applies to register the design within six months from the date of the opening of the exhibition. Under the same section the proprietor will also be protected even if the design, or any article to which the design is applied, is exhibited during the exhibition elsewhere than at such exhibition, if the design or article is so exhibited without his privity or consent.

By sect. 3 of the Act of 1886, Her Majesty may by Order in Council declare that sect. 57 of the Act of 1883 shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and may provide that the exhibitor shall be either wholly or partially relieved from the condition of giving notice to the comptroller of his intention to exhibit the design.

Where arrangements have been made with a foreign state for the mutual protection of designs, a person who has applied for protection for a design in such foreign state may, in priority to other applicants, register the design in this country within four months from his applying for protection in the foreign state, and such registration will not be invalidated by the exhibition or use of the design, or by the publication of a description or representation of the design, in the United Kingdom or the Isle of Man during such period of four months (*h*).

The provisions of this section only apply in the case of those foreign states to which Her Majesty may from time to time by

(*f*) Form I., p. 181, *post*.

(*g*) Rule 36.

(*h*) Sect. 103, sub-sect. 2; see also p. 123, *post*.



Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state (*i*).

The provisions of sect. 103 may also be applied by Order in Council to British possessions which have made satisfactory provision for the protection of inventions, designs, and trade marks patented or registered in this country (*k*).

(*i*) Sect. 103, sub-sect. 4. For a list of these Orders in Council, see p. 191, *post*.

(*k*) Sect. 104. For a list of these Orders in Council, see p. 192, *post*.

## CHAPTER III.

## WHO MAY REGISTER.

UNDER sect. 47, sub-sect. 1, of the Act of 1883, the application to register a design must be made by or on behalf of a person claiming to be the proprietor of the design. It is not the duty of the comptroller to inquire whether the applicant really is the proprietor or his agent, as long as he claims to be so (*a*). If a person who is not really the proprietor of the design gets it registered and gets himself registered as the proprietor, the remedy of the real proprietor is to move under sect. 90 to erase the name of the false proprietor from the register and have his own name substituted (*b*). And even if the real proprietor should not take this step, any other person aggrieved can move to have the register rectified by expunging the design altogether (*c*).

The word "proprietor" is defined by sect. 61 as follows: "The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be con-

(*a*) There is no provision in the designs part of the Act corresponding to sect. 71, which provides that where each of several people claims to be registered as proprietor of the same trade mark, the comptroller may refuse to register any of them till their rights are determined by law; so that in such a case he would apparently register them all, and leave

them to settle their rights under sect. 90; see the chapter on "Rectification," pp. 102 *seq.*, *post*.

(*b*) *E.g.*, in *Re Heinrich's Design*, 9 R. P. C. 73; and see pp. 108 *seq.*, *post*.

(*c*) *E.g.*, in *Re Gutterman's Design*, 35 L. J. Ch. 309; and see pp. 47, and 104 *seq.*, *post*.

sidered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise."

The proprietor may therefore be—

- (A) (1) The author of the design ; or
- (2) The principal in whose employ the author of the design may be.
- (B) A purchaser of the design or of the right to apply the design.
- (C) The person on whom the property in such design or such right to the application thereof devolves, *e.g.*, by bankruptcy, by will, by assignment, &c.

(A) (1) **The author of the design.**—The author of a design is the person who actually invents it, and as a general rule there is no difficulty in determining who invented a particular design. Difficulties, however, sometimes arise in cases where a merchant gives a manufacturer an order to produce for him a design in a certain material, or to make some specific article according to a particular design. There is no difficulty, of course, if the merchant takes a definite design to a manufacturer and says "Make me some lace according to this design"; or "Make me a table of this particular shape"; the manufacturer would clearly not be the author of the design. On the other hand, if the merchant merely said: "Make me some lace with a floral design of roses and lilies," or "Make me a table with three flaps,"—in fact, merely gives the manufacturer a general idea of the kind of design he wants,—then the manufacturer would clearly be the author of the design produced in accordance with these instructions (*d*). It is in cases between these two extremes that difficulties may occur, and it is always a question of fact as to which of the two parties really invented the design (*e*). Possibly under certain circumstances, although the manufacturer was the "author," the merchant might

(*d*) See *e.g.*, in *Winfield v. Snow*, 8 R. P. C. 15, where the plaintiff (a manufacturer) had made and registered a design according to a suggestion of a firm's buyer. The facts are set out at p. 38, *ante*.

(*e*) See *Hothersall v. Moore*, 9 R. P. C. p. 38; *Re Heinrichs' Design*, 9 R. P. C. 73. What the facts in these two cases were is not at all clear from the reports, so that no general rule can be deduced from them. See also *Nevill v. Bennett & Sons*, 15 R. P. C. 412.

be able to claim that the work was executed on his (the merchant's) behalf for valuable consideration, and that he was therefore the "proprietor" under the next heading (*f*).

(A) (2) **Author's principal.**—If the author of a design be in the employ of a manufacturer as designer, then the design will be the property of the manufacturer, and he will have the right to register the design. In the case of *Lazarus v. Charles* (*g*), Sir R. Malins, V.-C., commenting on sect. 5 of the Act of 1842, which corresponds to sect. 61 of the Act of 1883 and is in similar terms, said: "Therefore I take it that where a person is engaged in any ornamental business, and has a workman in his employ under him, who makes a design which is new and original, that design would become the property of his master by virtue of the relations that exist between them, and the master would be entitled to register the design under the words of the section: 'Every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same,' &c." The wages which the manufacturer pays to a designer appear to be a sufficiently good consideration for the property in the designs invented by the employee becoming vested in the master.

That is, doubtless, all that was meant by Mr. Justice Lawrance in the case of *Woolley v. Broul* (*h*), when, after making the following quotation from sect. 61 of the Act of 1883, "The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good and valuable consideration, in which case such person shall be considered the proprietor," he said: "And that, I see, is meant to apply to the case of a manufacturer who has a servant in his employment who has made some new design which his master has given him valuable consideration for." It would, it is thought, be straining the meaning of these words too much to take them to mean that the master had to give a valuable consideration in addition to the ordinary wages of his servant, before he could acquire the property in the design.

Although there appears to be no case upon the point, it seems

<sup>1</sup> See in *Re Heurtel's Design*, above, p. 71.

(*g*) 16 Eq. 117.

(*h*) 9 R. P. C. at p. 211.

obvious that it is only where the servant is employed by the master for the purpose of designing, and the design is applicable to the articles manufactured by the employer, that the inventions of such servant belong to the master; and that where the servant is not employed as a designer, or where, though he is employed as a designer, the design is applicable only to some article of a totally different kind from that manufactured by the employer, then in such cases the design would remain the property of the servant and would not become the property of the master. For example, if the cashier of a lace manufacturer invented a design for lace, or if the designer of such lace manufacturer invented a design for a candle shade, it could hardly be maintained that the employee had executed the work on behalf of his master for good and valuable consideration, and there would be no reason for supposing that in either of these cases the design would become the property of the employer merely by virtue of the relations of master and servant existing between the manufacturer and the inventor of the design. In each of these cases, it is conceived, the design would remain the property of the servant, who would be entitled to register it.

It would seem from the wording of sect. 47, sub-sect. 1, and sect. 103, sub-sect. 1, and from the analogy of patent law, that a design known abroad may be registered and protected in England by any person as being the "author" of the design, subject to the possibility of his registration being ousted by a subsequent registration of the design on the part of some person who has applied for protection thereof abroad (*i*). Under the patent law the person who introduces a new invention into this country is considered "the first and true inventor" thereof (*k*); and though there does not seem to be any case on the point as regards designs, probably a person introducing a design from abroad would be considered the "author"; this would appear to be in concordance with the principles on which monopolies are granted by the Crown (*l*).

(i) See pp. 49, 50, *post*.

(k) See *Re Curcz*, 6 R. P. C. p. 553; and cases cited there.

(l) See Edmunds on Patents (2nd ed.), pp. 266, 267. The judgment in the case of *Lazarus v. Charles*, cited on p. 46, *post*,

seems somewhat opposed to this view; but it will be noticed that the plaintiffs did not argue the question of their being the "authors" of the design, but based their claim on the ground of having acquired the design.

(B) **Purchaser or licensee.**—A person who has, for good or valuable consideration (*m*), acquired a new design or the right (whether exclusive or otherwise) to apply such design, can register the design, or if it is already registered can register himself as proprietor to the extent of the interest acquired by him (*n*).

But in order to be able to register the design he must acquire the actual property in the design itself or the right to apply the design, otherwise the registration will be invalid.

In the case of *Lazarus v. Charles* (*o*), where the plaintiff had bought an article in Germany and registered the design in England, it was held, on his bringing an action for infringement, that he was not the proprietor of the design within the meaning of 5 & 6 Viet. c. 100, and that consequently the registration was bad. Sir R. Malins, in his judgment, said: "Here it is admitted that the plaintiffs are not the designers of the article, and though they stated in the original bill that they were the designers, a different version is given of the plaintiffs' right in their subsequent affidavit, and it now turns out that they saw the design in a shop at Frankfort, and that they brought it over to this country; but they state that they entered into an agreement with the manufacturer at Frankfort that they would purchase their baskets from him. This shows at once that the plaintiffs are not entitled to any merit of invention; they only did as anyone else might do, that is, they purchased the articles, but they gave no consideration to entitle them to be the proprietors of the design under the terms of the Act, for the agreement to purchase the articles from the manufacturer can form no consideration within the meaning of the statute. Therefore they are not the designers of the article, nor are they entitled to be the proprietors by virtue of having purchased the design for valuable consideration. That is in my opinion a fatal objection to the plaintiffs' title."

A person who acquires the sole right of selling goods manufactured according to a registered design does not therefore become a "proprietor" of the design within the meaning of sect. 61

(*m*) Apparently, therefore, the proprietor of a design could not make a gift of it to another person so as to entitle that person to register as proprietor.

(*n*) See sects. 55 (1) and 61. A licence may be granted for applying a design to certain articles only.

(*o*) 16 Eq. 117.

of the Act of 1883, nor become entitled to register the design as proprietor under sect. 47. This principle is exemplified by the following cases :—

In the case of *Jewitt v. Eckhardt* (*p*) the plaintiff agreed to purchase for a lump sum from an American manufacturer named Crandall the exclusive right to sell in England toys manufactured according to a then unpublished design, and also to obtain such protection for the same as he could under English law. The vendor was not to sell any toys made according to that design for this country, except to the plaintiff; and the plaintiff, on the other hand, was not to manufacture the toys, but to purchase all he required from Crandall. There was no agreement in writing between the parties. The plaintiff, on the receipt of the first case of toys, registered the design under 5 & 6 Vict. c. 100. In an action for infringement against the defendant, who had purchased the toys from the American manufacturer, it was held by Jessel, M. R., that the plaintiff had not acquired under the contract the right to apply the design to a manufactured article so as to enable him to register it in his own name, and that the action must be dismissed.

In the similar case of *Re Guiterman's Registered Design* (*q*) the facts were as follows :—In May, 1885, Guiterman, who was acting as the sole agent and consignee in the United Kingdom during the year 1885 of toys manufactured in the United States by an American company and consigned to him by them, registered in his own name the design in accordance with which some of the toys were manufactured. The company had authorized him to register the designs in his own name, but had not assigned to him the designs, or the right to apply them to goods, the only arrangement between Guiterman and the company being that he should sell in the United Kingdom goods manufactured and consigned to him by the company. It was held by Pearson, J., that Guiterman was not the proprietor of the design within the meaning of sect. 61 of the Act of 1883, and that the registration in his name was therefore wrongful and must be expunged (*r*).

In these cases nothing more was intended to pass than the sole

(*p*) 8 Ch. Div. 404.

(*q*) 55 L. J. Ch. 309.

(*r*) See also *per* Lawrance, J., in *Woolley v. Broad*, [1892] 1 Q. B. p. 810.

right to *sell the goods* in England in the one case, and in the United Kingdom in the other. It was not intended that the right to *apply the design* should pass; that was in each case reserved to the manufacturer. There was nothing to prevent the design being registered in the name of the manufacturer, but as this was not done in either case, and as the design was not assigned to the person who registered it, the registration was rightly held to be bad.

An assignment of the copyright in a design or a licence to apply the design should apparently be in writing. This was laid down in *Jewitt v. Eckhardt* (s) which was decided under sect. 6 of the Act of 1842, but the law would appear to be still the same (t).

Apparently also an assignment or licence cannot be registered by the assignee or licensee before the proprietor himself has registered (u).

In the case of co-owners one proprietor cannot by himself grant a licence (x).

(C) **Devolution of design.**—The copyright in a design is personal property and devolves like any other property (y). If the proprietor of a design dies or becomes bankrupt before registering the design, the right to register devolves upon his personal representative or the trustee in bankruptcy as the case may be (z). If the design is already registered the copyright in the design devolves in the same way.

A licence to apply a design may devolve in the same way, or in any manner provided for by the instrument granting the licence.

**Foreigners.**—There is nothing in the Act of 1883 to prevent foreigners from registering designs under it. The Act of 1861 (24 & 25 Viet. c. 73, s. 1) expressly provided that the Designs Acts should extend to any proprietor whether or not a subject of her Majesty. That Act was repealed by the Act of 1883, which contains

(s) 8 Ch. Div. 404.

(t) See *per* Wright, J., in *Woodley v. Wood*, 9 R. P. C. p. 212.

(u) See *per* Jessel, M. R., in *Jewitt v. Eckhardt*, 8 Ch. Div. p. 410; and see sect. 87 of the Act of 1883, and rule 21.

(x) See *Powell v. Head* (a dramatic copyright case), 12 Ch. 686.

(y) See sects. 61 and 87 of the Act of 1883.

(z) See *per* Jessel, M. R., in *Jewitt v. Eckhardt*, above, p. 409.



no similar provision; but as the word "proprietor" is used in sect. 61 without any limitation, it seems clear that a foreigner may register a design equally with a British subject (*a*). This right is quite distinct from the right of registration under the provisions of sect. 103 (*b*). Foreigners must, after registering a design, take care to comply with the provisions of sects. 51 (*c*) & 54 of the Act of 1883, or the copyright will be forfeited (*d*).

**Corporation.**—A body corporate may be registered as "proprietor" by its corporate name (*e*), as "person" includes a body corporate (*f*).

**Infants and lunatics.**—There is nothing to prevent the grant of copyright in a design to an infant or lunatic. If through infancy, lunacy, or other inability, any person is prevented from doing anything either required or permitted by the Act, sect. 99 provides that his guardian or committee, or if none, any person appointed by any Court or judge possessing jurisdiction in respect of the property of incapable persons may do the necessary thing in his name and on his behalf (*g*).

**Priority of registration under sect. 103 (*h*).**—When arrangements have been made with any foreign State for the mutual protection of designs, any person (*i*) who is applying for protection for any design in any such State is entitled to register his design in priority to other applicants, if he applies for registration within four months from his applying for protection in such foreign State (*k*). In such a case, the copyright can only be granted to the

(*a*) See *per* Webster, A.-G., in *Re Carez*, 6 R. P. C. 552; and see also Article II. of the International Convention, p. 183, *post*.

(*b*) See below.

(*c*) See p. 57, *post*.

(*d*) See p. 115, *post*.

(*e*) Designs Rules, 1890, rule 26; *cp.* also *per* Pearson, J., in *Guiterman's Design*, 55 L. J. Ch. p. 311.

(*f*) Sect. 117 of the Act of 1883.

(*g*) See also Designs Rules, 1890.

rule 29, as to discretion of Comptroller, with the sanction of the Board of Trade, to dispense with the doing of any act or the production of any evidence under certain circumstances.

(*h*) See also p. 122, *post*.

(*i*) This includes a foreign corporation. See *per* Webster, A.-G., in *Re Carez*, 6 R. P. C. 552.

(*k*) 1883, sect. 103 (*i*), amended by 1885, sect. 6. For list of such foreign States, see Appendix A. (1).

person who has made the foreign application and in his own name (*l*). The section is not confined to foreigners, so that an English subject who has made a foreign application can avail himself of the provisions of this section.

This provision may be applied with any variations or additions, by Order in Council, to any British possession the legislature of which has made satisfactory provision for the protection of inventions, designs, and trade marks patented or registered in this country (*m*).

It may be noticed that the priority given by this section is a priority over other *applicants*; and it seems doubtful whether registration could be obtained under this section if a copyright had already been completely granted to another person (*n*).

If an application is made in a foreign State prior to the date of the Order in Council applying sect. 103 to that State, the foreign applicant has priority over a person applying for registration here before the date of the Order in Council but subsequently to the foreign application (*o*). But it may be noticed that of late years the Orders in Council applying sect. 103 to a foreign State or colony have always contained a clause providing that each Order shall take effect, so far as regards patents, at the expiration of seven months, and so far as regards designs and trade marks, at the expiration of four months from the actual date of the Order; so that no application for registration in this country made before the actual date of an Order in Council can now be ousted by a foreigner as a consequence of that Order.

(*l*) See *per* Webster, A.-G., in *Re Shallenberger*, 6 R. P. C. 550; *cp. Re Carrez*, above.

(*m*) 1883, sect. 104. For list of such

British possessions, see Appendix A. (2).

(*n*) See in *Re Main's Patent*, 7 R. P. C. 13.

(*o*) *Ibid*.

## CHAPTER IV.

## MARKING.

SECT. 51 of the Act provides that before delivery or sale of any articles to which a registered design has been applied, the proprietor of the design must cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered; and if he fails to do so the copyright in the design ceases, unless he shows that he took all proper steps to ensure the marking of the article. By Rule 32 of the Designs Rules, 1890, as amended by Rule 5 of the Rules of 1893, the "prescribed mark" is, in the case of articles in Classes 13 or 14 (*a*), the abbreviation "Regd.," and in the case of articles in Classes 1 to 12 (*a*) the abbreviation "Rd.," and also, in the case of articles in these latter classes other than lace, the number appearing on the certificate of registration.

The mark is usually stamped or impressed on the article to which the design is applied, but in the case of articles such as lace, which would be injured by the mark being applied directly to them, the mark is usually made on a label attached to the article, or on the packet in which the article is contained (*b*). Sect. 4 of the Act of 1842 provided that either method might be adopted in the case of any article. The Act of 1883 contains no special provision as to the method of marking, so, presumably, either method is allowable.

The important thing is that there should be some mark on the article when it reaches the purchaser, so that he may know that the design is registered (*c*). If the mark is afterwards removed

(*a*) See p. 174, *post*.

(*b*) See *Blank v. Footman, Pretty & Co.*, 5 R. P. C. p. 569, and p. 55, *post*; and *cp.* in *Hothersall v. Moore*, 9 R. P. C. 27.

(*c*) See *per* Lord Campbell. C. J., in *Heywood v. Potter*, 22 L. J. Q. B. p. 136; *per* Lord Herschell in *Heath v. Rollason*, 15 R. P. C. p. 445.

by the purchaser this does not affect the proprietor (*d*), even, it is thought, if the purchaser were subsequently to sell the article again, as this is quite beyond the control of the proprietor.

It is the proprietor of the design who has to see that each article is marked before sale. In the case of co-owners, the default of one proprietor will bind the others and they will all lose the copyright (*e*).

There seems to be some difficulty in the case where a proprietor has granted a licence to apply the design and the licensee has omitted to mark the articles. Such a licensee is, to a limited extent, a proprietor, and can register himself as proprietor to that extent (*f*). But he is not really a co-owner, and it would be hard if a proprietor were at the mercy of a licensee who could cause the copyright to be forfeited by selling unmarked articles. Under the corresponding section (sect. 4) of the Act of 1842, only the person who failed to comply with the Act lost the benefit of the Act, but the Act of 1883 contains no such provision. It is, however, suggested that if the proprietor, in granting the licence, stipulates that all articles made by the licensee shall be properly marked before sale, and otherwise does his best to ensure that the articles shall be properly marked, he would be protected by the proviso at the end of the section if the licensee failed to mark, and that the licensee alone would lose the benefit of the Act. This view seems to be supported by the arguments and judgment in the case of *Wedekind v. The General Electric Co., Limited* (*g*), where considerable stress was laid on the fact that the proprietors acquiesced in the granting to the defendants of a licence in which no stipulation as to marking was contained.

**Sale by agent.**—The words “delivery on sale” apply to a sale by the lawfully authorised agent of the proprietor as well as to a sale by the proprietor himself (*h*).

(*d*) See per Sir J. Romilly, M. R., in *Sarazin v. Hamell*, 32 Beav. p. 152; *op. per* Coleridge, J., in *Hegwood v. Potter*, 22 L. J. Q. B. p. 137.

(*e*) See per Charles, J., in *Wedekind v. The General Electric Co., Ltd.*, 14 R. P.

C. p. 200.

(*f*) See sect. 61, and p. 46, *ante*.

(*g*) 14 R. P. C. 130; see particularly pp. 192, 203, 205.

(*h*) *Ibid.* p. 205.

With reference to the marking itself there are two principal points to be noticed :—

- (a.) The marking must be done before the delivery on sale of the article.
- (b.) Each article must be marked.

**Delivery on sale.**—As to what constitutes “delivery on sale” for the purposes of this section the principal case is *Woolley v. Broad (i)*. In that case John Woolley, a lace manufacturer, one of the plaintiffs, had entered into a verbal agreement with A. H. Woolley & Co., lace finishers, the other plaintiffs, to submit to the latter all designs which he might acquire or invent for their approval. If they approved of the designs, A. H. Woolley & Co. were to register them in the name of John Woolley, the parties sharing the expense. It was further agreed that in the case of every design so registered John Woolley should manufacture for A. H. Woolley & Co. and for no other person, and A. H. Woolley & Co. should give orders to John Woolley and to nobody else, John Woolley turning over the goods in the “brown” or unfinished state to A. H. Woolley & Co. to be finished into white lace and made ready for the market. It was also further agreed that before selling any of the goods in the finished state A. H. Woolley & Co. should mark them with the registered mark. In pursuance of this agreement John Woolley delivered lace in the brown made in accordance with a registered design to A. H. Woolley & Co. to the value of £250, for which the latter duly paid, but no mark was put upon the goods by John Woolley before delivery of them to A. H. Woolley & Co. On the plaintiffs bringing an action for infringement against the defendant, the latter contended that the lace should have been marked before delivery to A. H. Woolley & Co., and that through neglecting to mark the lace the copyright in the design had been lost. The plaintiffs on the other hand contended that delivery on sale did not apply to the delivery of an unfinished article such as lace in the brown which, as was shown by the evidence, was never sold retail, and which had to go through several processes in the course of finishing, so that if a ticket with

(i) 9 R. P. C. 429.

the registration mark had been put upon the lace it would have been destroyed in the process of finishing. It was proved, however, that a large trade in lace in the brown existed between manufacturers and finishers. It was held by Coleridge, L. C. J., that the delivery of lace in the brown by John Woolley to A. H. Woolley & Co. was a "delivery on sale" within the meaning of sect. 51 and that the lace should have been marked, and that as this had not been done the copyright was lost.

It appears from this case that if a registered design is applied to an article and that article is sold by the manufacturer to a purchaser, then, even if the purchaser has to pass the article through a further process before it is ready for sale to the public, there has been a "delivery on sale" within the meaning of sect. 51. In the case in question the lace in the brown was complete; nothing had to be done to it to complete the application of the design. The finishing was a mere process by which the lace was made ready for sale to the public, and might be compared to dyeing, which of course does not affect the design (*k*). The design had, in fact, been applied to the article, although the article itself was in an unfinished state.

If, however, as is sometimes the case, one firm finishes for another firm and returns the finished article to the first firm—the manufacturing firm—then there would apparently be no "delivery on sale" till the article had been returned to the manufacturer (*l*).

**Each article must be marked.**—Only articles which are to be sold need be marked. Under the Acts of 1842 and 1843 *every* article of manufacture to which a registered design was applied had to be marked. Under the present Act patterns or samples may be exhibited or given away, though unmarked, without forfeiting the copyright.

If the article is sold in long pieces or strips, it is only necessary to mark each piece or strip. But if before sale the article is

(*k*) It may be noticed, however, that in the case of *Mallet v. Howitt* (W. N. (1879) 107, it was held that the "finisher" had "caused to be applied" the registered design, within the mean-

ing of sect. 7 of the Act of 1842, *sed quære*.

(*l*) See *per* Lord Coleridge, L. C. J., in *Woolley v. Broad*, above, p. 434.

divided, then each separate piece becomes an "article to which a registered design has been applied" and must be marked.

In the case of *Hegwood v. Potter* (*m*), which was decided under the Act of 1842, the plaintiffs were the registered proprietors of a design for paper-hangings, which were usually sold in lengths of 12 yards. These lengths were properly marked, but the plaintiffs had been in the habit of selling small pieces as patterns without properly marking them. It was held that these pieces were "articles of manufacture" within the meaning of the Act and that the plaintiffs had failed to comply with the requirements of the statute (*n*).

In the case of *Hothersall v. Moore* (*o*) the plaintiff had registered a design for dusters under Class 13 as piece goods. The goods were woven in pieces consisting of 12 squares marked off, one from the other, by threads woven across the piece, each square being intended to be cut from the rest and to be used as a duster; and it appeared from the evidence that the proprietor himself was cutting up the pieces into individual dusters, and having them hemmed and prepared for sale. He, however, marked the goods by gumming a small ticket, with the letters Regd. upon it, on one only of the dusters forming each piece of 12. It was held by Bristowe, V.-C., that the goods were not sufficiently marked, as each square ought to have been separately marked.

The judgment of the V.-C. in that case (*p*) seems to go as far as this: that even if the goods had only been actually sold in the lengths of 12 squares, still, as it was clearly intended that each square should be immediately cut off and used separately, each such square should be marked. This would appear to be the right view, as in such a case each square would in reality be a separate article of manufacture, displaying the whole of the registered design.

In the case of *Blank v. Footman, Pretty & Co.* (*q*), where a narrow trimming was sold by the maker in pieces of 144 yards, each piece having round it a paper band bearing the proper mark, it was held that the trimming was sufficiently marked. In his judgment, Kekewich, J., said: "It has not been argued that the

(*m*) 22 L. J. Q. B. 133.

(*o*) 9 R. P. C. 27.

(*n*) Cp. *per* Field, J., in *Fielding v.*

(*p*) See at p. 39.

*Hauley*, 48 L. T. (N. S.) p. 640.

(*q*) 5 R. P. C. 633.

trimming itself ought to be marked, and it would be impossible to say where and how often it should be marked. It is obvious that you could not mark every quarter of an inch, and that even if you could do it, you could not in lace work like this preserve the thing, if you were to stamp it with marks. Therefore it is not suggested that this ought to be done, but it is said that every article, however small, ought in some way to show that it is a registered design. That to my mind is entirely a misconstruction of the 51st section. The Act may or may not go far enough, but the Act says that a mark is to be placed before delivery on sale of any articles to which a registered design is to be applied. The marking is to be caused to be done by the proprietor of the design. If the proprietor of the design does not sell those articles of dress to which the trimmings are affixed, the section lays no liability upon him to mark those articles of dress. What is to be marked by him is the article to which a registered design has been applied—that is the trimming. If he sells it in pieces of 144 yards, he must mark the pieces of 144 yards. If on the other hand he sell small pieces, whether for patterns or for use, he must mark each small pattern in some manner in which those things can be conveniently marked, as, for instance, by tying on a label or by printing something on the packet in which it is. But he is not bound to mark anything but that which he sells, and that is the exact consequence of the case of *Heywood v. Potter* which was cited to me on behalf of the defendant. There the Court held, that whether it was a small piece or a large piece you must mark the piece sold; and so I say, you must mark the piece sold and not mark anything else.” The distinction between such a case as this and *Hothersall v. Moore*, above, is sufficiently obvious.

Where a butter-dish consisted of two parts, viz., a dish and a cover, and the dish was legibly stamped with the registration mark, but there was not, nor ever had been, any such mark upon the cover, which was separate and apart from the dish and not in any way attached thereto, and moreover the whole of the registered design was upon the cover, the dish having only a roughened edge, and any of the covers containing the design could be used with any of the dishes interchangeably or with any other dishes of the same shape and design, nevertheless it was held that the article was



sufficiently marked, the grounds of the decision being that the butter-dish, although consisting of two parts, was in reality one article, and that of the two parts the dish was the principal and was therefore properly marked (*r*).

Where copies of a registered design were published in a book for sale, it was held that it was not necessary to affix to such copies any registration mark (*s*).

**Articles sold abroad.**—Articles to which a registered design has been applied, even if sold abroad, must be properly marked, or the copyright will be lost (*t*). Even if the proprietor of the registered design is a foreigner, this fact will not excuse him from strict compliance with the Act (*u*).

**Wrong marks.**—In *Heinrichs v. Bastendorff* (*r*), the plaintiff had registered a design in Classes 1, 3, and 12, and marked the articles made in accordance with his design with the letters Regd. instead of the letters Rd. (*y*). It was held in that case that the copyright was not thereby lost, apparently on the ground that the greater would include the less. But the point does not seem to have been seriously argued, and it is suggested that the decision was questionable. The mark Regd. might quite possibly in some cases cause a purchaser to infer that the design was registered in Class 13 or 14, and not in any other class, and might therefore lead him to infringe by applying the same or a similar design to articles in one of those other classes, which he would be quite entitled to do if the design was really registered in Class 13 or 14; and on the other hand might prevent him from applying the design to articles in Class 13 or 14 although as a matter of fact entitled to do so (*z*). Again, the section says that each article must be marked with “the prescribed mark or the prescribed word or words or figures,” and the statute should be construed strictly (*a*); under Rule 32 of the Designs Rules the prescribed word for articles in Classes 1—12 is “Rd.,” as

(*r*) *Fielding v. Hawley*, 48 L. T. (N. S.) 639.

(*s*) *De la Branchardière v. Elvery*, 18 L. J. Ex. 381.

(*t*) *Sarazin v. Hamell*, 7 L. T. (N. S.) 660.

(*u*) *Ibid.*

(*v*) 10 R. P. C. 160.

(*y*) See p. 51, *ante*.

(*z*) See p. 80, *post*.

(*a*) See *per Giffard, V.-C.*, in *Pierce v. Worth*, 18 L. T. (N. S.) 710.

distinguished from "Regd." which is the prescribed word for articles in Classes 13 and 14. A wrong *number* would clearly render the copyright liable to forfeiture (*b*), and wrong words would be even more misleading. In the case of *Heath v. Rollinson* (*c*), Lord Herschell in his judgment speaks of the necessity for a proprietor to make out a case for relief if there is any "error in complying with the exact requirements of the section as to the figures or words to be put upon the articles." It is thought, therefore, that a proprietor might incur forfeiture by putting Regd. instead of Rd. just as much as by putting Rd. instead of Regd.

**Marks accidentally omitted.**—It is easily understood that cases may arise where the goods or articles made in accordance with a registered design are by inadvertence sold without having been properly marked. In such cases the proprietor will be protected by the proviso in sect. 51, if he can show that he took all proper steps to ensure that no articles were sold without the proper registration mark having been put upon them.

Where the proprietor of a registered design for a china lamp, known as the "Owl" lamp, sent to the manufacturers in Germany the proper die for stamping the mark on the lamps which were to be manufactured according to the design, and the manufacturers by inadvertence marked some of the lamps with a mark which belonged to a design for a china menu stand registered by the same proprietor, the copyright of which had then expired, using by mistake the old die which remained in their possession (the letters Rd. formed part of both marks), and the proprietor sold some of the lamps so wrongly marked without observing the error, it was held that the proprietor was protected by the proviso in sect. 51 and that the copyright in the design was not forfeited (*d*).

But it is not sufficient for the proprietor to show that he gave orders that no article should be sold unless properly marked, unless he can also show that proper means were taken to ensure his orders being carried out. In the case of *Johnson v. Bailey* (*e*),

*b*) See *per* Lindley, M. R., in *Re Engstrom's Design*, 11 R. P. C. p. 913, where the copyright was only saved from forfeiture by the proviso at the end of sect. 51.

*c*) 15 R. P. C. 411.

*d*) *Wattman v. Oppenheim*, 27 Ch. Div. 260.

*e*) 11 R. P. C. 21.

the plaintiff registered designs for earthenware teapots. The teapots were made in a mould, in the bottom of which there was a hollow parallelogram with the letters and numbers embossed upon it. When a teapot was made in such a mould the result was that there was upon the bottom of the teapot a raised parallelogram or tablet with the letters raised thereon. The mould was liable to wear out, and so fail to produce a distinct mark. The plaintiff gave orders to see that all proper registration marks were duly made on the teapots, but he took no precautions to see that his orders were obeyed, nor were all the teapots examined for this purpose before being sent out. On bringing an action against the defendant for infringement, the latter produced three teapots which were not properly marked, but which had merely a raised parallelogram or tablet with some inequalities thereon, which could not be deciphered. Lord Low, the Lord Ordinary, held that the tablet alone did not constitute sufficient marking, and that the plaintiff, in order to secure that no teapot was issued which was not impressed with the registration mark, ought either to have seen that the moulds were not used after the tablets became so worn as not to convey to the teapots a distinct impression of the mark, or to have inspected every teapot before it was issued, and that as he had neglected to do this he had not taken all proper precautions to ensure the marking of the goods, and that consequently the copyright was lost (f).

This decision may appear to be somewhat inconsistent with the *obiter dictum* of Mr. Justice Field in the case of *Fielding v. Hawley* (g). In that case the judge said that supposing articles had to be fired in the course of manufacture, and had been properly marked before being fired, and in the course of firing the marks on some of them became illegible, he would be very slow to say that the proprietor was thereby deprived of the protection of the statute. But the two cases are really quite distinguishable. It is clear that in the case put by Mr. Justice Field the illegibility of the mark would be quite outside the control of the proprietor, who had taken every precaution to ensure the proper marking of the article, and it would

(f) Cp. also *Wedekind v. The General Electric Co., Ltd.*, 14 R. P. C. 190.

(g) 48 L. T. (N. S.) 639.

be manifestly unjust to punish him for what could only be considered as a pure accident (*h*). In the case of *Johnson v. Bailey* (above) the proprietor knew that the moulds were liable to wear out, and so fail to mark the teapots properly, and should have taken care to see that defective moulds should not be used, and that teapots if not properly marked should not be sold (*i*).

No definition of general application can be given of the meaning of the words of the statute "all proper steps to ensure the marking of the article." Every case must be judged according to its merits, and it is in each case a question for the jury whether or not all proper steps have been taken (*k*). But where the registration mark is altogether omitted or obliterated, the proprietor must make out a stronger case for relief than if there is merely some error in complying with the exact requirements of the section as to the figures or words to be put upon the article (*l*).

If a proprietor has granted a licence for application of the design, and the licensee sells articles to which the design has been applied without properly marking them, the proprietor would probably be protected under the proviso, if he has stipulated in the licence that all articles made by the licensee must be properly marked before sale (*m*).

**If properly marked, additional wrong marks immaterial.**—If the proprietor of a design, in addition to properly marking his goods, puts on registered numbers which ought not to be there, he does not thereby lose his copyright, at any rate if there was no intention to deceive the public. In the case of *Harper & Co. v. Wright & Butler Lamp Co.* (*n*) the plaintiffs had registered a design for a stove (which was the subject of litigation) and had subsequently registered further designs for handles for the stove and for a cover

(*h*) See also *Re Rollason's Registered Design*, 11 R. P. C. 893 and (on appeal) 909; and in the House of Lords, 15 R. P. C. 411, where a "5" was accidentally substituted for a "3" in the registration number.

(*i*) See per Lord Herschell, in *Heath v. Rollason*, 15 R. P. C. p. 418, commenting on *Johnson v. Bailey*.

(*k*) Per Lord Low, in *Johnson v. Bailey*, 11 R. P. C. p. 24.

(*l*) Per Lord Herschell, in *Heath v. Rollason*, above, p. 417.

(*m*) See in *Wolekind v. The General Electric Co., Ltd.*, 14 R. P. C. 190, and p. 52, *ante*.

(*n*) 12 R. P. C. 483.

to the stove—a particular pattern of ornamentation of the cover—and they had first of all, on stoves which they had sold, put the registered number of the original design, and also put the registered numbers of the designs which they had registered subsequently as applicable to particular parts of the stove. The defendants contended that this was misleading, and that the public would not know to what those numbers referred; and that if the lid was a new registered lid, then they ought not to have put on the number of the original design, because that was a different design. On this point Lord Herschell, in giving judgment, said (p. 491): “There is nothing in the Act of Parliament which deprives a person, who has registered a design, of his right to protection and to prevent infringement of it, if he puts on articles that he sells registered numbers which ought not to be there. If he sells without putting on the registered number of a design which is within his registration, then no doubt he loses his protection; and it may sometimes be a difficult question to know exactly what numbers he ought to put on, and on what parts of the articles sold, and it is only natural that a person who has registered designs should err on the side of caution, because if he does not put the number on he certainly loses his rights. But there is no clause in the Act of Parliament which deprives him of his rights if he, even mistakenly, puts numbers on the articles which he sells which have no business there. Now, whatever might be the case if a person were fraudulently to put numbers on with a view to misleading the public it is unnecessary to say, but it appears to me to be a most hopeless contention to suggest that a person owning registered designs, who in the course of his business may sell some articles with registered numbers on which should not be there, thereby, without any such provision in the Act of Parliament, loses his rights as a registered proprietor. If the Courts were so to hold they would be making the law, they would not be interpreting it.”

**Falsely representing a design to be registered.**—Section 105 of the Act of 1883 provides that any person describing a design applied to an article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not

exceeding £5, and that for the purpose of that enactment a person shall be deemed to represent that a design is registered if he sells the article with the word "registered," or any word or words expressing or implying that a registration has been obtained for the article, stamped, engraved, or impressed on, or otherwise applied to the article (a).

(a) See p. 147, *post*.

## CHAPTER V.

## INFRINGEMENT.

THE 58th section of the Act of 1883, as slightly amended by sect. 7 of the Act of 1888, enacts that:—

“During the existence of copyright in any design—

“(a) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply or cause to be applied such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural; and

“(b) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.”

The words “or cause to be applied” were added after the word “apply” by the Act of 1888.

The words “or obvious,” after the word “fraudulent,” in sect. 58, did not occur in the corresponding section (*a*) of the Act of 1842. As will be seen later (*b*), an imitation of a registered design may be fraudulent without being obvious, or obvious without being fraudulent, and either of these elements is sufficient to bring an imitation within the statute; while, on the other hand, a design may resemble a registered design to a certain extent without being either a fraudulent or an obvious imitation.

(*a*) Sect. 7.

(*b*) See p. 72, *post*.

A design may therefore be infringed in any of the following ways :—

A. [under sub-sect. (a)].

If a person during the existence of the copyright in a registered design—

Applies or causes to be applied for purposes of sale	{ to any article of manu- facture, or to any sub- stance, artificial or natural, or partly artificial and partly natural,	{ (1) the registered design itself, (2) any fraudulent imitation, (3) any obvious imitation,	{ in the class or classes (c) of goods in which such design is re- gistered
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without the licence or written consent of the proprietor of the registered design.

B. [under sub-sect. (b)].

If a person during the existence of the copyright in a registered design—

(1) Publishes ;	{ any article of manufacture, or	{ (1) the registered design itself,
(2) Exposes for sale (d)	{ any substance to which has been applied	{ (2) any fraudulent imitation, (3) any obvious imitation,

knowing that the same has been so applied without the consent of the registered proprietor.

Sub-sect. (a) applies to *manufacturers* who apply piratical designs to articles of manufacture ; sub-sect. (b) to *sellers* of such articles. In the former case the mere manufacture of such articles for the purposes of sale without the licence or written consent of the proprietor is an infringement ; in the latter case, actual knowledge by the seller of the articles that the design has been applied to them without the consent of the registered proprietor must be proved (e).

Sub-sect. (b) says nothing about actual “selling” ; but sect. 59, which gives a remedy by damages for infringement, speaks of “publication, sale, or exposure for sale” ; and the omission of the word “sells” in this sub-section does not appear to have any practical effect, as a sale would necessarily have the effect of a publication.

(c) A design may be registered in more than one class ; see p. 118, *post*.

(d) In a patent case (*Minter v. Williams*, 4 A. & E. 251) in 1835, it was held that

“exposure for sale” was not the same as selling. This is provided against by this section.

(e) See pp. 88, *seq.*, *post*.



**"Cause to be applied."**—In the case of *Mallet v. Howitt* (*f*), where the defendant was not the manufacturer, but a lace merchant who bought the undressed lace from manufacturers and then had it dressed and completed ready for sale, it was held that he had "caused to be applied" the registered design (*g*).

In the case of *Potter v. Braco de Prata Printing Co.* (*h*) which was an action for infringement of registered designs for printing calicoes, the defendants manufactured and bleached the cloth in this country and the rollers for printing were engraved with the design in this country, but the actual printing was done in Portugal. It was contended that this was a case of "causing to be applied" because everything was done in this country except the actual application of the design to the fabric (*i*); but the Court held that there was no infringement within this country.

**Purposes of sale.**—Under the provisions of sub-sect. (a), the application of the design must be for purposes of sale; therefore if a person applies a copyrighted design to an article for his own use or amusement no action would lie under this sub-section, though of course if he were subsequently to publish it or expose it for sale, he would render himself liable under sub-sect. (b). In this respect there is an important difference between designs and patents (*k*).

Sub-sect. (a) applies to the case of registered designs being applied to goods at any time during the existence of the copyright, even where it is not intended that the goods should be sold till after the term of protection has expired. In the case of *McCrae v. Holdsworth* (*l*) which was decided under the corresponding section (*m*) of the Act of 1842, Knight-Bruce, V.-C., granted an injunction against such manufacture, as well as against the sale of the articles, and the articles complained of were ordered to be given up to the plaintiff to be destroyed.

Section 58 forbids the unauthorized manufacture and sale of not only articles to which a registered design has been applied, but

(*f*) W. N. (1879) 107.

(*g*) See, however, *Woolley v. Broad*, [1892] 1 Q. B. 806, and p. 84, *post*. In that case, under similar circumstances, it was held that the lace merchants were not "proprietors," because they had no

right to apply the design.

(*h*) 8 R. P. C. 218.

(*i*) See at p. 222.

(*k*) See p. 130, *post*.

(*l*) 2 De G. & Sm. 456.

(*m*) Sect. 7.

also articles to which a "fraudulent" or "obvious" imitation of such design has been applied.

In considering cases of "imitation" it will be found that the same considerations often arise as in cases of "novelty," but in a more limited degree, the point being not whether the design attacked is *absolutely* novel, but only whether it is novel so far as regards the particular design which is said to be infringed. For instance, if A. registers a design in 1890 and B. registers another design in 1891, then if A. moves to expunge B.'s design from the register on the ground of want of novelty (*n*), A. need only show that B.'s design is not really novel, that it is like *some* previous design; but if A. brings an action for infringement, he must show that B.'s design is like *his own*, and an imitation of it. With this restriction, the cases on novelty (*n*) may be referred to in questions of imitation, in addition to the cases quoted in this chapter.

**Obvious imitation.**—An "obvious" imitation may be defined as an imitation which, while not being an exact copy of the registered design (for then it would practically be the registered design itself) is so like it that one design might easily be mistaken for the other. If a design is an "obvious imitation" of a previously registered design, the later design is an infringement even if made quite independently and in entire ignorance of the registered design (*p*). The practical result of this is that the proprietor of a registered design obtains a monopoly not only of the design he has registered, but of any design closely resembling it.

In deciding whether an imitation is "obvious" or not the appeal is to the eye. In the case of *Barran v. Lomus* (*q*), Jessel, M. R., said: "Now it has been said, and it is a fair observation to make, that when you come to try a case of piracy the first point to be considered is whether the similarity or dissimilarity strikes the eye." And similarly Lord Westbury in the case of *Holdsworth v.*

(*n*) See the chapter on "Rectification of the register," pp. 102, *seq.*, *post*.

(*o*) Pages 22—33, *ante*.

(*p*) See *per* Lord McLaren, in *Waller, Hunter & Co. v. Hecla Foundry Co.*, 5 R. P. C. p. 73; *per* Lord Shand (in the same case on appeal), 5 R. P. C. p. 368. Rule 35 of the Designs Rules enables

any person to ascertain whether a particular design intended to be applied to goods in a particular class is identical with, or an obvious imitation of, any registered design applied to such goods of which the copyright is still subsisting; see p. 128, *post*.

(*q*) 28 W. R. p. 975.

*McCrea* (r): "Now in the case of those things as to which the merit of the invention lies in the drawing or in forms that can be copied, the appeal is to the eye, and the eye alone is the judge of the identity of the two things; whether, therefore, there be piracy or not is referred at once to an unerring judge, namely, the eye, which takes the one figure and the other figure and ascertains whether they are or not the same" (s). But these remarks must be taken together with, and as somewhat modified by, the remarks of Chitty, J., in *Grafton v. Watson* (t): "As to the meaning of the word 'obvious,' the Act clearly does not mean that which is obvious at a glance to the uneducated or unskilled eye; it means obvious to the judge or to a jury with the assistance of experts—persons conversant with the particular trade. In the case of *Mitchell v. Henry* (u), the late Master of the Rolls used his own eyes without the assistance of evidence and declined to hear the evidence, but the Court of Appeal over-ruled his decision so far as it depended on that principle, and heard the evidence" (x).

Lord Herschell in his judgment in the case of *Hecla Foundry Co. v. Walker, Hunter & Co.* (y) added another qualification to the test: "It seems to me, therefore, that the eye must be the judge in such a case as this, and that the question must be determined by placing the designs side by side and asking whether they are the same, or whether the one is an obvious imitation of the other. I ought, perhaps, to qualify this by saying that as a design to be registered must, by sect. 47, be 'a new or original design not previously published in the United Kingdom,' one may be entitled to take into account the state of knowledge at the time of registration, and in what respects the design was new or original, when considering whether any variations from the registered design, which appear in the alleged infringement, are substantial or immaterial." In the later case of *Harper & Co. v. Wright & Butler Lamp Manufacturing Co.* (z), Lord Herschell quoted the above words and added: "Now here the two designs have been placed side by side,

(r) L. R. 2 II. of L. at p. 388.

(s) Cp. per Romer, J., in *Birkin & Co.*

(t) See also per Kekewich, J., in *Demartial & Co. v. Booth*, 9 R. P. C. p. 502.

v. Pratt, *Hurst & Co.*, 12 R. P. C. p. 373.

(y) 6 R. P. C. p. 559.

(u) 50 L. T. (N. S.) p. 422.

(z) 12 R. P. C. p. 488; and [1896]

(v) 15 Ch. Div. 181.

1 Ch. p. 146.

the eye has been left to judge, and the impression produced upon all the members of the Court has been . . . that in all their essential features they are alike and that in those essential features they differ, both of them, from anything previously known. Now, better proof than that, that the one design is an obvious imitation of the other, it seems to me, it would be impossible to give."

In comparing a registered design with an alleged piratical design, with the object of seeing if one is an obvious imitation of the other, the designs should be looked at not only side by side, but also apart, and under the conditions subject to which they would usually be seen. In the case of *Grafton v. Watson* (*a*), Chitty, J., said: "The test is not merely to look at the two designs side by side, though, no doubt, that is one element of comparison in coming to a conclusion, but it is not the whole test. I think the designs should be looked at together, but then consideration should be given to what would be the effect supposing that they were seen at different times, or supposing they were looked at a little distance off (*b*). . . . It should be considered, also, how the patterns would look when worn as a dress or an apron, or used as a covering for furniture."

Too much stress should not be laid upon differences of detail if the two designs are substantially alike (*c*).

A mere difference of size between two designs is not of itself material in a question of infringement (*d*); but, of course, differences in the sizes of the relative parts of the designs may assist in making the two designs substantially different.

As colour cannot be the subject-matter of a design (*e*), differences of colour are also immaterial (*e*), except possibly where the registered design has been registered by sample (*f*). In some cases, a similarity of colour between two designs may tend to show that the later design was copied from the earlier one (*g*).

(*a*) 50 L. T. (N. S.) p. 424.

(*b*) See also the judgment of Smith, L. J., in *Harper & Co. v. Wright, & Co.*, 12 R. P. C. p. 433.

(*c*) Per Lord Herschell in *Harper & Co. v. Wright, & Co.*, above, at p. 489; per Hall, V.-C., in *Novell v. Bennett & Sons*, 15 R. P. C. p. 417.

(*d*) See per Chitty, J., in *Walker & Co.*

*v. Scott & Co.*, 9 R. P. C. p. 486; and in *Grafton v. Watson*, 50 L. T. (N. S.) p. 423, quoted on p. 70, *post*.

(*e*) See p. 6, note (*b*), *ante*.

(*ee*) *Novell v. Bennett & Sons*, above, p. 417.

(*f*) See p. 76, note (*d*), *post*.

(*g*) See per Robinson, V.-C., in *Knowles & Co. v. Bennett & Sons*, 12 R. P. C. p. 143.

It is, of course, quite impossible to lay down any rules for deciding what amount of resemblance will make one design an "obvious imitation" of another; it must always be a question of fact in each case. But as illustrating the method of comparing two designs, and as an instance of how one design may differ from another in its details and yet be so similar as to be an "obvious imitation," it may be useful to set out here at some length a part of Mr. Justice Chitty's judgment in the case of *Grafton v. Watson* mentioned above (*h*).

"The plaintiff's design and the defendant's are well contrasted in the exhibits which have been placed before the Court. One of the plaintiff's designs consisted of an acorn and spray, in which the acorn may be termed the dominant and the spray the subservient. The acorns and spray are detached. There is a remarkable edging to both the leaves and spray and the acorns, and there is a band of a lighter colour which surrounds the edges in part. When I speak of colour I am aware that colour cannot be the subject-matter of design; but where you look at the application of the design and the nature of the fabrics to which it is intended to be applied, it is right to see how the design is worked out in point of practice. The defendant's design contrasted with the acorn pattern consists of what is termed in the defence a mangosteen, and the mangosteen has a contour which closely resembles the contour of the acorn; and as the acorn, which in patterns of this kind is more or less a conventional acorn, is divided into two parts, viz.: that which represents in a conventional way the cup, and that which represents the acorn itself, I find the same two divisions produced in the mangosteen pattern.

(*h*) See also the judgment of Lord Herschell, in *Harper & Co. v. Wright, &c. Co.*, above. It may be useful also to examine the illustrations of the plaintiffs' and defendants' designs (at p. 223, *post*) in the case of *Sherwood & Cotton v. Decorative Art Tile Co.* (1 R. P. C. 207, where the defendants' design was held to be a "fraudulent," but not an "obvious," imitation; and those given in 12 R. P. C. p. 372, in the case of *Birkin & Co. v. Pratt, Hurst & Co.* (a lace case), where it was held that the defendants'

design was not an obvious imitation of the plaintiffs' design; in 13 R. P. C. p. 490, in the case of *Oliver & Co. v. Thornley & Co.* (also a lace case), where the defendants' design was held to be a very clear infringement; and in 14 R. P. C. pp. 169, 170, in the case of *Farley v. Keighley Ironworks Society, Ltd.* See also the illustrations in 11 R. P. C. p. 894, and in [1888] 1 Ch. p. 238, in *Re Rollason's Design*, where the question was one of "novelty."

There is something which closely resembles the cup of the acorn, and at the top of the mangosteen there is a sprout which again resembles more or less closely the top of the acorn. The mangosteens are about the same size as the plaintiff's acorns, and the arrangement of the two is very nearly identical. I do not mean to say that if the one design was placed over the other the figures would occupy the same places, but they coincide very nearly, and in cases of this kind it would be wrong to treat the question as one of exact measurement. The plaintiff's sprays are probably oak leaves or something of that kind, and the acorns are detached. The defendant has filled in his ground between the mangosteens with sprays, which closely resemble the sprays in the plaintiff's designs, and there is this remarkable feature that the sprays are also detached and in no sense form a continuous part of the mangosteen. The defendant has stated that he took his mangosteen from an old design which was one of the exhibits, and, no doubt, he is right; but the rest of the figures in the design from which he took it are as unlike those in his design as can well be conceived. The sprays are different entirely. There is a continuity in the leafy part of the one which is not found in the other, and the resemblance between the defendant's and the plaintiff's designs consists in the points I have already mentioned, viz., in the distribution of the parts, the filling up of the ground, and the general effect. The test is not merely to look at the designs side by side, though, no doubt, that is one element of comparison in coming to a conclusion, but it is not the whole test. I think the designs should be looked at together, but then consideration should be given to what would be the effect supposing they were seen at different times, or supposing they were looked at a little distance off. It appears to me, adopting the language of the plaintiff's witnesses, that viewed in either of these ways the imitation is obvious. It should be considered, also, how the patterns would look when worn as a dress or an apron, or used as a covering for furniture, and I have very little doubt that a person going into a room and seeing them so used would say, as the plaintiff's witnesses here said, that there is such an imitation as to make it impossible to distinguish by memory alone the one from the other."

**Fraudulent imitation.**—A very clear definition of fraudulent imitation is given in the judgment of Cotton, L. J., in *Grafton v. Watson* (i): “Fraudulent imitation, to my mind, must mean this: if a man, knowing that the pattern is a registered design, goes and imitates it, and does that without any sufficient invention on his own part, that would be a fraudulent imitation, if in fact it is an imitation (k). There may be an imitation which is unconscious—that is to say, not an imitation in the sense of copying—producing of the same effects without knowing of the registered design; but when the registered design is known, then, if there is imitation, the burden of proving that the registered design was not copied is, to my mind, thrown on the person who produces the pattern like that which is imitated. It is not fashion or anything of that sort which is to be protected; the design is to be protected. In my opinion there is here a *prima facie* case of imitation (l), and without such further explanation as may be given by the defendants, such *prima facie* case is, in my opinion, within the meaning of the Act, a fraudulent imitation.”

It may be useful to compare the remarks of Jessel, M. R., in *Barran v. Lomas* (m): “I now come to the next words ‘fraudulent imitation.’ As I understand it, the Act does not prohibit imitation. The design itself being open to such great varieties, a fair imitation—that is to say, something to which the idea of the original design has been applied—is not prohibited. To take an illustration from architecture, I suppose, though a man could not take either Teutonic capitals or the Greek capitals, the Act would not prevent his using the composite capitals. And therefore it seems to me that you must look at the thing itself to see if it is a fair imitation. But that is not all. The word ‘fraudulent’ ought to have a definite meaning. It must be something more than imitation. As I understand it the meaning is *imitation with knowledge*, that is, that the man who imitates has seen the first design. It is not unconscious imitation, which is said to be the greatest compliment you can pay to an artist or author, but conscious imitation,

(i) 51 L. T. (N. S.) p. 144.

(k) Even if not an *obvious* imitation; see p. 72, *post*.

(l) It was proved that the defendants' designer had seen the plaintiffs' designs before preparing his own.

(m) 28 W. R. p. 974.

the man having the design before him and knowingly and wilfully imitating, and that design being, as I said before, not sufficiently original to be protected as a fair imitation."

"Fraudulent" but not "obvious" imitation.—It will be seen from these cases that the fact of a person having seen and worked on the registered design of another is strong *prima facie* evidence of "fraudulent imitation"; and a design may be invalid as a fraudulent imitation even if it is not *obvious*. In *Sherwood & Colton v. Decorative Art Tile Co.* (*n*), Manisty, J., said: "The conclusion that I have arrived at is that it is not an obvious imitation (*o*). If so, it resolves itself into the single remaining question whether it is a fraudulent imitation. I think the word was introduced for the very purpose of meeting the case of an imitation, not an obvious imitation, but an imitation varied for the purpose really of perpetrating what is a legal fraud." And the learned judge held that the defendants' design *was* a fraudulent, though not an obvious imitation. But of course the design impeached as piratical must be an imitation in some way; there must be some real similarity between the two designs (*p*); and even the fact of having worked on a registered design would not invalidate the later design (though forming a *prima facie* case against it) if the two designs are *substantially* different (*q*). In the case of *Thom v. Syddall* (*r*) an injunction was refused, though it seems to have been admitted that the defendants had seen and worked on the plaintiff's design, Wickens, V.-C., saying: "I am bound to say that the designs complained of seem to me different as wholes from those of the plaintiff—substantially and not colourably different." Compare also Kekewich's judgment in *Demartial & Co. v. Booth* (*s*), which was an action for the infringement of a registered design for a dinner set. "Mr. Aston says: 'We know that they had our dish before them and were aware of it, and no doubt they imitated in

(*n*) 4 R. P. C. p. 210.

(*p*) Illustrations of the plaintiffs' and defendants' tiles are given at p. 223, *post*.

(*q*) See *per* Lord Watson, in *Hecla Foundry Co. v. Walker, Hunter & Co.*,

6 R. P. C. p. 556.

(*q*) See the judgments in the cases of *Grafton v. Watson* and *Barran v. Lomas*, quoted on the preceding page.

(*r*) 20 W. R. 291.

(*s*) 9 R. P. C. p. 502.



the sense of wishing to rival them and bring out something which would attract public attention and become fashionable.' That of course may be conceded . . . It is for the defendants, according to him, to explain, when once the similarities are established, the want of good faith on their part. 'It is not,' he says, 'my business to show the presence of bad faith.' I demur to that, unless you establish such similarities as of themselves constitute an infringement. I have not those similarities here for the reasons I have already mentioned."

**Where design registered by sample.**—If a design is registered by a pattern or sample of the design without any accompanying description defining the part or parts claimed as new or original (*t*), the design as a whole, but only as a whole, is protected. In the case of *Holdsworth v. M'Crea* (*u*), M. had registered a pattern of his design without any accompanying description, the design consisting of six pointed stars on an Albert chain arranged in a particular manner and shaded. M. in his particulars in the action claimed "the particular collocation of the shaded and bordered stars upon the ornamental chain surface, as shown in the registered pattern, thus forming together the ornamentation of the woven fabric." Lord Westbury in giving judgment said that where a design had been so registered by the proprietor "all that he can claim to protect against imitation is, that thing in its exact form and relative position and proportions as they appear upon his pattern. For that is the only thing that you can ascribe to him as an invention. He says: 'I substitute the drawing for any description.' . . . Anything, therefore, which is a facsimile of that drawing, any other pattern which is a reproduction of that in its integrity, becomes an infringement. But that which is different in shape and form, or in the relative positions of the several parts, which is not a reproduction of it, as a replica or copy of a picture, would not be an infringement of the thing so specified."

In the subsequent case of *M'Crea v. Holdsworth* (*x*) (in respect of the same matter), Lord Hatherley, L. C., said: "It has been argued that when a design of this kind is registered, and the

(*t*) See p. 117, note (*d*), *post*.

(*u*) L. R. 2 H. L. 380.

(*x*) 6 Ch. 418.

designer, instead of describing the design in words, chooses to place the design itself upon the register in the shape of a part of the article designed, then he is tied down to that identical design so exhibited, and is not at liberty to complain of any person making a thing which is to all outward appearances exactly the same, and which for all purposes for which the thing is manufactured is identical. And it has been argued that if the person who exhibits a design for all practical purposes identical with the registered design is astute enough, as in this case, to turn what is called a star in the opposite direction upon the pattern, though it is of exactly the same dimensions and effect to the eye, he may do so with impunity. The question appears not to have been raised at the trial, where the judge and the jury considered the articles as identical for the purpose for which they were made; and I imagine that the observations made by some of the learned Lords were intended to say merely that the design could be protected only as it was represented; and the learned Lords considered that the question whether there was any difference in the effect would be left to the jury. Their Lordships seem to have meant that the designer is not bound, as in a patent case, to distinguish the new from the old, and is allowed to register his pattern without distinguishing the new from the old; but if he chooses to put it in that way, it will not be protected as against the public in case they choose to use any portion in any manner substantially differing from the registered design. If the designs are used in exactly the same manner, as I hold they are in this case, and have the same effect or nearly the same effect, then of course the shifting or turning round of a star, as in this particular case, cannot be allowed to protect the defendant from the consequences of the piracy." And similarly in the case of *Grafton v. Watson* (y), Cotton, L. J., said: "Undoubtedly in the course which the plaintiffs have adopted, they having registered a piece of their goods, all they can claim is that entire design." In the original case of *M'Crea v. Holdsworth* (z), Erle, C. J., said: "Every part of that which is registered, and nothing but the combination, is the thing that is before the public . . . It is the combination that forms the design in this specimen . . . I am

(y) 51 L. T. (N. S.) p. 144.

(z) L. R. 1 Q. B. 264.

clearly of opinion that if a person copied the star by itself, or the chain pattern by itself, though each were new, no action would lie against him by the person who has registered the design. The stars, the collocation of the stars, and the placing of them on an Albert ground, is the design, and if a person chooses to follow that exact (*a*) combination, an action lies against him."

As further explaining this point it may be useful to quote the comments of Wickens, V.-C., on these cases in *Thom v. Syddall* (*b*) "The precise question which was determined after so much litigation, was that a design, however complex, might become private property by the registration of a sample. It was strongly urged that if a design consisting of various parts, new and old, is registered by sample, without anything to disclaim what is old and point out what is new, future designers are put to a most unfair and unreasonable disadvantage, since they cannot tell what is sought to be protected and have thus the unfair onus thrown upon them of finding out what is really claimed, and avoiding that in future designs. To this all the Courts successively seem to have given the same answer: 'It is not thrown upon you to find out what is or is not claimed; *all* is claimed, not the separate parts, of which nine-tenths may be new or not, but the whole as one thing.' No exclusive right is claimed to any design which is not, as one design, substantially connected with that shown by the sample registered. It seems to me, I confess, that the difficulty raised about the registration of a complex design could have been solved in no other way. . . . Nothing whatever was said by him (*c*) to throw doubt on the general proposition, common alike to the judgments of the Exchequer Chamber and to the speeches of Lord Chelmsford and Lord Westbury in the House of Lords, that the whole design is claimed when the registration is by sample, and that when there is no reproduction of the whole design, there is no infringement; but that there may be a reproduction of the whole design, notwithstanding small variations in particular parts of it. Supposing a design in stars arranged in a complicated series of

(*a*) The imitation need not be *exact*, if the effect produced is the same or nearly the same; see Lord Hatherley's remarks, above; and Wickens' remarks, below.

(*b*) 20 W. R. p. 291.

(*c*) *I.e.*, the Lord Chancellor, in giving judgment, L. R. 6 Ch. 419.

interlacing and recurring curves, so as to produce a striking and pleasing effect to the eye, and the design to be registered by a sample showing the design in five pointed blue stars on a white ground, a design with six pointed stars in the same arrangement would probably be an infringement; a design with black stars instead of blue might perhaps be an infringement (*d*); but a design of rosebuds in the very same arrangement, or of mere circular rings in the very same arrangement, would, I am inclined to think, be no infringement. The proprietor of the registered design might say: 'The real merit, attraction, and novelty in my design is in the series of curves in which the elements of the design, whatever they may be, are arranged; everything else in my design is well-known, obvious, and unattractive.' The answer would be: 'If you had claimed that, you might possibly have protected it. But you have claimed a great deal more, and you cannot now disclaim the rest of it for the purpose of putting a subsequent design in the wrong.'"

The principles laid down in these cases may be summarized shortly, thus: Where a design is registered by pattern or sample without any accompanying description defining the part or parts claimed as new or original (*c*), the design *as a whole*, as represented in the pattern or sample, is protected, if otherwise valid; but any part of the design (whether such part be new or old) may be used by itself or in combination with some other design without thereby infringing the copyright, or all the component parts of the design may be used together, as long as they *produce a different effect*. If the general effect of the original design is reproduced exactly or very closely, that will constitute an infringement even if some of the component parts have been altered. It is the general effect, and the general effect only, which is protected in these cases; and the proprietor cannot, after registration, disclaim any part of the design so registered so as to protect the residue by itself (*f*). In the

(*d*) A mere difference in colour would not by itself prevent a design from being an infringement; see p. 68, *ante*; but in the illustration here given, if a different effect were produced by the change of colour, this might possibly be no infringement; *see quare*.

(*c*) No regular specification, as in patents, is required or allowed; but a short technical description may be given when necessary; see p. 117, note (*d*), *post*.

(*f*) Cf. *per* Wills, J., in *Smout v. Newpark*, 7 R. P. C. p. 91.

case of *Barran v. Lomas* (g), where the plaintiff registered a design in braid by sending in a photograph of a child's jacket with the ornamental braid applied to it as trimming, Jessel, M. R., expressed his opinion (though in that particular case the point was not of importance) that if anyone applied the design to a pair of trousers there would be no infringement; and that in similar cases it would be prudent for the persons registering to expressly show on the register that they do not wish to claim the jacket (or whatever article it may be), but that it is merely put there as an illustration; otherwise the braid could not be claimed as apart from the jacket. In the case of *Harper & Co. v. Wright & Butler Lamp Manufacturing Co.* (h), in which the plaintiffs were successful, the order as originally drawn provided that the defendants should be restrained from infringing the plaintiffs' registered designs "or any part thereof." Before the order was finally settled the defendants applied to strike out the words "or any part thereof" on the ground that what the plaintiffs were declared entitled to protect were the designs as a whole; and the Court acceded to the application.

**Object of a design not material in question of infringement (i).—** In considering whether a design is a piracy of a registered design, it is quite immaterial to consider whether or not the later design accomplishes the same object or purpose as the original design. In the case of *Hecla Foundry Co. v. Walker, Hunter & Co.* (k), the original design was registered for the shape of a kitchen-range fire-door with a moulding on the top which had the effect of closing the range to the cold air; and the defendants manufactured a range fire-door with a moulding on the top which had the same effect. It was there held that the Court of Session (l) were wrong in taking into consideration the question whether the defendants' fire-door accomplished the same useful object as the previous design. (Both Courts decided that the later design was as a matter of fact an obvious imitation.) Lord Herschell in giving judgment said: "In the present case the applicant declared that

(g) 28 W. R. 973.

(h) 12 R. P. C. p. 496.

(i) See also pp. 32, 33, *ante*.

(k) 6 R. P. C. 554.

(l) 5 R. P. C. 71 and 365.

it was for the 'shape' that he desired registration. Under the designs part of the Act of 1883, I do not think the object which the designer has in view in adopting the particular shape, or the useful purpose which the shape is intended to serve, or does serve, ought to be regarded in considering what is the design protected. The scheme of this part of the Act is entirely different from that relating to patents for inventions, where the object attained by the invention for which the patent is granted is, of course, very material to the inquiry, what is its subject-matter, and whether there has been an infringement. I cannot agree, therefore, that the registration was claimed, or could be claimed, 'not for the particular moulding,' but for the form given by placing 'any suitable moulding' upon a fire-door in the described position, or that a privilege was granted 'for putting a moulding upon a fire-door in such a manner as to accomplish' a particular object. I think the protection was granted for the shape, and for that alone, and that in such a case, when an infringement is alleged, the only question is, whether the shape of that which is impeached is the same, or whether the one is an obvious imitation of the other, without reference to whether it does or does not accomplish the same useful end. I quite agree with what was said by Lord Shand in *Walker v. Falkirk Iron Co. (m)*, that 'the Act in this branch gives protection only to the shape or configuration, or to the design for the shape or configuration, in such a case as the present. The result of such protection may be, however, to secure important advantages, such as attend a mechanical contrivance, if these advantages should be the result, directly or indirectly, of the shape or configuration adopted.' But this is a mere incident. If such advantages are obtained, it is only because no shape not substantially the same, and which is therefore not an infringement, will achieve the same end. The test of infringement must always be, whether the shape is or is not the same. If it be, then the exclusive privilege has been infringed, even though the same object be not accomplished; if it be not, then, though the object be accomplished, there has been no infringement. In the present case, for example, by a very slight deviation from the design,

(m) 4 R. P. C. p. 393.

which would scarcely be apparent, the air might be admitted to the fire. I do not think that a person making such a fire-door could successfully answer the complaint that he had infringed the rights of the proprietor of the design by showing that, when applied to a range, it would not exclude the air."

Similarly, Lord Watson in giving judgment in the same case said: "The person registering acquires no exclusive right, except to the shape and configuration of his design. If his design should be calculated to serve some useful purpose, it is nevertheless open to every member of the public to attain the same end by using an article which differs from it in shape and configuration. . . . Accordingly, the only relevant consideration in any question of infringement is, whether the article complained of is a copy or a fraudulent or obvious imitation of the registered design."

It is also quite immaterial in a question of infringement whether or not the later design is more useful than the earlier design; the mere fact of its being more useful will not prevent it from being an infringement, unless the later design itself is substantially different from the earlier one (*o*).

**Where design is new only in some particular part.**—A design may be valid within the Act although only one particular part of it is new or original, the rest being old, provided that the new part is sufficiently important to give a stamp of originality or novelty to the whole (*p*). But the design is only protected as a whole, and in such a case there is nothing to prevent another person from manufacturing articles according to the same design with the omission of the particular new feature.

In the case of *Walker & Co. v. A. G. Scott & Co.* (*q*), which was an action for the infringement of the design for an oil-can for cyclists, it was proved that the only novelty in the plaintiffs' design was having rounded edges instead of sharp edges, and that the defendants' can had not these rounded edges. Chitty, J., in giving judgment for the defendants, said: "What is protected by the Act is the design as a whole. . . . Supposing a design was registered for a bottle of the ordinary shape in all respects except

(*o*) See p. 32, *ante*.

(*p*) See p. 31, *ante*.

(*q*) ? R. P. C. 482.

the neck, which was twisted, it is plain the proprietor of the design could not prevent other persons from making ordinary bottles without twisted necks."

**No infringement by application in different class.**—A design may be registered in more than one class (*r*), and if so registered will be protected in each class (*s*). But the proprietor of the design cannot bring any action for infringement against any other person for applying the same or a similar design to articles in other classes; such an application would not be an infringement, as copyright in a design only extends to the classes in which it is registered (*t*). And this is the case even if those articles are of the same kind as the articles in the classes of registration; for instance, a design for a lamp shade in the shape of a rose, made in linen, and registered for application to articles in Class 12, would not be infringed by its application to a lamp-shade in china, which is an article in Class 4 (*u*). In the case of *Re Read & Gresswell's Design* (*x*), Chitty, J., in the course of his judgment remarked: "No doubt the copyright that is conferred by the Act of Parliament (I take the 60th section) is a copyright only in respect to the goods comprised in the class in which registration takes place, and it is clear upon that section as well as on the 58th section which gives a special remedy by procedure for penalties—it is clear upon these two sections, and indeed upon the Act generally that upon a question of infringement the person who is registered in one class could not proceed against an infringer who is only infringing outside the class for which the registration exists. That is because the man who is on the register has knowingly confined his claim to a particular class of goods; and in doing that he tells the rest of the world that they may with impunity manufacture goods according to the design, or use the design in any lawful manner upon goods not within the class."

It may be noticed that in sect. 59 (which gives a remedy by

(*r*) Sect. 47 (1) of the Act of 1883.

(*s*) The protection extends to all articles within the classes of registration, even if different to those to which the design is usually applied; see sects. 58 [a] and 60.

(*t*) See sects. 58 [a] and 60.

(*u*) But if the design, or a similar one, is registered by another person for application to similar articles in a different class, this registration may be expunged. See pp. 20 *seq.*, *ante*.

(*x*) 6 R. P. C. 471.



damages as an alternative to the remedy by penalty given by sect. 58) the words appearing in sect. 58 "in the class or classes of goods in which such design is registered" do not occur. The words are, "damages arising from the application . . . to *any* article of manufacture or substance"; so that at first sight it might appear that the proprietor of a registered design could proceed for damages under sect. 59 against a person infringing even outside the class in which the design is registered, though he clearly could not proceed for penalties under sect. 58. But the remedies are alternative (*y*), and it is clear from the wording of the two sections that they are intended to apply to exactly the same offences, namely, the offences defined in the first part of sect. 58 (*z*).

**Where design registered in wrong class.**—It is not quite clear what is the effect, in an action for piracy of a registered design, of the design having been registered in the wrong class; *i.e.*, what protection is given to a design so registered. In an old case, *Loundes v. Browne* (*a*), decided under the Act of 1842, it seems to have been thought that if a design was registered under a wrong class, that would not justify the pirating of it; but the Act of 1842 did not confine the copyright to the class or classes of registration, as is the case under the Act of 1883 (*b*), so that the same considerations did not arise, and as a matter of fact the Court held that the design had been registered in the right class. In the more recent case of *Mothersall v. Moore* (*c*), where the plaintiff had registered a design under Class 13 ("printed or woven designs on textile piece goods"), and applied it to goods which, though woven in the piece, were so sub-divided in the pattern by cross lines as to show that they were intended to be sold not by measurement but by number, it was held (*d*) that these goods fell properly within Class 14 ("handkerchiefs and shawls"); that the registration of the plaintiff's design in Class 13 was ineffectual to protect him for such goods, but would protect him for goods worked out as a piece.

(*y*) See p. 88, *post*.

(*z*) See also the definition of copyright in sect. 60.

(*a*) 12 Ir. L. Rep. 293.

(*b*) See p. 80, *ante*. The chief importance of the division into classes

under the Act of 1842 was, that different classes had different periods of protection.

(*c*) 9 R. P. C. 27. The facts are briefly stated at p. 55, *ante*.

(*d*) See at p. 38.

The Vice-Chancellor pointed out that in order to avoid any difficulty the plaintiff might have registered under both classes, and so ensured his desired protection. It would appear from this decision that a registration in a wrong class has practically no different effect to a registration in a right class; in either case the design is protected in the class of registration and is not protected in any other class. The wording of sect. 47, sub-sects. 3, 4, and 5, seems to point to the same conclusion. An applicant can register a design in any class he likes; if he is doubtful as to the proper class, having in view the goods to which he wishes to apply the design, he can make himself safe by registering in any class in which they might be included; or he may leave the question to be decided by the Comptroller. It seems probable, from the wording of sub-sect. 5, that the decision of the Comptroller on this point would be final. The Comptroller can, in any case of doubt or difficulty, apply to either of the law officers for directions (*e*).

**Copyright confined to United Kingdom.**—The copyright conferred upon the proprietor of a registered design does not extend beyond the United Kingdom and the Isle of Man, and no action for infringement will lie against any person, even if he is a British subject, who sells, or applies, or causes to be applied a registered design in a foreign country (*f*). The design can only be infringed by the production or sale in the United Kingdom or the Isle of Man of goods bearing the design; and where a plaintiff had registered a design for printing calicoes, and the defendants manufactured and bleached the cloth in this country, and the rollers for printing were engraved with the design in this country, but the actual printing was done in Portugal and the goods were sold abroad exclusively, it was held that there was no infringement within this country and that no action would lie (*g*).

Where, under the provisions of sect. 103 of the Act of 1883, as amended by sect. 6 of the Act of 1885, a person registers a design with a date prior to the date of actual registration (*h*), he cannot recover damages for infringements happening prior to the date of actual registration (*i*).

(*e*) Sect. 95.

(*f*) *Potter & Co. v. Braco de Prata Printing Co.*, 8 R. P. C. 218.

(*g*) *Ibid.*

(*h*) See p. 122, *post*.

(*i*) Sect. 103 (1). It seems clear that he could not recover a penalty either, though the section only speaks of damages.

## CHAPTER VI.

## REMEDIES FOR INFRINGEMENT.

SECTION 58 of the Act of 1883, after prohibiting the piracy of registered designs, proceeds to enact that: "Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding £50 to the registered proprietor of the design, who may recover such a sum as a simple contract debt by action in any Court of competent jurisdiction." This is amended by sect. 7, sub-sect. 2, of the Act of 1888, which enacts that: "To the same section [sect. 58 of the Act of 1883] the following words shall be added: 'Provided that the total sum forfeited in respect of any one design shall not exceed £100.'"

Section 59 enacts that: "Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication sale or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application."

**Only registered proprietor can sue.**—The remedies for infringement provided by sects. 58 and 59 are given to the registered proprietor (*a*) only, and no person who does not answer that description can sue under either section. A person who has obtained an exclusive licence to sell goods to which a registered design has been applied has no right of action in case the design is

(*a*) As to who is a "proprietor" of a design, see sect. 61 of the Act of 1883, and pp. 42 *et seq.*, *ante*.

infringed, even though it is upon him that the loss falls, for he cannot be registered as proprietor (*b*). In the case of *Woolley v. Broad* (*c*), where the registered proprietor and a company having an exclusive licence to sell goods to which the design had been applied brought a joint action for infringement, the registered proprietor claiming an injunction and penalties, and the licensees claiming damages, it was held that the licensees had no right of action. Lawrance, J., in giving judgment, said: "The action is brought by John Woolley and A. Herbert Woolley & Co. John Woolley is the owner and registered proprietor of two registered designs applicable to lace goods, and he has made a verbal contract with Herbert Woolley and Co. to supply to them, in its unfinished state, all the lace manufactured by him according to the designs. Herbert Woolley & Co. are to have the sole right to sell the goods when finished. The question is, have they any right to sue the defendants under the circumstances of this case? I am of opinion that they have not. As I understood the argument of the plaintiffs' counsel, it was that any person might sue who could show that he had been injured by an infringement of the registered proprietor's copyright in a design. I think that proposition is too wide. The case in my judgment turns entirely upon sects. 58 and 59 of the Patents, Designs, and Trade Marks Act, 1883, which point out what is to be done in the case of a piracy of any registered design." (The learned judge then read those sections.) "Here the plaintiffs H. Woolley & Co. are seeking to recover damages arising from the defendant having applied the registered proprietor's designs to lace goods, and for having manufactured and sold the goods to which the designs had been so applied. I am of opinion that the only right to sue is that given by the Act, and the right is clearly confined by the terms of sect. 59 to the registered proprietor. There can be no doubt that the registered proprietor has a right to sue; and I should think, though I give no decided opinion upon the point, that if he has made a contract by which he himself becomes liable to pay damages to the person with whom he has contracted, he would be entitled to recover these damages from a person who had infringed his copyright.

(*b*) See p. 46, *ante*.

(*c*) [1892] 1 Q. B. 806.

“Our attention was called to sect. 61; but that section, in my opinion, does not touch this case. It is meant to apply to cases like that of a servant who executes a new and original design for his master, and then the person for whom the design is made is to be considered the proprietor. In *Jewitt v. Eckhardt* (d) the plaintiff bought from an American manufacturer the exclusive right to sell in England an article designed and manufactured by the American manufacturer. Jessel, M. R., held that the plaintiff, not having the right to apply the design to any article, because the right to manufacture was expressly retained by the American manufacturer, did not become in any sense the proprietor of the design; that he therefore was not entitled to be registered as proprietor of a new and original design within 5 & 6 Vict. c. 100, and was not entitled to restrain the defendant from infringing the copyright in it. Here it is clear that Herbert Woolley & Co. had no right to manufacture the lace goods to which the design was applied. The sole right to manufacture and the ownership of the designs were both in the hands of John Woolley; and it appears to me that H. Woolley & Co. stand in no other position than that of any outside persons who have made a contract with the registered proprietor, who is manufacturing for them, and against whom they may or may not have a right of action for permitting such a piracy of his design as to injure them, having regard to that contract. I am of opinion that they have no right of action because they are not the registered proprietors of the design.”

It will be seen, therefore, that it is very desirable for a person who is interested in the sale of articles bearing a registered design, but cannot get registered as “proprietor” (such as an exclusive licensee for sale), to stipulate that the registered proprietor shall bring actions against any persons infringing the design and obtain injunctions against them; otherwise he may find himself suffering heavy loss from the piracy of the design, without being able to stop the piracy or having any remedy.

A person who has a licence (whether exclusive or not) to *apply* the design, can register himself as proprietor and can then sue for infringement (e).

(d) 8 Ch. Div. 404.

(e) See p. 46, *ante*.

Even a person who is a proprietor within the meaning of section 61 of the Act of 1883 (*f*) must be actually registered as such before he can sue. It seems probable, however, that an unregistered proprietor (*g*), though unable to pursue the statutory remedies under sects. 58 and 59, might nevertheless obtain an injunction against an infringer; for the remedy by injunction is available quite apart from any statute (*h*). And, if the piratical design is registered, any person aggrieved can apply to have the registration expunged (*i*).

**Statutory remedies.**—A registered proprietor whose design has been infringed, has, under the Act, the choice of two remedies against the wrongdoer (*k*)—

(a.) He can bring an action to recover a penalty under sect. 58.

(b.) He can bring an action to recover damages under sect. 59.

The limitation of the penalty to £100 by the Act of 1888 clearly only applies to any one action in respect of any one design. A subsequent infringement would be ground for a further penalty (*l*).

It must be noticed that an action under sect. 58 is for a penalty by way of penalty, and therefore quite distinct from an action for damages as under sect. 59. This was decided in the case of *Saunders v. Wiel* (*m*), both in the Divisional Court and in the Court of Appeal. Therefore an action under this section is subject to the rules of practice, evidence, &c., which apply to actions for a penal sum as distinct from an action for damages (*n*).

The full penalty need not necessarily be inflicted, and in the absence of circumstances of aggravation a nominal penalty is

(*f*) See pp. 42, *seq.*, *ante*.

(*g*) Apparently this would be so even in the case of a person who is not a "proprietor" at all, as in *Woolley v. Broad*, above; see *Cooper v. Whittingham*, 15 Ch. Div. 501, and p. 92, *post*.

(*h*) See *per* Jessel, M. R., in *Cooper v. Whittingham*, above.

(*i*) See pp. 91, 92, 107, *post*.

(*k*) As to the choice of remedy, see p. 88, *post*.

(*l*) See *per* Cave, J., in *Saunders v. Wiel*, 9 R. P. C. p. 470. "Under the circumstances I think I must give a

nominal penalty, which, if further piracy goes on, would be a very good ground for increasing it in a subsequent case." It may be noticed that the penalty-imposing section (sect. 8) of the Act of 1842 contained a very clear proviso as to this: "but the aggregate amount of penalties for offences in respect of any one design committed by any one person, up to the time at which any of the proceedings herein mentioned shall be instituted, shall not exceed the sum of 100*l*."

(*m*) 9 R. P. C. 459.

(*n*) See p. 131, *post*.

frequently imposed. Mr. Justice Cave, in giving judgment in the case of *Saunders v. Wiel* (o), said: "What sum of money ought I to give by way of judgment? This is a penalty. That has been decided in this very case. It is an action for a penalty, and the maximum sum is £50 for each occasion. Now a penalty is punishment, and punishment is to be awarded in proportion to what it is that the offender has done, and no doubt if he has done it under circumstances of aggravation the punishment ought to be heavier. If he has done it under circumstances of mitigation the punishment ought to be lighter, and in one of the cases which has already been decided on this statute, the Court has drawn attention to that circumstance, and said that where the piracy results from accident or mistake, then the judge may reduce the penalty; the judge has the power of reducing the penalty to a merely nominal one, and in that way of not confounding the innocent with the guilty. In this case no circumstances of aggravation have been brought before me at all. On the other hand there are no circumstances of mitigation. The defendant has not shown me that the resemblance was accidental, or that it was due to a mistake; he has not shown me the extent to which he has used it, and that he has stopped its further use or anything of that kind. Therefore I am left by both parties entirely in the dark as to how I should limit this penalty." Two cases of infringement were proved, and the judge decided to impose a nominal penalty of 20s. in each case (p).

**Damage not considered in imposing penalty.**—In imposing a penalty under sect. 58, the amount of damage which the plaintiff has sustained should not be taken into consideration; it is not even necessary to prove that any damage has actually been sustained, the circumstances under which the infringement was committed being alone material. In the above case, in the Court of Appeal (q), Lord Esher in giving judgment said: "The expression 'a sum not exceeding £50' has been relied on, and it is said that the plaintiff must prove the amount of damage that he has sustained, as he would have to do in an action for damages.

(o) 9 R. P. C. 467.

(q) [1892] 2 Q. B. p. 322.

(p) Cp. *Oliver & Co. v. Thornley & Co.*, 13 R. P. C. p. 500.

The true intention of the section seems to me to be that those words as to the amount to be recovered do not apply to the damage sustained by the plaintiff, but to the conduct of the defendant, which the jury may take into consideration. For example, in the case of infringement by accident or through a mistake, the jury might assess the penalty to be recovered at a less sum than the statutory limit of £50."

**Choice of remedy.**—The remedies under these two sections (58 and 59) are alternative, not cumulative; the proprietor cannot sue for a penalty as well as an infringement (*r*), and if he frames his statement of claim in such a way that it is doubtful which remedy he is pursuing, he can be compelled to make an election (*s*). In cases where the piracy has been a deliberate one, but the damage actually sustained is small, the proprietor should bring his action for a penalty under section 58. If, however, he has sustained damage to a greater amount than the maximum penalty, he should sue for damages under sect. 59, especially if the piracy has been an innocent one. If he has made a contract under which he is liable to pay damages to a third party (such as an exclusive licensee for sale) in consequence of the infringement, he would probably be entitled to recover those damages from the infringer (*t*).

**Action against seller.**—It must be noticed that when the act complained of is the publishing, selling, or exposing for sale a piratical article, the plaintiff in bringing an action for infringement, either under sect. 58 or sect. 59, must prove that the defendant knew that the design had been applied without the consent of the registered proprietor. The Act of 1842 (sect. 7) provided that no person should publish, &c. any article, &c. "after having received, either verbally or in writing, or otherwise from any source other than the proprietor of such design, knowledge that his consent has not been given to such application, or after having been served with or had left at his premises a written notice signed by

(*r*) See sect. 59; and *cp. per* Wright, J., in *Woolley v. Broad*, 9 R. P. C. p. 212: "The action is given to the proprietor only in case he elects not to proceed for

a penalty or forfeiture."

(*s*) See p. 131, *post*.

(*t*) See *per* Lawrence, J., in *Woolley v. Broad*, above, p. 211; and p. 84, *ante*.



such proprietor or his agent to the same effect." Under this section it was held, in the case of *Norton v. Nicholls* (u), that the notice must be express, *i.e.*, that it must explicitly state that the application of the design is without the registered proprietor's consent. The Act of 1883 substituted the word "knowing" for the somewhat complicated provisions of the earlier Act. But it is still, of course, advisable for the registered proprietor to give notice to the infringer that he has not consented to the application of the design, as it may otherwise be difficult to prove knowledge against the offender, and the burden of proof is with the plaintiff (x). Such notice need not now be so explicit as was demanded under the Act of 1842 (y). But it must be clear, and distinctly show what design is being infringed. If the notice does not contain any pattern of the design, or give any detail of the design claimed, this would not by itself be sufficient to fix the seller with knowledge. In the case of *Smith v. Lewis Roberts & Co.* (z) the plaintiff's solicitors wrote to the defendants on May 17th as follows: "Mr. Robert Smith informs us that it has come to his knowledge that you have in your warehouse exposed for sale, and have been in the habit of selling, Leno canvas striped goods, the patterns of which have been registered by our client. On his behalf we have to request you within seven days from this date to supply us with a full statement showing the quantity of goods you have sold, the quantity you have in stock, and the name of the manufacturer. If the information is not given within the time mentioned, our instructions are to commence an action against you forthwith." In the evidence given in support of the plaintiff's case, it was stated that the words "Leno canvas striped goods" could not apply to any other "class" of goods than those manufactured by the plaintiff, and that the plaintiff's goods were well, if not exclusively, known on the Manchester market by that name. It was, however, admitted in cross-examination that goods could be made with a pattern so different from those in the plaintiff's registered designs as not to be an infringement thereof, but that they might still be "Leno canvas striped goods." The defendants sold some goods bearing the designs in question on May 21st, but

(u) 7 W. R. 420.

(x) See p. 133, *post*.

(z) Above.

(y) See *per Bristowe, V.-C.*, in *Smith v. Lewis Roberts & Co.*, 5 R. P. C. p. 614.

then Mr. Roberts, who had been away in London, immediately on his return to Manchester stopped their sale of goods of the class complained of; and the defendants on discovering, by subsequent inspection on June 6th of the plaintiff's designs, that they had infringed his copyright, immediately returned to the manufacturer the goods which bore the infringing design. It was held that the defendants had not sold with knowledge that the designs were registered, or with knowledge that they had been applied without the consent of the registered proprietor. Bristowe, V.-C., in his judgment, referring to the letter mentioned above, said: "In my judgment that was not an adequate statement on the part of Mr. Smith to the retailer, Mr. Roberts, who up to that time had no idea that there was any registration about the goods. He did not know anything at all of the kind. In this case the retail dealer is selling goods for a considerable period of time, and he had no claim made against him on the ground that the goods were registered goods at all. In order to bring the case within the Act of Parliament, I think it must necessarily be shown that the retail dealer knew at the time of the exposition for sale that the design applied to the goods exposed for sale was applied without the consent of the registered proprietor. Now surely it is necessary that the person giving the first notice should give such a notice, if it is in writing at all, as to be intelligible to the person charged, so that he may know what is alleged against him. The person charged may be under contracts to supply such goods to different tradesmen all about the town. He must have the particular thing explained to him which it is claimed has the right of registration."

The necessity for the proprietor to show "knowledge" on the part of the defendant, however, only arises where he is claiming a penalty or damages under sect. 58 or sect. 59. If he seeks for an injunction only, want of knowledge is no defence (*a*), though it is sometimes of importance on the question of costs (*b*).

It is not necessary to prove knowledge against a manufacturer

(*a*) See *Wittman v. Oppenheim*, 27 Ch. Div. 269; cp. *American Tobacco Co. v. Guest*, 9 R. P. C. 218; *Mellington v.*

*For*, 3 My. & Cr. 338; *Cooper v. Whittingham*, 15 Ch. Div. 501.

(*b*) See p. 144, *post*.

(that is, the person who applies, or causes to be applied, the design, as distinguished from a person who publishes or exposes for sale), or to give him any notice, whether the action is brought under sect. 58 or sect. 59. The mere application of the registered design to an article without the consent of the registered proprietor is sufficient to make the manufacturer liable; it is his business to find out what is registered (*c*). A manufacturer can usually guard against infringement by availing himself of Rule 35 of the Designs Rules (*d*).

With reference to the consent of the registered proprietor, the reader should notice the case of *De la Branchardière v. Elvory* (*e*), which was a special case stated under the Act of 1842. The owner of the copyright of various designs for crochet collars, &c., had published a book containing copies of several of those designs, and it was contended that this gave to every purchaser of a copy a licence to apply those designs to collars, &c., and to sell such collars. It was held that the publication of the book was not such a licence as was required by sect. 7 of the Act of 1842, and did not give a purchaser the right to apply the design for purposes of sale.

**Registered piratical design may be expunged.**—Under the provisions of sect. 90 of the Act of 1883, a design which has been improperly registered may be expunged from the register at the instance of a person aggrieved (*f*). Therefore, where there is a piracy of a registered design, and the piratical design is registered, the proprietor of the original registered design may apply to have the registration of the piratical design expunged from the register. And he has this remedy even if the piratical design is registered in a different class to that in which his own is registered, if it is applied to similar articles (*g*); though in such a case, as we have seen (*h*), no action for infringement under sects. 58 or 59 will lie.

(*c*) *Per* Jessel, M. R., in *Barran v. Lomas*, 28 W. R. p. 974; cp. also his remarks in *Mallet v. Howitt*, W. N. (1879), 107.

(*d*) See p. 128, *post*.

(*e*) 13 L. J. Ex. 381.

(*f*) See the chapter on "Rectification," pp. 102, *seq.*, *post*.

(*g*) See pp. 20, *seq.*, *ante*.

(*h*) *Ante*, p. 80.

This remedy is available, not only for the registered proprietor, but for any person aggrieved (*i*).

Sub-sect. 2 of sect. 90 gives the Court power when such an application is made to award damages to the party aggrieved; but in practice this is rarely, if ever, asked for or done.

**Remedy by injunction.**—Although the Act of 1883 confers a particular right—the right of ownership in a properly registered design—and provides particular remedies for infringement of that right, yet a person proceeding under that Act is not absolutely confined to his statutory remedies under the Act, but may in addition obtain a remedy by injunction. In the case of *Cooper v. Whittingham (k)*, Jessel, M. R., in giving judgment, said: “It was argued that where a new offence and penalty for it had been created by statute, a person proceeding under the statute was confined to the recovery of the penalty, and that nothing else could be asked for. That is true as a general rule of law, but there are two exceptions. The first of the exceptions is the ancillary remedy in equity by injunction to protect a right. That is a mode of preventing that being done which, if done, would be an offence. Wherever an act is illegal and is threatened, the Court will interfere and prevent the act being done; and as regards the mode of granting an injunction the Court will grant it either when the illegal act is threatened but has not been actually done, or when it has been done and seemingly is intended to be repeated. The second exception is that created by the Judicature Act, sect. 25, sub-sect. 8, which enables the Court to grant an injunction in all cases in which it shall appear to the Court to be just or convenient. This section may be said to be a general supplement to all Acts of Parliament.”

As appears from the above judgment, the Court may grant an injunction where an infringement of a registered design is threatened, even if not yet actually carried out (*l*). And an injunction may be granted against the mere manufacture of articles to which a registered design is wrongfully applied, even where it is not

(i) As to who is a “person aggrieved,” see pp. 104, *seq.*, *post*.

(k) 15 Ch. Div. 501.

(l) See also *per* Cotton, L. J., in *Proctor v. Bayley*, 42 Ch. Div. p. 398; and *cp.* *Adair v. Young*, 12 Ch. Div. 13.

intended to sell the articles till after the expiration of the copy-right in the design (*m*).

Where there has actually been an infringement of a design there is a *prima facie* case for an injunction, for it is to be presumed that an infringer intends to go on infringing, and the proprietor of the design has a right to an injunction to prevent his doing so (*n*).

But if the Court has reason to think, owing to evidence of long discontinuance of the infringement or otherwise, that there is no intention on the part of the defendant to continue infringing, an injunction will generally be refused (*o*). In the case of *Smith v. Lewis Roberts & Co.* (*p*), where the defendants, who were retailers, immediately on receiving notice, sent back to the manufacturers all the infringing goods, and stopped all sales of those goods, Bristowe, V.-C., said: "In such a case, is it possible that I can grant an injunction *quia timet* or grant any injunction against that which the man says: 'I have not done (*q*), and never intend to do.'" In the case of *Jan v. Grossman & Skewes* (*r*), an injunction was refused under very similar circumstances (*s*). And even if successful in obtaining his injunction under such circumstances, the plaintiff is liable to be deprived of his costs (*t*).

**Undertaking not to infringe.**—Sometimes an undertaking is given by an alleged infringer that he will no longer infringe, and this is often accepted in lieu of pressing for an injunction. But the aggrieved party should be careful to see that the undertaking properly meets his requirements, as it will not be construed so as to have a wider effect than appears on the face of it. In the case of *Walker & Co. v. Scott & Co.* (*u*), the plaintiffs had registered a design for a tin oil-can for cyclists, the main and only new feature of which was the rounded edges at the top and bottom, instead of sharp edges. The defendants infringed the design, but, on complaint being made, wrote a letter to the plaintiffs in which they

(*m*) *McCrae v. Holdsworth*, 2 De G. & Sm. 496; and see p. 65, *ante*.

(*n*) See *per* Cotton, L. J., in *Proctor v. Bayley*, above; and *cp.* *Geary v. Norton*, 1 De G. & Sm. 9.

(*o*) *Proctor v. Bayley*, above.

(*p*) 5 R. P. C. 611. For the facts, see p. 89, *ante*.

(*q*) *I.e.*, selling after notice.

(*r*) 12 R. P. C. 537. For the facts, see p. 94, *post*.

(*s*) *Cp.* *Lyon v. Mayor, &c. of Newcastle-upon-Tyne*, 11 R. P. C. 218.

(*t*) See p. 144, *post*.

(*u*) 9 R. P. C. 482.

undertook "not to manufacture, sell, or offer for sale, any cans similar to, or only colourably differing from, cans of your design." Subsequently the defendants manufactured cans which had sharp edges instead of rounded edges, but were otherwise similar to those of the plaintiffs. The plaintiffs commenced proceedings for infringement, and moved for an interlocutory injunction to restrain the defendants from infringement, and from a breach of their undertaking. On the hearing of the motion it was held (1) that the only novelty in the plaintiffs' design was the rounded edges, and that, therefore, the defendants had not infringed; (2) that the undertaking meant nothing more than that the defendants would not in future infringe, and that, therefore, there had been no breach of the undertaking, the defendants being free to manufacture any oil-cans which did not actually infringe the plaintiffs' design.

On the other hand, the aggrieved party should not ask for too stringent an undertaking. In *Smith v. Lewis Roberts & Co.* (x), the plaintiff's solicitors wrote a letter to the defendants asking them to undertake "not to sell or expose for sale any articles or goods of the class to which the plaintiff's registered designs, or any of them, relate." The defendants declined to give this undertaking, and the plaintiff commenced an action, claiming damages and an injunction, against them. It was admitted that there had been an infringement of the plaintiff's design, but under the circumstances (y) the action was dismissed and the injunction refused with costs, Bristowe, V.-C., pointing out that the undertaking asked for was far too wide, extending as it did to the whole class of goods, and not being limited to those bearing the registered design, and that obviously the defendants could not have been advised to give such an undertaking.

Under certain circumstances the aggrieved party may be well advised in not pressing for an undertaking at all.

In the case of *Jun v. Grossman & Skewes* (z), which was an action for infringement of a registered design for powder puffs, the defendant admitted that he had purchased three puffs infringing the design, one of which he had sold to an unknown customer, and

(x) 5 R. P. C. 611.

(y) See p. 89, *ante*.

(z) 12 R. P. C. 537.

another to the plaintiff, on which occasion he first was informed that the puffs were an infringement. The defendant then at once promised to sell no more, and removed the third puff from his shop window, and never afterwards exposed it for sale, or attempted to sell it; but he refused to give a formal undertaking, demanded three weeks afterwards by the plaintiff's solicitor, not to sell any more. The plaintiff then commenced an action, and contended that, as the defendant admitted he had still an infringing article in his possession, he ought to have given the undertaking, and that the plaintiff was therefore entitled to an injunction; but the action was dismissed with costs, Kekewich, J., saying in his judgment that he thought the action was wholly unnecessary and unjustifiable under the circumstances.

**Delivery up of piratical articles (a).—**When a plaintiff has succeeded in an action for infringement and obtained an injunction, the defendant will be ordered to deliver up, to be destroyed, all articles bearing the infringing design, and any patterns, dies, moulds, or other things used by him for the production or manufacture of such articles (b). In the case of *McCrae v. Holdsworth* (c) the order was made although there was no intention to sell the articles till after the expiration of the copyright.

**Interlocutory injunction.—**The proprietor of a registered design, who is bringing an action for infringement, may also apply for an interlocutory injunction to restrain the continuance of the alleged infringement till trial of the action. It is not, of course, necessary for a plaintiff to apply for such an injunction, but it is generally advisable for him to do so, both in order to protect himself from further acts of infringement and because failure to do so might cause a suspicion of want of *bona fides* on his part in not bringing the matter before the Court as soon as possible (d).

On the hearing of the application for an interlocutory injunction the plaintiff must establish a *prima facie* case of infringement,

(a) See also p. 133, *post*.

(b) *Gordon & Munro v. Patrick & Hill*, 12 R. P. C. p. 24; *cp. Knowles & Co. v. John Bennett & Sons*, 12 R. P. C. p. 148; and *Oliver & Co. v. Thornley & Co.*, 13 R.

P. C. p. 501.

(c) 2 De G. & Sm. 496.

(d) See the remarks of Cotton, L. J., in *Mitchell v. Henry*, 15 Ch. Div. p. 196, and p. 98, *post*.

otherwise his application will be dismissed. If he succeeds in establishing a *prima facie* case, the Court may follow either of two courses. It may grant the interlocutory injunction, in which case the plaintiff is put upon the usual undertaking as to damages; or it may order the application to stand over till the trial, in which case the defendant will be ordered to keep an account. In deciding which of these two courses should be followed, the Court is chiefly guided by the question of convenience as between the parties (*e*).

If from the nature of the case the keeping of an account by the defendants would enable the plaintiff to obtain full compensation, if successful at the trial, for any loss he might sustain by the continuance of the piracy, and there is no special reason for an injunction, the application would probably be ordered to stand over. But if the keeping of an account by the defendant would probably not adequately compensate the plaintiff, if he proved successful at the trial, an interlocutory injunction would be granted. In the case of *Grafton v. Watson* (*f*), Chitty, J., in giving judgment said: "Balancing, as I am bound to do upon an interlocutory application, the question of convenience or inconvenience between the parties, I have taken into consideration the fact that the value of a trade of this kind may be truly said to be ephemeral. The value of the design will probably be exhausted in a year, and if I order the motion to stand over till the trial, the trial will probably not take place for a year from the present time, and a judgment in the plaintiffs' favour would then be comparatively useless to them. There would no doubt be the defendants' undertaking in damages; but it does not follow that the defendants would obtain all the orders that the plaintiffs lost, that all the customers of the plaintiffs would become customers of the defendants. In my mind the probability is that the plaintiffs will succeed at the trial, and they have on the balance of testimony made out a *prima facie* case, on which I think the Court ought now to act." An injunction was accordingly granted. This decision was upheld in the Court of Appeal (*g*) on the same grounds. Baggallay, L. J., also, in

(*e*) *Per* Cotton, L. J., in *Grafton v. Watson*, 51 L. T. (N. S.) p. 144; *cp. per* James, L. J., in *Mitchell v. Henry*, 15

Ch. Div. p. 191.

(*f*) 50 L. T. (N. S.) 420.

(*g*) 51 L. T. (N. S.) 111.



considering the question of convenience between the parties, pointed out that the defendants had brought it on themselves by admittedly going as near to the plaintiffs' design as they possibly could, and said that, therefore, if one side had to suffer an inconvenience that side should be the defendants.

In the case of *Knowles & Co. v. Bennett & Sons and Benjamin Bigio (h)*, Robinson, V.-C., in his judgment, said: "The only other question that remains is this—whether or no the inconvenience, the injustice, would be so great if I am wrong in granting an injunction, that I ought to pause before doing so. It seems to me that the parties are very evenly balanced in that respect. If I grant an injunction, and the defendant Bigio is not allowed to sell these goods which he has sent out (*i*), then, as far as I can judge, damages will be an ample compensation to him for any loss he may sustain. These goods are being sold upon commission, apparently, and the profit which the defendant would get by being allowed to continue the sales would probably be the commission which he would be entitled to, and in any case it would not be more than the value of the goods; therefore a money compensation will, I think, be a complete compensation to the defendant for any loss which he may sustain in case I grant an injunction, and in case I am wrong, either because so held by the Court of Appeal, or if I come to the conclusion, at the hearing of the action, that this injunction has now been improperly granted. On the other hand, it is difficult to say what the exact loss may be which the plaintiffs may sustain if the injunction is not granted. They may be supplanted in a trade which they have, to a certain extent, established in the East, by the sale of goods of a cheaper class—I will not say of an inferior class, because I hardly know enough about it to say whether one is superior or inferior to the other. But I am satisfied that the defendant Bigio is selling his goods at a lower price than the plaintiffs sell their goods, and the result might possibly be that the plaintiffs' trade might be taken away from them. I think, therefore, that on the plaintiffs giving

(h) 12 R. P. C. 137.

(i) The plaintiff and the defendant Bigio were both trading with the East, Bennett & Sons being the manufacturers.

the usual undertaking as to damages, I ought to grant an interlocutory injunction until the hearing of the action."

Where there is a considerable conflict of testimony in the affidavits, the application for an interlocutory injunction will probably be ordered to stand over.

In the case of *Mitchell v. Henry* (k), Cotton, L. J., said: "I should like to say a few words on the ground why I think we cannot interfere by granting an injunction. If there is a conflict of testimony on the question whether or no goods are calculated to deceive or be passed off as those of the persons by whom they are not manufactured, very often the Court is in a position to judge by its eyes where the truth lies, and what ought to be the result; but in the present case the question seems to me to be essentially a question for experts. . . . There being that conflict of testimony between the expert witnesses, and there being, so far as I am concerned, a difficulty in arriving at a satisfactory conclusion, I think the better course is to let the motion stand over to the hearing and then, after cross-examination of the witnesses, and after hearing the evidence in Court, that the Court should decide whether the defendants' goods are so manufactured as to be calculated to be passed off as the goods of the plaintiffs. On that ground I think we ought not to grant any interlocutory injunction; the defendants being put on an undertaking to keep an account, and the plaintiffs at the hearing not having it thrown in their teeth that this application was refused, or that they did not make an interlocutory application to the Court in order to ascertain *prima facie* as far as they could, and as soon as they could, what their rights were."

A motion for an interlocutory injunction is sometimes, by arrangement between the parties, treated as the trial of the action (l).

(k) 15 Ch. Div. p. 195.

(l) See e.g., *Demartial v. Booth*, 9 R. P. C. 499.

## CHAPTER VII.

## DEFENCES TO AN ACTION FOR INFRINGEMENT.

A DEFENDANT in an action for infringement has usually two broad grounds of defence :—

- (A.) That he has not committed any offence within the meaning of the Act.
- (B.) That the plaintiff's registration is invalid, or that the copyright no longer exists.

These two broad grounds may be further sub-divided thus :—

- (A.)—(i.) Under the first head the defendant may simply plead that the design used by him is not the plaintiff's design, or a fraudulent or obvious imitation thereof; in other words, that there has been no piracy (*a*). This is the most usual defence under this head.
- (ii.) If the defendant is not a manufacturer, but only a seller, he may further plead that, assuming that the design applied to the articles he is selling is an infringement of the plaintiff's design, he did not know that it had been so applied without the consent of the registered proprietor; in other words, "no notice" (*b*). But though this, if established, would be a valid defence to an action against a seller for a penalty or for damages, it is no defence by itself to a claim for an injunction (*c*). In such a case, the defendant should further show that immediately he learnt that he was infringing he stopped all further sales of the infringing goods, and offered the plaintiff a satisfactory undertaking not to sell any more of them. If he can show that he has

(*a*) See the chapter on "Infringement," pp. 63 *et seq.*, *ante*.

(*b*) See pp. 88 *et seq.*, *ante*.

(*c*) See p. 90, *ante*, and cases referred to there.

- acted in this manner, and there are no special circumstances, an injunction would probably be refused (*d*), or granted without costs (*e*).
- (iii.) He may plead that he has only applied the alleged piratical design to goods not in the class or classes in which the plaintiff's design is registered (*f*).
  - (iv.) He may plead that the alleged piratical goods are both made and sold abroad exclusively, so that there is no infringement in the United Kingdom (*g*).
  - (v.) If the design has been registered under the provisions of sect. 103 of the Act of 1883, as amended by sect. 6 of the Act of 1885, he may plead the statutory defence that the infringement took place before the date of actual registration (*h*).
  - (vi.) He may plead that he has not applied the design for the purposes of sale (*i*). But this defence will obviously be rarely available.

(B.) Under the second head are included all pleas that the requirements of the Act have not been complied with. The principal defences under this head may be shortly summarized thus:—

- (i.) That the design was not a proper subject-matter for registration as a design (*k*).
- (ii.) That the design had been published prior to registration (*l*).
- (iii.) That the design was not new or original (*m*).
- (iv.) That the person who registered the design was not the proprietor, and therefore not entitled to register (*n*).
- (v.) That the copyright has been forfeited under sect. 50 (2), sect. 51, or sect. 54 (*o*) ; of these, forfeiture under sect. 51 is the most usual (*p*).

(*d*) See pp. 53, *seq.*, *ante*, and cases referred to there.

(*e*) See pp. 111, 115, *post*, and cases referred to there.

(*f*) See p. 80, *ante*.

(*g*) See p. 82, *ante*.

(*h*) See p. 82, *ante*.

(*i*) See p. 65, *ante*.

(*k*) See pp. 5—11, *ante*.

(*l*) See pp. 33—41, *ante*.

(*m*) See pp. 15—32, *ante*.

(*n*) See, *e.g.*, *Jewitt v. Eckhardt*, 8 Ch. Div. 401; *Re Guiterman's Design*, 55 L. J. Ch. 309; and see pp. 42, *seq.*, *ante*.

(*o*) See p. 115, *post*.

(*p*) See the chapter on "Marking," pp. 51, *seq.*, *ante*.

In addition to the defences under the two heads mentioned above, three other defences may occasionally be available.

- (i.) That the plaintiff is not the registered proprietor and therefore cannot sue (*q*).
- (ii.) That the term of copyright (five years) has expired.
- (iii.) The Statute of Limitations (*r*).

If the defence includes or involves any plea to the effect that the plaintiff's design is improperly on the register, the defendant should move to expunge the design from the register (*s*).

Where the action is brought for a penalty under sect. 58, the defendant, even if he have no valid defence, may escape with a light or nominal penalty if there are mitigating circumstances, such as that he was unaware that he was infringing, that he stopped all sales at once on receiving notice, and so on (*t*). The defendant should therefore give any evidence to this effect that he can. If an injunction is claimed, such evidence may induce the Court to refuse the injunction altogether, or to grant it without costs (*u*). In all questions of infringement the conduct of the parties is taken into consideration by the Court, and is often of considerable importance when the question of costs arises (*x*).

(*q*) See pp. 83—86, *ante*.

(*r*) The Designs Act, 1812, s. 12, provided that no action should be brought after the expiration of twelve calendar months from the commission of the offence; but this Act is now repealed, and there is no similar provision under the Acts now in force; consequently, the ordinary rules of limitation will now apply.

(*s*) See the chapter on "Rectification of the Register," pp. 102, *seq.*, *post*, and particularly p. 108, and cases referred to there. As to mode of application, see p. 112.

(*t*) See p. 86, *ante*.

(*u*) See pp. 93, *seq.*, *ante*, and pp. 141, 145, *post*.

(*x*) See the chapter on "Costs," pp. 142, *seq.*, *post*.

## CHAPTER VIII.

## RECTIFICATION OF THE REGISTER.

SECTION 90 (*a*), sub-sect. 1, of the Act of 1883, as amended by sect. 23 of the Act of 1888, enacts that "The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person or of any other particulars from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making expunging or varying the entry, as the Court thinks fit; or the Court may refuse the application."

**The Court.**—Sect. 117 of the Act of 1883 defines "The Court" as meaning (subject to the provisions for Scotland, Ireland, and the Isle of Man (*b*)) the High Court of Justice in England (*c*). In the case of *Kinahan v. Kinahan* (*d*) it seems to have been assumed that an application for rectification could only be made in the High Court in England. It was decided by the Court of Appeal in the case of *King & Co.'s Trade Mark* (*e*) that an application to rectify can always be made in the High Court in England, even if the registered proprietor is domiciled in Scotland or Ireland. The Court did not decide the further question whether or not such an application *must* always be made in the High Court in England, or whether it could be made in the Scotch or Irish Courts when the registered proprietor is domiciled in Scotland or Ireland; but the learned judges seemed inclined to be of opinion that those

(*a*) This section applies alike to patents, designs, and trade marks, and patent and trade mark cases are therefore authorities on the interpretation of this section, equally with design cases.

(*b*) See sects. 111 and 112, and pp. 136, 137, *post*.

(*c*) This includes the County Palatine Court of Lancaster; see p. 135, *post*.

(*d*) 8 R. P. C. 18.

(*e*) 9 R. P. C. 350.

Courts had concurrent jurisdiction in such cases. Kay, L. J., in his judgment, said : " I am not going to decide now, or to express any confident opinion on the question, whether such an application could be made before the Courts in Ireland. I confess, at present, the inclination of my opinion is, that under sect. 111 it might possibly be made ; because I read at the end of that section (*f*) the direction that the Comptroller shall alter the register where an order for alteration of the register shall have been made in Ireland, and I presume that means an order made under the Act ; but at present I desire to reserve my opinion on that question till, perhaps, some case occurs in which it is necessary to decide it " (*g*).

But in the Irish case of *Bayer v. Connell Brothers & Co.* (*h*), which was an application to expunge a trade mark, Porter, M. R., held that the Irish Court had no jurisdiction under sect. 90, and that applications to rectify the register must in all cases be made to the High Court of England. This appears to be the only case in which the question has been definitely decided ; but in a recent Scotch case (*i*) the Lord Ordinary remarked : " I have been informed that there is no report in our books of any petition for rectification of the register of trade marks ; but no objection has been taken to my jurisdiction and I suppose there is no doubt about it. At the same time, sect. 111 of the Act of 46 & 47 Vict. c. 57, on which it seems to depend, is very obscure." In the absence of any express decision on the point, except the case of *Bayer v. Connell Brothers* mentioned above, the question seems open to considerable doubt.

It seems probable that an application for rectification could not under any circumstances be made in the Courts of the Isle of Man ; there is no provision with reference to those Courts corresponding to sub-sect. 2 of sect. 111.

The application is usually made to the Chancery Division, and may be made to the Court of Chancery of the County Palatine of Lancaster in cases where the registered proprietor is domiciled within its jurisdiction (*j*).

(*f*) Sub-sect. (2) of sect. 111.

(*g*) Cp. also *per* Bowen, L. J., *ibid.*,  
at p. 354.

(*h*) 14 R. P. C. 275.

(*i*) *Cowie Bros. v. Herbert*, 14 R. P. C.

436, p. 413.

(*j*) See p. 135, *post*.

Who is a person aggrieved?—Sect. 90 does not enable a person, whose design the Comptroller has refused to register, to apply to the Court as “a person aggrieved by the omission of a name,” as this would be tantamount to an appeal to the Court from the decision of the Comptroller, and the only appeal from his decision is to the Board of Trade (*k*).

But a registered proprietor, whose name has been erased by the Comptroller under the provisions of sect. 50, sub-sect. 2 (*l*), could, it is thought, apply under this section to have his name restored. Sect. 47, sub-sect. 6, and Rules 15—19, appear to apply only to cases where the Comptroller refuses an original application for registration; and an application to the Court under sect. 90 would therefore seem to be the proper and only remedy in such a case.

There can never, of course, be any doubt as to the right of the proprietor of a registered design, or a person claiming to be the proprietor of such a design, to apply under this section, as a “person aggrieved,” for the rectification of some error, or omission, or wrong entry in the register with reference to that design.

But there has been a good deal of difficulty as to what persons could apply as “persons aggrieved,” within the meaning of this section, to altogether expunge a design from the register. It does not seem ever to have been questioned that a defendant in an action for infringement of a design has a right to attack that design and move to have it expunged; the fact that he is being sued for infringement of it would naturally prove that he is injured by its retention on the register, if it is there wrongfully (*m*). But there was, till recently, some doubt as to what persons could, of their own motion, apply to expunge from the register a design in respect of which no attack had been made upon them. The principal cases bearing on the point are trade mark cases (*n*), where it has been sought to expunge a trade mark.

The general tendency has been to consider any person who is suffering, or may suffer, loss, or may be prevented from making a profit, by the existence on the register of a registration which ought not to be there, as a “person aggrieved by an entry made without

*l*, Sect. 47, sub-sect. 6; see *per* Chitty, J., in *Re Normal Trade Mark*, 3 R. P. C. p. 272; and see p. 120, *post*.

*k* See p. 115, *post*.

*m* See p. 107, *post*, note (*z*).

*n* See p. 102, *ante*, note (*a*).



sufficient cause." And this principle is now clearly established by the recent cases referred to below.

In the case of *Re Powell's Trade Mark* (o), Bowen, L. J., in his judgment, said: "Persons who are aggrieved are persons who are in some way or other substantially interested in having the mark removed from the register, or persons who would be substantially damaged if the mark remained. It is very difficult to frame a nearer definition than that. In the '*Apollinaris*' case (p) it was pointed out, not as a complete or exhaustive definition, that people would be aggrieved if they were in the same trade and dealt in the same article. To my mind, it is equally true that persons would be aggrieved if they are in the same trade and might reasonably be expected to deal in the same article, though not prepared to prove at the moment that they had formed a clear determination to do so. Supposing that this mark ought not to be on the register, it hampers those who are in the trade, and who might wish to consider the question of embarking in another branch of the trade if lawfully entitled to do so. It would be, to my mind, an unbusinesslike construction to place on the term 'aggrieved,' to say that it could only be applicable to those who actually had formed a fixed and crystallized intention of dealing in the particular article if permitted to do so. If a man is hampered in his arrangements of business matters in the future by the fact that a trade mark is on the register which ought not to be there, he is a person who, to my mind, is sufficiently aggrieved to come within the section. . . . It seems to me that . . . unless this trade mark is rightly upon the register, it cannot be said that the respondents are not interested in having it taken off. It is admitted that if an action were brought against them for infringing this trade mark they then would be persons aggrieved and would then have a right to take it off. Look at the absurdity to which that would lead, upon the contention of the appellants. We should say to people in the trade who are prevented by this trade mark from using it as theirs, 'if an action is brought against you, you then will be sufficiently aggrieved to remove this from the register; but as long as they do not bring an action against you, it may lawfully stay on

(o) 10 R. P. C. 195.

(p) *Re Apollinaris Co.'s Trade Marks*, 8 R. P. C. 137.

the register so as to terrify you.' That is impossible. The true view, to my mind, is, that we must look to see not merely, as in the 'Apollinaris' case, whether people are in the same trade and actually intending to carry on the business; but whether in the reasonable scope of the conduct of their affairs it is reasonably possible that they may want to carry it on, excluding remote possibilities and attaching oneself to real and substantial business chances."

This decision was affirmed in the House of Lords (*q*), all the judges concurring. Lord Herschell remarked: "Wherever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark, if remaining on the register, would, or might, limit the legal rights of the applicant, so that by reason of the existence of the entry on the register he could not lawfully do that which, but for the existence of the mark upon the register, he could lawfully do, it appears to me he has a *locus standi* as a person aggrieved" (*r*).

It should be noticed that the mere fact of a person being engaged in the same trade is not of itself sufficient to constitute him a "person aggrieved," unless there is some reasonable likelihood of his being injured by the continuance of the registration. In the case of *Re Wright, Crossley & Co.'s Trade Mark* (*s*), Romer, J., said: "I accept what was laid down by the Court of Appeal in the case of the *Apollinaris Co.'s Trade Mark*, where it is stated, in the report of that case, that the words 'aggrieved persons' must not be so read as to render it necessary to show evidence on the part of the applicants to expunge of great or serious damage; and I further accept the statement of the Court of Appeal, that a man in the same trade as the one who has wrongfully registered a trade mark and who desires to deal in the articles in question is *prima facie* an aggrieved person—but only *prima facie*; and the circumstances of the case may show that an individual applicant is not a person aggrieved. I think . . . that an applicant, in order to show that he is a person aggrieved, must show that in some possible

*q* 11 R. P. C. 1.  
*re* *Cp. Rivière's Trade Mark*, 26 Ch.  
 Div. 48; *Talbot's Trade Mark*, 11 R. P.

C. 77; *Apollinaris Co.'s Trade Marks*,  
 8 R. P. C. 137.  
 (*s*) 15 R. P. C. 131.

way he may be damaged or injured if the trade mark is allowed to stand; and by 'possible' I mean possible in a practical sense, and not merely in a fantastic view." This view was upheld in the Court of Appeal (*l*), where Rigby, L. J., remarked: "I have carefully considered the passages cited from the 'Yorkshire Relish' case (*u*), in the House of Lords, and so far from assenting to the statement that the mere fact that a man is engaged in the same trade is sufficient to make him a person aggrieved, I think it is carefully guarded against in the very passages in that judgment which have been cited. It is contrary, in my judgment, to the principle of the case decided in the House of Lords."

As a person in the same trade is *prima facie* an aggrieved person, it is apparently for the respondent to show that the applicant could not in any reasonable probability be injured (*x*).

From the cases quoted above and other reported cases, the persons who can claim to be "aggrieved" within the meaning of sect. 90 by the improper registration of a design may be classified as follows:—

A. Any person dealing in goods similar to, or in the same class as, those to which the registered design is to be applied, and who may possibly be injured by the retention of the entry on the register (*y*).

B. Any person sued for infringement of the registered design (*z*).

C. The proprietor of a previously registered similar design (*a*).

This is generally only a stronger case of Class A, as he would obviously be injured by the retention of the entry if the later design were applied to goods of a similar nature

(*l*) 15 R. P. C. 377.

(*u*) *I.e.*, *Re Powell's Trade Mark*, *supra*.

(*x*) See *per* Fry, L. J., in *Apollinaris Co.'s Trade Marks*, 8 R. P. C. p. 160: "A man in the same trade as the one who has wrongfully registered a trade mark, and who desires to deal in the article in question, is *prima facie* an 'aggrieved person.' This may be rebutted by showing that, by reason of some circumstances entirely independent of the trade mark, the person complaining never could carry on any trade in the article; but the burden of tendering such proof is on the man who claims the

mark."

(*y*) See the cases cited above; and, *e.g.*, *Re Sherwood's Design*, 9 R. P. C. 268.

(*z*) See *per* Bowen and Kay, L. JJ., in *Re Powell's Trade Mark*, 10 R. P. C. pp. 202, 203, and p. 105, *ante*; and see, *e.g.*, *Re Bach's Design*, 6 R. P. C. 376; *Smout v. Shymaker*, 7 R. P. C. 90; *Re Plackett's Design*, 9 R. P. C. 456; *Denartual v. Booth*, 9 R. P. C. 499; *Cooper v. Symington*, 10 R. P. C. 261; *Re Rollason's Design*, 11 R. P. C. 823; *Re Gutterman's Design*, 55 L. J. Ch. 369.

(*a*) *E.g.*, *Re Read & Gresswell's Design*, 6 R. P. C. 471.

to those to which his own were applied. If the later design is registered for application to quite different goods in another class, the application to expunge it would, as a matter of fact, probably fail (*b*). But this would not, it is thought, interfere with his *locus standi* as a person aggrieved; he would be entitled to make the application in order to test the question whether the goods *are* so dissimilar as to make the later registration valid.

A design may be expunged from the register for any reason which would have prevented its being originally registered, such as want of novelty, prior publication, &c. (*c*); or on the ground that the person who registered was not the proprietor (*d*); or on the ground that the registered proprietor has forfeited his copy-right under sect. 51 or sect. 54 (*e*).

Substitution of name as proprietor.—When a design has been registered by a person wrongly claiming to be the proprietor, any other person claiming to be the real proprietor can apply to rectify the register by striking out the name of the registered proprietor and substituting the name of the applicant. It has been suggested, on the authority of the cases mentioned below, that the Court has no power to substitute one name for another, but can only strike out the name of the wrongly registered proprietor. But it is submitted that the reasoning in those cases (all trade mark cases) is only applicable to trade marks, and, when examined closely, really assists the conclusion that in design cases such a course can be followed. The principal one of these cases is *Re Rivière's Trade Mark* (*f*). There Cotton, L. J., said: "In my opinion, whatever might be the result of the application to strike the name of the French firm off the register, the other application (*g*) ought not to be granted. Without saying that it is impossible to grant such an

*b*, See pp. 19, *seq.*, *ante*.

*c*, See the chapter on "What may be Registered," pp. 5, *seq.*, *ante*.

*d*, See, *e.g.*, *Re Gusterman's Design*, 55 L. J. Ch. 309; and see the chapter on "Who may Register," pp. 42, *seq.*, *ante*.

*e*, See, *e.g.*, *Re Rollason's Design*, 14 R. P. C. 893; and see p. 115, *post*.

(*f*) 53 L. T. (N. S.) 237. This case and the other trade mark cases mentioned below were all decided under sect. 5 of the Trade Marks Registration Act, 1875, which was similar to sect. 90 of the Act of 1883.

(*g*) *I.e.*, to substitute the names of the applicants as owners.

application as this in any case where one person is improperly on the register and another person who is entitled to the trade mark wishes to be put on, yet, as a rule (and I do not know a case where there would be an exception), when anyone applies in the first instance to be publicly registered as the proprietor of a trade mark, the requirements of the Act and Rules as to issuing advertisements and otherwise ought to be complied with. For there may be cases—and I can imagine them—where, although the person applying to strike a name off the register may be entitled to say, as against the person on the register, that he is improperly registered as owner of the trade mark, yet there may be persons, not present at the litigation, who have a right, as against the applicant, to rectify the register and to say that such applicant is not himself entitled to be there so as to prevent such third person from using the mark.”

It will be noticed that the learned judge expressly refrained from saying that in no case could the name of an applicant be substituted for that of the person improperly on the register, but rested his decision on the ground that before an applicant can get on the register certain requirements of the Act as to advertisements, &c. (*h*) should be complied with, pointing out that third parties might have a right to object to the registration of the applicants. Now in the case of designs there are no provisions for advertising prior to obtaining registration, nor for objections to registration being lodged with the Comptroller so as to enable conflicting claims to be adjusted before registration. Consequently no one could possibly be injured by the Court granting such an application in the case of a design (*i*); on the contrary, such a course would give much greater publicity to the registration than a registration in the ordinary way. It may be argued that such an order would deprive the Comptroller of the discretion given to him by sect. 47, sub-sect. 6, the only appeal from which is to the Board of Trade (*j*). But the Comptroller has notice of every application

(*h*) See sects. 68, 69 of the Act of 1883.

(*i*) In the case of a trade mark, registration is *prima facie* evidence of the right of the person registered to the exclusive use of the trade mark, and

conclusive evidence after five years (sect. 76 of the Act of 1883); but there is no corresponding provision with regard to designs.

(*j*) See p. 119, *post*.

under sect. 90 (*j*) and could raise any objection at the hearing, when the Court could, of course, refuse that part of the application; though probably any objection on the part of the Comptroller to the registration of the design would have been taken at the time of the original registration. Consequently the whole reason for the decision in *Rivière's Trade Mark* falls to the ground when applied in a design case.

In the other cases, *Re Rust & Co.'s Trade Mark* (*k*), *Re Farina's Trade Marks* (*l*), and *Re Greenlees' Trade Mark* (*m*), there was no question of conflicting titles. They were all cases in which a member of a firm had inadvertently registered a trade mark on behalf of the firm in such a manner as to vest the ownership in himself, and the applications were made in order to transfer the ownership to the firm. In the first case, as a matter of fact, the order for rectification was made, the registered proprietor having applied for registration in the firm's name as well as his own. In the case of *Farina's Trade Marks*, where the registered proprietor had made no mention of the firm in his original application, Jessel, M. R., said that he had no power to dispense with the requirement that notice is to be given to the public, and that the proper course was for the registered proprietor to assign the trade mark. In *Re Greenlees' Trade Mark*, which was a similar case, the same course was followed. Here, again, it will be observed that the requirement of notice, which is peculiar to trade marks, was the reason given for refusing the application, so that the reasoning could hardly apply to design cases, even if the circumstances were similar. The course adopted in those cases, of taking an assignment, would obviously be inapplicable when the parties are hostile and the respondent is struck off the register on the ground that he was not the proprietor.

It is submitted, therefore, that none of these cases are authorities which should be followed in a design case, but rather tend to show that there is no reason for refusing an application in a design case to substitute the name of the applicant for that of the person who is improperly on the register (*n*). Such an application

(*j*) Designs Rules 27.

(*m*) 9 R. P. C. 93.

(*k*) 44 L. T. (N. S.) 98.

(*n*) It may also be noticed that sect. 10 of the Act of 1842 expressly authorized such a substitution.

(*l*) 44 L. T. (N. S.) 99.

was made in the case of *Heinrichs' Design* (*o*), and, though it was refused on the ground that the applicant had not made out that he was the real proprietor of the design, it was not questioned that, if he had succeeded in establishing his title, the Court could make the order asked for. In the case of *Guiderman's Design* (*p*) the registered proprietor of a design brought an action for infringement, and the defendants moved to expunge the design from the register on the ground that he was not entitled to register, being only an agent for a company who manufactured the goods to which the design was applied; they succeeded in their application, and the plaintiff's counsel then asked for an order to substitute the company's name for that of the plaintiff. This was refused, without any reason being given. But it will be noticed that in that case it was not the applicants who asked to have their name substituted for the respondent's name, but the respondent who asked that a third party's name might be substituted for his; and, moreover, the *whole design*, not merely the name of the registered proprietor, was expunged as the result of the original application (*q*), so that it is difficult to see how the order could have been made in such a case.

Sub-sect. 2 of sect. 90 gives the Court power, in any proceeding under that section, to decide any question that it may be necessary or expedient to decide for the rectification of a register, and to direct an issue to be tried for the decision of any question of fact; and it is submitted, on the grounds stated above, that there is no reason why the Court should not, in a design case, exercise this power by substituting the name of a successful applicant for that of the person wrongly on the register, if the applicant proves that he is the real proprietor.

**Change of name.**—Where the name of the proprietor or proprietors of a registered design is changed, as in the case of a company, the Court will order the register to be rectified by registering the altered name as the name of the proprietor (*r*).

(*o*) 9 R. P. C. 73.

(*p*) 55 L. J. Ch. 309; and see p. 47.  
*ante*.

(*q*) It was in fact an application under

heading B, p. 107, *ante*, not an application of the kind under consideration.

(*r*) See *e.g.*, *The Pneumatic Tyre Co.'s Designs*, 11 R. P. C. 636.

The Court has power under sect. 90 to make, expunge, or vary any entry (*s*). But if an improper entry cannot be put right by an alteration or addition, the whole entry must be expunged (*t*).

The words in sect. 90, "entry made without sufficient cause," include any entry which is at any time on the register without sufficient cause, even if originally properly made (*u*).

**Damages.**—Under sub-sect. 2 of sect. 90 the Court has power to award damages to the party aggrieved, but this power appears to be rarely, if ever, exercised.

Any order of the Court rectifying the register (*x*) must direct that due notice of the rectification be given to the Comptroller (*y*). The person in whose favour the order is made must forthwith leave at the Patent Office an office copy of the order, and the register is thereupon rectified, or the purport of the order otherwise duly entered in the register, as the case may be (*z*).

**Procedure in an application.**—A claim for rectification of the register cannot take the form of an action, or of a counterclaim in an action (*a*). The claim should be made by motion, or by summons, the former being the more usual course. But in some cases the motion may be ordered to go into the general list of witness actions (*b*).

Four clear days' notice (*c*) of the application must be given to the

(*s*) As to what entries may be made in the register, see the chapter on "The Register," p. 124, *post*; and as to the practice in rectifying entries, see *Re Green's Patent*, 24 Beav. 115; *Re Morey's Patent*, 25 Beav. 581; *Re Horsley & Knighton's Patent*, L. R. 8 Eq. 475 (all decided under the corresponding section of the Patent Law Amendment Act, 1852); and *Baker v. Rawson*, 45 Ch. Div. 519.

(*t*) See *per Kekewich, J.*, in *Haslett v. Hutchinson*, 8 R. P. C. p. 464; and *ep. per Lord Romilly, M. R.*, in *Re Horsley & Knighton's Patent*, above, p. 478.

(*u*) See *per Lindley, M. R.*, in *Re Batt & Co.'s Trade Marks*, 15 R. P. C. p. 539.

(*x*) For a form of such an order, see

*Re King & Co.'s Trade Mark*, 9 R. P. C. p. 354.

(*y*) Sect. 90, sub-sect. 3; see also sect. 111, sub-sect. 2. This is done even when the Comptroller appears at the hearing of the application; see, *e.g.*, the order in *Re King & Co.'s Trade Mark*, above.

(*z*) Designs Rules, 1890, r. 28.

(*a*) *Pinto v. Badman*, 8 R. P. C. 181, at pp. 187, 190.

(*b*) See, *e.g.*, *Re Bach's Design*, 6 R. P. C. 376; *Re Read & Gresswell's Design*, 6 R. P. C. 471.

(*c*) For a form of notice of motion, see in *Re La Compagnie Générale, &c.*, 8 R. P. C. p. 448.



Comptroller (*d*), who is usually, but not necessarily, made a respondent (*e*).

The registered proprietor need not necessarily be made a respondent to the motion, though it is usual to do so if he is within the jurisdiction, and he is in any case entitled to have proper notice of the application (*f*).

If the registered proprietor is domiciled out of the jurisdiction of the Court, so that notice of the application cannot be served upon him in the usual way, the proper course for the applicant to pursue is to serve the notice on the Comptroller only, and when a day has been fixed for the hearing to send a letter to the proprietor, accompanied by a copy of the notice of motion, stating that an application will be made on the day fixed affecting his interest (*g*). It is not necessary to obtain the leave of the Court to give such an intimation (*h*).

If the registered proprietor cannot be found, the Court would probably allow notice to him to be given by advertisement, or dispense with notice altogether (*i*).

Any decision of the Court in an application under sect. 90 can be appealed from to the Court of Appeal and to the House of Lords (*k*).

(*d*) Designs Rules, r. 27.

(*e*) See p. 131, *post*.

(*f*) *Ibid*.

(*g*) See *Re La Compagnie Générale, &c.*, 8 R. P. C. 446; followed in *Re Robertson, Sanderson & Co.'s Trade Mark*, 9 R. P. C. 213; *Re King & Co.'s Trade Mark*, 9 R. P. C. 350.

(*h*) *Per Kekewich, J.*, in *Re King & Co.'s Trade Mark*, above, p. 352; but in the case of *Robertson, Sanderson & Co.'s*

*Trade Mark* (above) the applicants did, by an *ex parte* application, ask for, and obtain, the leave of the judge who was to hear the motion.

(*i*) See *per Bowen, L. J.*, in *Re King & Co.'s Trade Mark*, above, p. 364.

(*k*) See *e.g.*, *Re Rollason's Design*, 14 R. P. C. 909; 15 R. P. C. 141. Apparently this was not the case under the Patent Law Amendment Act, 1852. (See *Re Horsley and Knighton's Patent*, L. R. 4 Ch. 781.)

## CHAPTER IX.

## EXTENT, DURATION, AND FORFEITURE OF COPYRIGHT.

**Extent.**—The copyright in a registered design extends to the United Kingdom, and ordinarily to the Isle of Man also (*a*). But the copyright does not, apparently, extend to the Isle of Man in cases where a design is registered, under the provisions of the International Convention and sect. 103, by a person who has applied for protection in a foreign state or colony which is a party to the Convention; for the accession of Her Majesty's Government to the Convention was only made on behalf of Great Britain and Ireland, power being reserved to subsequently accede on behalf of the Isle of Man, Channel Islands, or any of Her Majesty's possessions (*b*). Where, however, by Order in Council under sect. 103, the provisions of that section are applied to a foreign state or colony which is *not* a party to the Convention, it would seem that a person who has applied for protection in such state or colony, and then registers here under the provisions of sect. 103, would obtain copyright to the full extent (*c*).

**Duration.**—Copyright in a registered design continues for five years from the date of registration (*d*). The date of registration is the date on which the application for registration is received by the Comptroller (*e*), except when the application has been made under the provisions of sect. 103 or sect. 104, in which case the registration has the date of the application in the foreign state or

(*a*) Sect. 112. The copyright does not extend to the Channel Islands.

(*b*) See p. 183, *post*.

(*c*) A list of the foreign states and colonies to which the provisions of sect. 103 have been applied by Order in Council is given at pp. 191, 192, *post*;

those marked with an asterisk being parties to the Convention.

(*d*) Sect. 50, sub-sect. 1. There is no provision now for the extension of the term of copyright, as in the case of patents.

(*e*) Rule 20. See also p. 121, *post*.

colony. If application for protection has been made in more than one foreign state or colony, the registration here would, apparently, have the date of the earliest of such applications (*f*).

**Forfeiture.**—Copyright in a registered design, however, may be lost before the expiration of the term of five years.

Under the provisions of sect. 51, the copyright ceases if the design is used in manufacture in any foreign country and is not used in this country within six months of its registration in this country.

Sect. 51 provides that, before delivery on sale of any articles to which a registered design has been applied, the proprietor must cause each such article to be marked with the prescribed mark, or with the prescribed words or figures, denoting that the design is registered, and that if he fails to do so his copyright ceases, unless he can show that he took all proper steps to ensure the marking of the article (*g*).

The copyright in a registered design is also liable to forfeiture under sect. 50, sub-sect. 2, which provides that, before delivery on sale (*h*) of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration) furnish to the Comptroller the prescribed number of exact representations or specimens of the design (*i*); and if he fails to do so, the Comptroller may erase his name from the register, and thereupon his copyright in the design shall cease.

Sect. 50, sub-sect. 2, only forbids the actual delivery on sale of the articles to which the registered design has been applied until its provisions have been observed; so that the proprietor will not, under this section, incur the risk of forfeiture by otherwise dealing with the design, or the articles to which it has been applied, after obtaining a date for registration by sending in a single sketch only (*i*); *e.g.*, he may exhibit the articles or the design.

It should be noticed that in sect. 50, sub-sect. 2, the words are “if he fails to do so, the Comptroller *may* erase his name from the

(*f*) See p. 122, *post*.

(*g*) See the chapter on “Marking,” pp. 51, *seq.*, *ante*.

(*h*) As to the meaning of “delivery on sale,” see p. 53, *ante*.

(*i*) See p. 118, *post*.

register, and *thereupon* his copyright shall cease"; whereas in sect. 51 the words are "if he fails to do so the copyright *shall* cease." Therefore, a breach of the provisions of sect. 50, sub-sect. 2, would have no effect till the Comptroller took action and erased the proprietor's name; while a breach of those of sect. 51 would, *ipso facto*, cause forfeiture. This might be of importance in the case of an infringement of the copyright immediately after a breach of one of these provisions by the proprietor; in the case of a breach of sect. 51, the mere fact of the breach would be a complete answer to an action for infringement; but in the case of a breach of sect. 50, sub-sect. 2, this would not be any answer unless the Comptroller had already, at the time of the infringement, erased the proprietor's name from the register.

Before exercising his power under sect. 50, sub-sect. 2, the Comptroller should, apparently, give the proprietor an opportunity of being heard in his defence (*l*). If the name is erased, the proprietor could, it is thought, apply to the Court under the provisions of sect. 90 to have his name restored (*m*).

As a matter of fact, forfeiture under this section is hardly likely to occur, except, possibly, in the case of designs for lace or articles in Classes 13 or 14; for the practice of the Comptroller is, not to register a design or issue a certificate till he has actually received the proper number of representations or specimens (*n*); and until the proprietor receives the certificate he cannot (except in the cases mentioned above) know what is the "prescribed mark" (*o*), and would, therefore, if he sold, incur forfeiture under sect. 51. As regards designs for lace or articles in Classes 13 and 14, it may be noticed that a proprietor selling articles marked as being registered before he has obtained his certificate of registration is liable to a penalty of 5*l.* for each offence (*p*).

(*l*) Sect. 94, and Rules 12-14. These only speak of an *applicant* for registration, but probably they would be taken to apply to a proprietor who has been erased.

(*m*) See p. 104, *ante*.

(*n*) See "Instructions to Persons who wish to Register," para. 6 (*a*), p. 195, *post*.

(*o*) See p. 51, *ante*.

(*p*) See p. 117, *post*.

## CHAPTER X.

## HOW TO REGISTER.

IN order to register a design, application must be made to the Designs Branch of the Patent Office. An application to register a design for any article other than lace must be made in Form "E" or Form "O"; if for lace, then in Form "E 1" or Form "O 1" (*a*). Any application must contain the name, address, and description of the individual or firm making the application (*b*), and must be signed by the applicant or his agent duly authorized. The application must state the nature of the design, that is to say, whether it is applicable for the pattern (*c*), or for the shape or configuration of the design (*d*), and the means (*e*) by which it is applicable (*f*), and must also state the class of goods in which the

(*a*) See Designs Rules, 1893, r. 3, p. 174, *post*.

(*b*) As to who may apply for registration, see the chapter on "Who may Register," pp. 42, *seq.*, *ante*.

(*c*) A design registered as "applicable for the pattern" is not necessarily confined to the pattern only, to the exclusion of other elements in it (see *Heath v. Rollason*, 15 R. P. C. 441). And so also, apparently, with designs registered for "shape or configuration," or "ornament." See the judgment of Lord Herschell in that case; *cp.* also *per* Rigby, L. J., in *Harper & Co. v. Wright, &c. Co.*, 12 R. P. C. p. 495; and see p. 139, *post*.

(*d*) All that is necessary is to fill in after the words "statement of nature of design" the words "for the pattern," "for the shape or configuration," or "for the ornament," or for any two or more such purposes as the case may be, adding, when necessary, a short technical description with the part or parts claimed

as new or original specially defined (see "Instructions to persons who wish to register designs," p. 195, *post*). No regular specification, as in patents, is required or allowed (see *per* Lord Shand in *Walker, Hunter & Co. v. Falkirk Iron Co.*, 1 R. P. C. p. 394; *per* Kay, L. J., in *Re Clarke's Design*, 13 R. P. C. p. 363). After registration the proprietor cannot disclaim any part of the registered design so as to protect the residue by itself (see *per* Wickens, V.-C., in *Thom v. Syddall*, 20 W. R. p. 292; and *per* Wills, J., in *Smout v. Staymaker*, 7 R. P. C. p. 91). As to the effect and possible dangers of registering by pattern or sample without any description, see p. 76, *ante*.

(*e*) *E.g.*, "by embossing," "by printing," "by stamping," &c.; see sect. 60.

(*f*) Rule 9. The forms prescribed by the Designs Rules, however, do not contain any provision for a statement being made by the applicant as to the means by which the design is applicable; and

applicant wishes the design to be registered (*g*), the classes being enumerated in the 3rd Schedule to the Rules (*h*). In case of doubt as to the class in which a design ought to be registered, the Comptroller may decide the question (*i*). In any case of difficulty the Comptroller can apply to either of the law officers for directions (*j*).

The applicant may register his design in more than one class if he thinks fit to do so (*k*), but in that case a separate application must be made in respect of each class (*l*).

Each application must be accompanied by a sketch or drawing of the design (sufficiently definite to identify the same), or by three exactly similar drawings, photographs, or tracings of the design or by three specimens of the design (*m*). The advantage of sending a sketch or drawing is to secure a date of registration at once (*n*), but no certificate can be issued until three exact drawings, photographs, tracings, or specimens have been sent to the Comptroller in substitution for the sketch (*o*). The proprietor must be careful not to sell any article to which the design has been applied before furnishing these three drawings, &c. (*p*).

The application for registration, and all other documents sent to or left at the Designs Branch of the Patent Office, must be written, printed, copied, or drawn upon strong wide-ruled foolscap paper (on one side only) of the size of 13 inches by 8 inches, and leaving a margin of not less than  $1\frac{1}{2}$  inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand (*q*). If sketches, drawings, or tracings are furnished, they must be fixed (*m*). In cases where the articles to which the design is to be applied are not of a kind to

as a matter of fact such a statement is not always regarded as necessary by the Comptroller.

(*g*) Sect. 47 (3).

(*h*) See p. 174, *post*.

(*i*) Sect. 17 (5). As to the effect of registering in a wrong class, see p. 81, *ante*.

(*j*) Sect. 95.

(*k*) Sect. 47 (1). In case of doubt as to the proper class of registration, the applicant should avail himself of this privilege and so ensure complete protection. See *per* Bristowe, V.-C., in

*Mothersall v. Moore*, 9 R. P. C. p. 38.

(*l*) See "Instructions to persons, &c.," para. 15, p. 196, *post*.

(*m*) Rule 9.

(*n*) Rule 20; and see "Instructions to persons, &c.," para. 6 (a), p. 195, *post*.

(*o*) As to the drawings or specimens, see "Instructions to persons, &c.," paras. 6—12, p. 195, *post*.

(*p*) See p. 115, *ante*.

(*q*) Rule 8. The Comptroller may in any particular case vary the requirements of this rule as he may think fit.

allow of their being pasted into books, drawings, photographs, or tracings must be furnished (*r*).

The application with the proper fee (*s*) can either be left at the Patent Office (Designs Branch) or sent by post to the Comptroller (*t*). If the application be sent by post, it will be deemed to have been left at the time when the letter containing the same would be delivered in the ordinary course of post (*u*). In proving such sending, it is sufficient to prove that the letter was properly addressed and put into the post (*v*).

The Comptroller may refuse any drawing, photograph, tracing, representation, or specimen which is not, in his opinion, suitable for the official records (*w*).

The Comptroller may refuse to register any design presented to him for registration (*x*), but before doing so he must, if so required by the applicant within one month from the date of the Comptroller's objection, give the applicant an opportunity of being heard personally or by his agent, by sending the applicant ten days' notice of the time when he may be so heard (*y*). If the Comptroller's refusal is based upon the identity of the design sought to be registered with a design already registered, the applicant is entitled to inspect the original design (*z*).

Within five days from the date when such notice was delivered in the ordinary course of post, the applicant must inform the Comptroller whether or not he intends to be heard upon the matter (*a*). After such hearing, the Comptroller must communicate his decision to the applicant (*b*). If the decision be unfavourable the applicant can appeal to the Board of Trade (*c*). If he wishes to appeal he must, within one month from the date of the decision of the Comptroller, leave at the Patent Office (Designs Branch) a notice of his intention to appeal, together with a statement of the grounds of appeal and of his case in support of it (*d*), and after

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| ( <i>r</i> ) Rule 9.                             | to the discretion of the Comptroller, see        |
| ( <i>s</i> ) For the amount of the fee, see      | Kerly on Trade Marks, p. 64.                     |
| p. 175, <i>post</i> .                            | ( <i>y</i> ) Sect. 94, and Rule 12; see also     |
| ( <i>t</i> ) Rule 7.                             | sect. 98.  |
| ( <i>u</i> ) Sect. 97 (1) and Rule 11.           | ( <i>z</i> ) Sect. 6 of the Act of 1888; and see |
| ( <i>v</i> ) Sect. 97 (2) and Rule 11; see       | p. 127, <i>post</i> .                            |
| p. 139, <i>post</i> .                            | ( <i>a</i> ) Rule 13; see also sect. 98.         |
| ( <i>w</i> ) Sect. 48 (2).                       | ( <i>b</i> ) Rule 14.                            |
| ( <i>x</i> ) Sect. 47 (6); see also sect. 86. As | ( <i>c</i> ) Sect. 47 (6).                       |
|  | ( <i>d</i> ) See Form F, p. 178, <i>post</i> .   |

leaving such notice he must forthwith send a copy to the Board of Trade (*e*). The Board of Trade may, upon the receipt of the notice, give any directions they may think fit for the purpose of the hearing of the appeal (*f*).

The Board of Trade must give to the Comptroller and the applicant seven days' notice, or such shorter notice as they may in any particular case direct, of the time and place appointed for the hearing (*g*). The Board of Trade may, on the hearing, allow the design to be registered unconditionally, or upon terms, or may refuse to allow it to be registered (*h*).

There is no appeal from the decision of the Board of Trade. In the case of *Re Normal Trade Mark* (*i*), Mr. Justice Chitty said: "In sect. 47, sub-sect. 7, the Board of Trade, where there is what is termed here an appeal to them, apparently are made the final tribunal for the decision of the question, because by this sub-section there is no such power conferred on them, in terms at any rate, as is conferred by sect. 62 (*k*), which is, that they may, 'if it appears expedient, refer the appeal to the Court,' instead of dealing with it themselves. It does appear from sect. 47 that the Legislature considered that they might entrust this question, as to what design should or should not come on the register, to the Comptroller-General, subject only to an appeal to the Board of Trade. No doubt the word 'only' is not used, but this is a statute prescribing a particular course of procedure with reference to a right established by the statute itself, and I take it that the general rule on a matter of that kind is that the course pointed out by the statute itself is the only course which the parties can pursue" (*l*).

There is no provision made by the Act or by the Rules as to the payment of the costs of an appeal to the Board of Trade, so the applicant pays his own costs whether the appeal be successful or not.

Any document, drawings, sketches, or tracings for the amending of which no special provision is made by the Act, may be

(*e*) Designs Rules 15, 16, and 17.

(*f*) Rule 18.

(*g*) Rule 19.

(*h*) Sect. 47 (7).

(*i*) 35 Ch. Div. p. 234.

(*k*) Which refers to trade marks only, but corresponds to sect. 47.

(*l*) See also *per* Lindley, L. J., in *Re Charles's Design*, 13 R. P. C. p. 357.



amended, and any irregularity in procedure which, in the opinion of the Comptroller, may be obviated without detriment to the interests of any person may be corrected, if the Comptroller think fit, and upon such terms as he may direct (*m*).

The time prescribed by the Rules for doing any act or taking any proceeding thereunder may be enlarged by the Comptroller if he think fit, but upon such terms as he may direct (*n*).

Where under the Rules any person is required to do any act or thing, or to sign any document, or make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, the Comptroller may, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, dispense with such act or thing, document, declaration, or evidence (*o*).

The Comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of the Act, apply to either of the law officers for directions in the matter (*p*).

If the Comptroller determines to register a design, he sends as soon as may be to the applicant a certificate of such registration in the prescribed form (*q*), sealed with the seal of the Patent Office (*r*), and he enters in the Register of Designs the name, address, and description of the registered proprietor and the date upon which the application was received by him, which date is deemed to be the date of registration (*s*), except in cases where the application has been made under the provisions of sect. 103 or sect. 104 (*t*). The copyright in the registered design lasts for five years unless previously forfeited (*u*). A body corporate may be registered as proprietor by its corporate name (*v*).

(*m*) Rule 30.

(*n*) Rule 31; see also sect. 98.

(*o*) Rule 29.

(*p*) Sect. 95.

(*q*) Form G, p. 178, *post*.

(*r*) Rule 10.

(*s*) Rule 20.

(*t*) See below, "International arrangements."

(*u*) Sect. 50 (1); see pp. 114, *seq.*, *ante*.

(*v*) Rule 26.

In case of loss of the original certificate, or in any other case in which the Comptroller deems it expedient, he may grant a copy or copies of the certificate of registration (*y*).

The Comptroller may on request in writing (*z*), accompanied by the prescribed fee of 5s. :

- (i.) Correct any clerical error in or in connection with an application for registration of a design, or
- (ii.) Correct any clerical error in the name, style, or address, of the registered proprietor of a design, or
- (iii.) Permit an applicant for registration of a design to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design to be registered (*a*).

**International arrangements.**—When arrangements have been made with any foreign state for the mutual protection of designs, any person (*b*) who has applied for protection for any design in any such state is entitled to registration of his design in priority to other applicants (*c*), and such registration has the same date as the date of the application in such foreign state; provided always that the application for registration is made within four months from his applying for protection in such foreign state (*d*). If application for protection has been made to more than one foreign state, the application for registration over here must apparently be made within four months of the earliest of the foreign applications for protection, and the registration here would have the date of that foreign application (*e*). But an earlier foreign application, if abortive, will be disregarded in relation to date under sect. 103, if there has been a *bonâ fide* and successful later application (*f*).

(*y*) Sect. 49 (2). The application for such a copy is made on Form II, p. 178, *post*.

(*z*) Form M, p. 181, *post*.

(*a*) Sect. 91; and the Act of 1888, s. 24.

(*b*) A foreign corporation can apply for registration under this section (see *per* Webster, A.-G., in *Re Curcz*, 6 R. P. C. 552). Registration will only be granted to the person who has made the foreign

application, and in his own name; see p. 49, *ante*.

(*c*) See p. 49, *ante*.

(*d*) Sect. 103 of the Act of 1883, amended by sect. 6 of the Act of 1885. See also Article IV. of the International Convention, p. 181, *post*.

(*e*) This is the rule in patent cases, and would presumably be the same in the case of a design.

(*f*) *Re Van de Poelc*, 7 R. P. C. 69.

As there is nothing in the section to confine its application to foreigners, an English subject could avail himself of the provisions of this section.

The proprietor of a design registered under this section cannot recover damages for infringements happening prior to the date of the actual registration of the design in this country (*g*). The exhibition or use in the United Kingdom or the Isle of Man, during the above mentioned period of four months, of the design, or the publishing therein during such period of a description or representation of the design, does not invalidate the registration of the design (*h*). The application for registration of such a design is made in the ordinary way (*i*).

The provisions of sect. 103 apply only in the case of those foreign states with respect to which Her Majesty from time to time, by Order in Council (*k*), declares them to be applicable, and so long only in the case of each state as the Order in Council continues in force with respect to that state.

Under sect. 104 Her Majesty may, by Order in Council (*k*), apply the provisions of sect. 103, with such variations or additions as may be thought fit, to any British Possession (*l*) the legislature of which has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country.

(*g*) Sect. 103 (1).

(*h*) Sect. 103 (2). See also Article IV. of the International Convention.

(*i*) Sect. 103 (3). In the case of patents a special form of application was provided by the Patent Rules, 1890,

but there is no corresponding form of application for designs.

(*k*) For a list of these Orders in Council, see pp. 191, 192, *post*.

(*l*) See sect. 117 (1).

## CHAPTER XI.

## THE REGISTER OF DESIGNS.

SECTION 55 of the Act of 1883 provides that there shall be kept at the Patent Office a book called the "Register of Designs," wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed.

Official copies of all specifications, drawings, and amendments are sent to the Edinburgh Museum of Science and Art, the Enrolments Office of the Chancery Division in Ireland, and the Rolls Office in the Isle of Man. Certified copies of, or extracts from, these documents can be obtained by any person on payment of the prescribed fee (*a*).

When a certificate of registration has been sealed, the Comptroller enters in the Register of Designs the name, address, and description of the proprietor of the registered design, and the date upon which application for registration was received by him, which date is taken as the date of registration (*b*), except in cases where the design is registered under the provisions of sects. 103 or 104 (*c*).

Where a person becomes entitled by assignment, transmission, or other operation of law (*d*) to the copyright in a registered design, the Comptroller, on request and on proof of title to his satisfaction, enters the name of such person as proprietor of the copyright in the design in the Register of Designs. The person for the time being entered in the register as proprietor of the copyright in a design has (subject to the provisions of the Act

*a* Sect. 100.

*b*, Rule 20.

*(c)* See p. 122, *ante*.

*(d)* See pp. 46 *et seq.*, *ante*.

and to any rights appearing from such register to be vested in any other person) power absolutely to assign, grant licences as to, or otherwise deal with the same, and to give effectual receipts for any consideration for such assignment, licences or dealing; but any equities in respect of the design may be enforced in like manner as in respect of any other personal property (*e*).

With reference to the "request" and "proof of title" required by sect. 87, the Designs Rules provide as follows:—

Where a person becomes entitled to the copyright in a registered design, or to any share or interest therein, by assignment, transmission, or other operation of law, or where a person acquires any right to apply the design, either exclusively or otherwise, a request (*f*) for the entry of his name in the register as such proprietor of the design, or as having acquired such right, as the case may be, must be addressed to the Comptroller and left at the Patent Office (Designs Branch) (*g*).

Every such request must, in the case of an individual, be made and signed by the person requiring to be registered as proprietor, and in the case of a firm or partnership, by some one or more members of such firm or partnership, or, in either case, by his or their agent respectively duly authorized to the satisfaction of the Comptroller; and, in the case of a body corporate, by their agent duly authorized in like manner (*h*); and it must state the name, address, and description of the claimant, and the particulars of the assignment, transmission, or other operation of law by virtue of which the request is made, so as to show the manner in which and the person or persons to whom the design has been assigned or transmitted, or the person or persons who has or have acquired such right as aforesaid, as the case may be (*i*). Every request must be accompanied by a statutory declaration to be thereunder written verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the design, or the right to apply the same, as the case may be, as claimed by such

(*e*) 1883, sect. 87, amended by the Act of 1888, sect. 21. No notice of trusts is entered on the register; see sect. 83, and p. 126, *post*. \*

(*f*) Form K, and, in case of lace, Form K 1, pp. 179, 180, *post*.

(*g*) Rule 21.

(*h*) Rule 22.

(*i*) Rule 23.

request (*k*). The claimant must furnish to the Comptroller any other proof of title which he may require for his satisfaction (*l*).

**Trusts.**—No notice of any trust, expressed, implied, or constructive, may be entered by the Comptroller upon the register (*m*). But in the case of *Stewart v. Casey* (*n*) it was held by the Court of Appeal that sect. 85 only excludes from the register simple notices of trusts, and not documents affecting the proprietorship of a patent, whether by creating trusts or otherwise, and that equitable assignments of a patent, or of a share in a patent, may be entered on the register as documents affecting the proprietorship of the patent (*o*). In that case, the owners of two patents wrote to C. that in consideration of his services they agreed to give him one-third share of the patents, to take effect from the date of the letter. C. caused an entry of this letter to be made on the register of patents, and an entry was also made in the register of proprietors that C. claimed an interest under the document. It was held that this letter was an immediate equitable assignment of an interest in the patents, and that the entries were perfectly proper, and the application to expunge them was refused.

The register of designs is *prima facie* evidence of all matters directed or authorized to be entered therein (*p*). Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office (*q*), of or from the register are admitted in evidence in all Courts and in all proceedings without further proof or production of the originals (*r*); and a certificate purporting to be under the hand of the Comptroller as to any entry, matter or thing which he is authorized by the Act or any of the Rules to make or do is *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone (*s*).

(*k*) Rule 24.

(*l*) Rule 25.

(*m*) 1883, sect. 85. This section applies alike to patents, designs, and trade marks.

(*n*) 9 R. P. C. 9 (a patent case).

(*o*) In the earlier case of *Huslett v. Hutchinson*, 8 R. P. C. p. 463, Kekewich, J., appears to have expressed a different

opinion; but the case of *Stewart v. Casey* is clear authority on the point.

(*p*) Sect. 55 (2).

(*q*) See sect. 84.

(*r*) 1883, sect. 89; and see sect. 100.

A plain copy should not be tendered as evidence; see *per* Kekewich, J., in *Huslett v. Hutchinson*, 8 R. P. C. at p. 461.

(*s*) Sect. 96.

Where a certificate is required for the purpose of any legal proceeding or other special purpose as to any entry, matter, or thing which the Comptroller is authorized by the Act or Rules to make or do, the Comptroller may, on a request in writing (*t*), and on payment of the prescribed fee (*u*), give such certificate, which shall also specify on the face of it the purpose for which it has been requested as aforesaid (*x*).

Any person who makes or causes to be made a false entry in any register kept under the Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, is guilty of a misdemeanour (*y*).

**Rectification.**—Omissions or wrong entries in the register may be rectified by the Court on the application of any person aggrieved (*z*) by the omission or wrong entry (*a*). Four clear days' notice of the application must be given to the Comptroller (*b*).

When an order for rectification has been made by the Court, the person in whose favour the order is made must forthwith leave at the Patent Office an office copy of the order, and the necessary alteration in, or addition to, the register is then made (*c*).

### *Inspection and Search of Register.*

Every register kept under the Act is at all convenient times open to the public, subject to the provisions of the Act and to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in such register are given to any person requiring the same on payment of the prescribed fee (*d*).

During the existence of the copyright in a design, the design itself is not open to inspection except by the proprietor, or a

(*t*) See Form I, p. 179, *post*.

(*u*) See p. 172, *post*.

(*x*) Rule 34; and see Form J, p. 179, *post*.

(*y*) Sect. 93; see p. 147, *post*.

(*z*) As to who is "a person aggrieved," and generally on this question, see the chapter on "Rectification of the Re-

gister," pp. 102, *seq.*, *ante*.

(*a*) Sect. 90 of the Act of 1883, amended by sect. 23 of the Act of 1888.

(*b*) Rule 27.

(*c*) Rule 28.

(*d*) 1883, sect. 88, amended by 1888, sect. 22; see also sect. 100. For the fee, see p. 173, *post*.

person authorized in writing by him, or a person authorized by the Comptroller or by the Court, and furnishing such information as may enable the Comptroller to identify the design. But where the registration of a design is refused on the ground of identity with a design already registered, the applicant for registration is entitled to inspect the design so registered. The inspection takes place in the presence of the Comptroller, or of an officer acting under him. The person making the inspection must pay the prescribed fee (*e*), and is not entitled to take any copy of the design (*f*).

After the copyright in any design has ceased, however, any person may on the production of the number of such design, and on paying the prescribed fees (*e*), inspect and take copies of such design (*g*).

The days and hours when inspection may take place are notified by a placard posted at the Patent Office (*h*).

On the request (*i*) of any person producing a particular design together with its mark of registration, or producing only its mark of registration, or furnishing such information as may enable the Comptroller to identify the design, and on payment of the prescribed fee (*k*), it is the duty of the Comptroller to inform such person whether the registration still exists in respect of such design, and if so, in respect of what class or classes of goods, and to state also the date of registration and the name and address of the registered proprietor (*l*).

The Comptroller may, on receipt of the prescribed fee (*k*), make searches among the designs registered at the Patent Office, and inform any person requesting (*i*) him so to do whether a particular design produced by such person, and to be applied to goods in any particular class, is or is not identical with, or an obvious imitation of, any registered design applied to such goods of which the copyright is still existing (*m*). The request for search must be accompanied by two representations of the design to be searched for (*n*).

(*e*) See p. 173, *post*.

(*f*) 1883, sect. 52 (1), amended by 1888, sect. 6.

(*g*) Sect. 52 (2), and Rule 33.

(*h*) See Rule 33.

(*i*) See Form N, p. 151, *post*.

(*k*) See p. 173, *post*.

(*l*) 1883, sect. 53.

(*m*) Rule 35. But such a statement is not evidence in an action for infringement; see *Smith v. Hope*, 6 R. P. C. p. 204, and p. 139, *post*.

(*n*) See "Instructions to persons, &c.," PART. 13, p. 195, *post*.



## CHAPTER XII.

## PRACTICE AND EVIDENCE.

As a rule, the general principles of law as to practice and evidence apply to design cases as well as other cases, but in some respects the principles which are followed in design cases differ from those followed in ordinary cases, and there are other principles which are peculiar to design cases. It is proposed in this chapter to point out some of the more noticeable principles which have been decided by the Courts, or laid down by the Acts or Rules.

**A.—Practice.***(1.) General Points.*

Where there is no special rule or reason to the contrary, the general course of practice followed in patent cases will also be followed in design cases. In the case of *Morris, Wilson & Co. v. Corentry Machinists' Co., Ltd.* (a), North, J., said: "What reason is there why the same course of practice should not be followed where the action is one for the infringement of a registered design as that settled and adopted in the case of the infringement of a patent? No reason has been suggested that seems to me to be a good one. No special reason has been suggested in respect of this particular action; and the question is whether it is not a convenient rule that the course of proceedings adopted for patent actions should be followed as regards actions for infringement of registered designs. . . . It seems to me that the practice which would be followed if this were a patent action should also be followed, although it is not an action for infringement of a patent, but of a registered design."

(a) 8 R. P. C. 353.

In the above case North, J., held that the rule of practice in patent actions, which allows a defendant to amend particulars of objection upon the terms that the plaintiff may then, within a given time, discontinue his action, and that if he does so the defendant must pay the plaintiff's costs subsequent to the delivery of the first particulars, is applicable to design actions. But though this rule is almost invariably followed in patent cases, the judge has an absolute discretion in the matter, which cannot be fettered by any rule of practice; and if he does not follow the general rule the exercise of his discretion will not be interfered with (*b*).

A defendant in an action for infringement of a design can raise the same questions that have been raised in a previous action against other defendants (*c*). But where the questions have been decided by a Court of Appeal, the Court will apparently, in a subsequent action, feel bound by those decisions without further consideration (*d*).

**Inspection.**—By the Rules of the Supreme Court, Order 50, rr. 3—6, the Court is given wide powers of ordering an inspection, and in patent cases inspection is very necessary and frequently resorted to where a patent is being infringed secretly, *e.g.*, where infringing machinery is being used in a workshop. But there is an important difference between patents and designs in this respect, that in patent cases the patent may be infringed merely by a person making and using the patented article, so that in such cases the patentee may be unable to satisfy himself that his patent is being infringed, unless he can obtain access to and inspection of the article he believes to be a piracy. But in the case of designs it is only the unauthorised application of a registered design, or of an imitation thereof, to any articles *for the purposes of sale* which is an infringement (*e*), so that the aggrieved party will nearly always be able to purchase a sample of the piratical article and will rarely need inspection. Inspection might be necessary in such a case as *McCrae v. Holdsworth* (*f*), where piratical articles were

(*b*) *Woolley v. Broad*, 9 R. P. C. 429.

(*c*) See *Walker v. Hecla Foundry Co.*, 5 R. P. C. p. 72.

(*d*) See *per* Lord McLaren in *Walker, Hunter & Co. v. Hecla Foundry Co.*, 5 R.

P. C. p. 73; and *per* the Lord President (in the same case on appeal), p. 367.

(*e*) See p. 65, *ante*.

(*f*) 2 De G. & Sm. 496.

manufactured during the period of copyright, but were not intended to be sold till after the expiration of that period. If inspection should in any case be necessary, the ordinary rules applicable to inspection in the case of patents would doubtless be followed (*g*).

**Interrogatories.**—In an action for a penalty under sect. 58 the defendant is not bound to answer interrogatories, the action under that section being for a penal sum, and the remedy given by that section being therefore a punishment for an offence, not compensation for an injury (*h*).

In the case of *Saunders v. Wiel*, Day, J., said (*i*), with reference to this question, that he did not think it was at all material whether the action was brought under sect. 58 or 59. "I think the objection would be as strong if he is proceeding under sect. 59, because, while sect. 58 remains in the Statute Book, to my mind he (the plaintiff) is not entitled to claim, by way of interrogatories, evidence of an offence committed under sect. 58, even in proceedings under sect. 59." This remark of Mr. Justice Day's is only an *obiter dictum*, as the action was treated as being brought under sect. 58; and the Court of Appeal declined to say what would be the construction as to the question of interrogatories if the action were brought under sect. 59. But it is suggested that interrogatories should be admissible in actions under sect. 59; for the remedies under sects. 58 & 59 are alternative, and cannot both be pursued for the same offence (*k*), so that a plaintiff, by bringing his action under sect. 59, practically absolves the defendant from any liability for a penalty under sect. 58, and the decision of the Court of Appeal in the case above was based entirely on the ground that interrogatories could not be administered to a defendant if they tended to show that he was liable to a penalty.

**Pleadings.**—If the statement of claim is so framed that it is doubtful under which section (58 or 59) the plaintiff is bringing his action, he may be compelled, by application in Chambers, to elect under which section he will proceed (*l*).

(*g*) See R. S. C. Order 50; and Edmunds on Patents, pp. 414 *et seq.*

(*h*) *Saunders v. Wiel* 9 R. P. C. 459.

(*i*) *Ibid.* at p. 461.

(*k*) See p. 88, *ante*.

(*l*) *Per* Day, J., in *Saunders v. Wiel*, above, p. 460; and *per* Esher, M. R., *ibid.* pp. 463, 465. In that case, the

In an action against a seller of piratical goods, the statement of claim should set out that the defendant knew that the proprietor had not given his consent to the application of the design (*m*).

The statement of defence should contain all the material grounds upon which the defendant intends to rely. In the case of *Walker, Hunter & Co. v. Hecla Foundry Co.* (*n*), the defendants, not having set up in their pleadings the defence of "anticipation," were not allowed to raise the question at the trial.

In the case of *Rivett v. Grimshaw* (*o*), the defendants in an action for infringement objected to the validity of the plaintiff's design on the ground (among others) that it had been anticipated, and in their particulars of objection specified several instances of alleged anticipation. Six days before the trial they gave notice to the plaintiffs that they intended to produce evidence in respect of two other instances of anticipation. The plaintiffs at the trial objected to the receipt of this evidence, but it was held that sufficient notice had been given.

The question whether a registered design has been infringed, and whether it is novel or not, is for the jury (*p*); but it is for the Court, looking at the statute and looking at the registered design, to say whether the requirements of the statute have been complied with (*p*). The question whether or not "all proper steps to ensure marking" have been taken by the registered proprietor under the proviso in sect. 51, is a question for the jury (*q*).

**Onus of proof.**—Where one of the grounds of defence to an action for infringement is that the plaintiff is not the proprietor of the design, the onus of proof lies with the plaintiff (*r*). In a motion to rectify the register by striking out the respondent's name

plaintiff having declined to make an election, the Divisional Court and Court of Appeal held that he must be taken to be proceeding under sect. 58.

(*m*) See *per* Wright, L. J., in *Woolley v. Broad*, 9 R. P. C. p. 212.

(*n*) 5 R. P. C. 71.

(*o*) 11 R. P. C. 351.

(*p*) *McCrea v. Holdsworth*, L. R. 1 Q. B. 261.

(*q*) See *per* Lord Low in *Johnson v. Bailey*, 11 R. P. C. p. 24.

(*r*) See in *Huthersall v. Moore*, 9 R. P. C. p. 38.

as registered owner and proprietor, the onus is on the applicant to show that the respondent is not the proprietor (s).

In an application to expunge a design from the register, if the applicant is in the same trade as the respondent, he is *prima facie* an "aggrieved person" within the meaning of sect. 90 of the Act; and the onus of disproving this, by showing that he could not possibly be injured, is upon the respondent (t).

In an action for infringement it is, of course, for the plaintiff to show that his registered design has been infringed. But if the plaintiff can show that the defendant knew of his (the plaintiff's) registered design, and that the defendant's design is an imitation of the plaintiff's design, though the imitation is not close enough to constitute it an *obvious* imitation, then the burden of proving that it is not a *fraudulent* imitation (u) is thrown upon the defendant. In the case of *Grafton v. Watson* (x), Cotton, L. J., in the course of his judgment, remarked: "When the registered design is known, then, if there is imitation, the burden of proving that the registered design was not copied is, to my mind, thrown on the person who produces the pattern like that which is imitated. . . . In my opinion there is here a *prima facie* case of imitation; and without such further explanation as may be given by the defendants, such *prima facie* case is, in my opinion, within the meaning of the Act, a fraudulent imitation" (y).

In an action against a seller of piratical goods, it is for the plaintiff to prove affirmatively that the defendant knew that the registered proprietor had not given his consent to the application of the design (z).

**Order for delivery up.**—An order for delivery up of piratical articles (a) to a successful plaintiff can only be made against the defendant himself, and not against third parties who are in

(s) See in *Re Heinrichs' Design*, 9 R. P. C. 73.

(t) *Per* Fry, L. J., in *Re Apollinaris Co.'s Trade Marks*, 8 R. P. C. p. 160; and see p. 107, note (x), *ante*.

(u) As to a design being a fraudulent, but not an obvious, imitation, see p. 72, *ante*.

(x) 51 L. T. (N. S.) p. 144.

(y) *Cp.* also *Demayrol v. Booth*, 9 R. P. C. p. 502.

(z) See *per* Bristowe, V.-C., in *Smith v. Lewis Roberts & Co.*, 5 R. P. C. p. 615, and p. 90, *ante*.

(a) See p. 95, *ante*.

possession of some of the piratical articles (*b*) ; but such third parties may apparently be added as defendants, so as to restrain them from parting with the articles except to the plaintiff (*c*).

The form of the order for delivery up is a direction that the defendant shall deliver up the piratical articles on an affidavit that they are all that he has got (*d*).

**Evidence in Appeal Court.**—In the Appeal Court, where the plaintiffs' case had been dismissed in the Court below without hearing the defendants' evidence, the Court of Appeal, in order to avoid a reference back to the Court below, went into the defendants' case and permitted their counsel to state the facts they could have proved, which were admitted by counsel for the plaintiffs, and thereupon gave judgment for the plaintiffs (*e*).

**Parties in applications under sect. 90.**—In applications to rectify the register the Comptroller is usually made a respondent, but this is not necessary (*f*), though four clear days' notice of the application must be given to him (*g*). Neither is it necessary, in cases where the applicant is not himself the registered proprietor, to make the registered proprietor a respondent, though it is usual to do so if he is within the jurisdiction ; and he is in any case entitled to have proper notice of the application (*h*). If the proprietor becomes bankrupt, the trustee in bankruptcy may apparently be made a respondent (*i*).

## (2.) *Jurisdiction of Courts.*

**English Courts.**—Under the Act of 1812 the penalty imposed by sect. 8 of that Act could be recovered by an action of debt, or on the

(*b*) *Per* Robinson, V.-C., in *Knowles & Co. v. John Bennett & Sons*, 12 R. P. C. p. 118.

(*c*) *Ibid.*

(*d*) See in *Gordon & Munro v. Patrick & Hill*, 12 R. P. C. p. 25.

(*e*) *Harper & Co. v. Wright & Butler Lamp Manufacturing Co.*, 12 R. P. C. 483.

(*f*) See in *Re King & Co.'s Trade Mark*, 9 R. P. C. 350, and p. 358.

(*g*) Rule 27.

(*h*) See *per* Lindley, L. J., in *Re King & Co.'s Trade Mark*, above, p. 361. As to giving notice to the registered proprietor when he is domiciled outside the jurisdiction, and generally as to the procedure in applications to rectify the register, see pp. 112, 113, *ante*.

(*i*) See *Rowe's Trade Mark*, 48 L. T. (N. S.) 388.

case, or by summary proceedings before two justices of the peace. The penalty imposed by sect. 58 of the Act of 1883 is now made by that section a simple contract debt, recoverable only by action in "any Court of competent Jurisdiction"; sect. 59 merely says that "an action for the recovery of damages" may be brought.

Sect. 117 of the Act defines "the Court" as meaning (subject to the provisions for Scotland, Ireland, and the Isle of Man (*k*)) Her Majesty's High Court of Justice in England, which now, by virtue of the Act 53 & 54 Viet. c. 23, includes the Court of Chancery of the County Palatine of Lancaster so far as regards persons and property within the jurisdiction of that Court (*l*). It would seem, therefore, that any action in respect of a design, whether under sect. 58 or 59, should be brought in the High Court, and as a matter of practice this is the usual course (*m*). It seems clear that the County Court has no jurisdiction where the copyright of a registered design is in question, as, for instance, where the defendant sets up the defence that the plaintiff's copyright is invalid; for the County Courts Act, 1888, sect. 56, excepts from the jurisdiction of that Court any action in which the title to a franchise is in question. In the case of *Regina v. The County Court Judge of Halifax* (*n*), it was held that the word "franchise" in that section includes a privilege which is granted by the Crown in respect of its prerogative, and that a patent is such a grant, and is therefore within the word "franchise"; and this definition would include a copyright in a design as well as a patent (*o*). And even if the copyright of the plaintiff is not challenged, and the only question is whether it has been infringed, it would seem that the action should still be brought in the High Court, as the express provision of a tribunal by sect. 117 of the Act of 1883 is not

(*k*) See pp. 136, 137, *post*.

(*l*) See also *per* Esher, M. R., in *Reg. v. County Court Judge of Halifax*, 8 R. P. C. p. 344.

(*m*) It may be noticed that sect. 8 of the Act of 1858, which was repealed by the Act of 1883, expressly provided that proceedings for damages caused by piracy might be instituted in the County Court; there is no similar provision in the Act of 1883.

(*n*) 8 R. P. C. 338.

(*o*) The case of *Moody v. Tree*, 9 R. P. C. 333, was tried in the County Court; and in the case of *Chard v. Carry*, 9 R. P. C. 123, where the plaintiff obtained 20*l.* damages, Grantham, J., certified that it was a proper case to bring in the High Court; but in neither case was the question of the jurisdiction of the County Court raised.

repealed by anything in the County Courts Act, 1888 (*p*). The judgments in the Court of Appeal in the case cited above show that the judges were of opinion that the Act of 1883 ousted the jurisdiction of the County Court in *all* patent actions (*i.e.*, in questions of infringement as well as of title), quite apart from the exception laid down in sect. 56 of the County Courts Act, 1888; and sect. 117 applies to designs as well as to patents. On the other hand, it is possible that the words "any Court of competent jurisdiction" in sect. 58 may be held to include the County Court in cases where the title to the copyright is not disputed. The question is by no means free from doubt.

The parties to the action, however, can by agreement in writing give the County Court jurisdiction to try the action (*q*); but the judgment of the Court will not be evidence of title between the parties or their privies in any other action or matter in that Court or any other Court (*r*).

The plaintiff may bring his action in either the Chancery or the Queen's Bench Division. If he desires that the case should be tried by a jury, the Queen's Bench is of course the proper division; but if not, the action is more usually brought in the Chancery Division.

Applications to rectify the register, under sect. 90 of the Act of 1883, must be made to the High Court (*s*).

**Scotch and Irish Courts.**—Section 111, sub-sect. 1, of the Act of 1883, enacts that the provisions of the Act conferring a special jurisdiction on the Court as defined by the Act (*t*) shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in proceedings relating to designs; and declares that with reference to any such proceedings in Scotland the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either division of the said Court; and that with reference to any

<sup>(p)</sup> See *per* Kay, L. J., in *Reg. v. County Court Judge of Halifax*, 8 R. P. C. p. 345.

<sup>(q)</sup> County Courts Act, 1888, sects. 61, 64.

<sup>(r)</sup> County Courts Act, 1888, s. 61. As to costs in such a case, see p. 146, note (*x*), *post*.

<sup>(s)</sup> See p. 102, *ante*.

<sup>(t)</sup> *I.e.*, by sect. 117, the High Court of Justice in England.



such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

This section does not exclude the jurisdiction of the High Court of Justice in England, even in cases where the registered proprietor is a Scotchman or Irishman, but preserves to the Scotch and Irish Courts concurrent jurisdiction in such cases (*u*).

It seems doubtful whether or not an application to rectify the register can be made to a Scotch or Irish Court (*x*).

Section 108 of the Act provides that in Scotland any offence under the Act declared to be punishable on summary conviction (*y*) may be prosecuted in the Sheriff Court.

Section 117 provides that in the application of the Act to Ireland "summary conviction" means a conviction under the Summary Jurisdiction Acts there defined.

**Courts of Isle of Man.**—Section 112 provides that the Act shall extend to the Isle of Man, and that nothing in the Act is to affect the Jurisdiction of the Courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a design competent to those Courts. It does not seem that under this section a motion to rectify the register could be made to a Court in the Isle of Man (*z*).

Under the same section the punishment for a misdemeanour (*u*) under the Act in the Isle of Man is to be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding £100 at the discretion of the Court; and any offence under the Act committed in the Isle of Man, which would in England be punishable on summary conviction (*b*), may be prosecuted, and the fine recovered at the instance of any person aggrieved (*v*), in the manner in which offences

(*u*) *Re King & Co.'s Trade Mark*, 9 R. P. C. 350, and p. 362.

(*x*) *Ibid.*; and see pp. 102, 103, *ante*, where the question is discussed.

(*y*) See sects. 105, 106, of the Act of 1883, and sect. 1 of the Act of 1888, and p. 147, *post*.

(*z*) See p. 103, *ante*.

(*a*) See sect. 91, and p. 147, *post*.

(*b*) See sects. 105, 106, of the Act of 1883, and sect. 1 of the Act of 1888, and p. 147, *post*.

(*v*) The interpretation of "a person aggrieved" under this section would probably be the same as the interpretation put on the corresponding words in sect. 90; see pp. 104 *et seq.*, *ante*.

punishable on summary conviction may for the time being be prosecuted.

## B.—Evidence.

The Designs Acts and Rules have made various provisions as to what may be accepted as evidence with reference to registered designs.

By sect. 55, sub-sect. 2, of the Act of 1883, the Register of Designs is made *prima facie* evidence of any matters by the Act directed or authorized to be entered therein.

Section 88 of the Act of 1883 provides for the giving of certified copies of entries in the register (*d*); and sect. 89 enacts that printed or written copies or extracts, purporting to be certified by the Comptroller (*e*) and sealed with the seal of the patent office (*f*), of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals (*g*).

By sect. 96 a certificate (*h*) purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorized by the Act, or by any general rules made thereunder, to make or do, is to be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Section 25, sub-sect. 2, of the Act of 1888, provides that all documents purporting to be orders made by the Board of Trade, and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorized in that behalf by the President of the Board, shall be received in evidence and shall be deemed to be such orders without further proof, unless the contrary is shown.

By sub-sect. 3 of the same section a certificate, signed by the

(*d*) See p. 127, *ante*.

(*e*) A plain copy will not be accepted as evidence; see *per* Kekewich, J., in *Hastlett v. Hutchinson*, 8 R. P. C. p. 461.

(*f*) See sect. 84.

(*g*) See also sect. 100.

(*h*) As to the granting of certificates, see p. 127, *ante*, and Rule 24.

President of the Board of Trade, that any order made or act done is the order or act of the Board, is to be conclusive evidence of the fact so certified.

Under sect. 97 of the Act of 1883, any application, notice, or other document, authorized or required to be left, made, or given at the Patent Office, or to the Comptroller, or to any other person under the Act, may be sent by a prepaid letter through the post; and, if so sent, is to be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post; and, in proving such service or sending, it is sufficient to prove that the letter was properly addressed and put into the post (*i*).

Under Rule 35 of the Designs Rules the Comptroller may search among the designs registered at the Patent Office, and inform any person requesting him so to do whether a particular design produced by such person, and to be applied to goods in a particular class, is or is not identical with, or an obvious imitation of, any registered design applied to such goods of which the copyright is still existing; but a letter from the Comptroller giving this information is not admissible as evidence in an action for infringement or other proceedings (*k*).

It was decided in the case of *Walker, Hunter & Co. v. Falkirk Iron Co.* (*l*) that the purpose for which a design is registered (*i.e.*, whether it is registered for pattern, shape, or ornament) may be proved by evidence in an action for infringement of copyright. This point, however, is not now of so much importance, as it has recently been decided that where a person registers a design as applicable for one of those purposes, *e.g.*, for "pattern," the protection given to his design is not necessarily confined to such parts of the design as come strictly within that purpose; the Court will not in all cases draw a hard and fast distinction between "pattern,"

(i) This provision is repeated in Rule 11. As to what is sufficient evidence of posting, see *Trotter v. Maclean*, 13 Ch. Div. p. 580; and *Taylor on Evidence*, 9th ed. p. 158.

(k) See *Smith v. Hope*, 6 R. P. C. pp.

203, 204. *Quære*, whether such a letter might be admissible, as against the Comptroller, in a motion to rectify the register where the Comptroller is made a respondent.

(l) 4 R. P. C. 390.

"shape," and "ornament." In the case of *Heath v. Rollason* (*m*), where the design was registered as "applicable for the pattern," Lord Herschell, in the course of his judgment, remarked: "All that sect. 47 and the following sections deal with is the question of 'design,' that is the word used and the only word; but the word 'design' is interpreted by the interpretation clause. In my opinion, the object of that interpretation clause was to make the word 'design' as extensive as it reasonably ought to be. It was not intended to draw the distinction suggested as a sharp, hard and fast distinction between the design being applicable 'for the pattern,' or 'for the shape or configuration,' or 'for the ornament.' I do not think that you can say that 'pattern,' as it is used in that section, necessarily and always excluded the shape or configuration, and that nothing could be included in 'shape or configuration' which might not fall to be considered under 'pattern'; or, again, that the 'ornament thereof' might not be part of the pattern and included under the word 'pattern.' The words have not a sharply defined meaning." And again, further on, "certainly the word 'pattern' very often includes, as I have said, what you might ordinarily speak of as 'ornament,' or an element of it may be certain 'shapes' and 'configurations' in parts of the design" (*n*).

But there may, of course, be cases in which the "pattern" is quite distinct from the "shape" or "ornament," and in such cases, if there is any question as to which purpose the design was registered for, the question may be settled by evidence, and the Court will, if necessary, call for the statement as to the purpose of the design contained in the application for registration (*o*).

Where the defendant in an action for infringement has deliberately copied the plaintiff's design, and then attacks that design on the ground of want of novelty, the fact that he has so copied it is some evidence of its novelty, as showing that he at any rate thought it was novel and worth copying (*p*).

(*m*) 15 R. P. C. 441.

(*n*) Cf. *per* Lindley, M.R., in the Court below, 11 R. P. C. p. 913; and the judgments of Lord Herschell and Rigby, 1. J., in *Harper & Co. v. Wright & Co.*,

12 R. P. C. pp. 490, 495.

(*o*) See *Walker, Hunter & Co. v. Falkirk Iron Co.*, above, p. 395.

(*p*) See *per* Lord Herschell, in *Harper &*

The commercial success of a design has been considered as evidence of novelty (*q*) ; but it is suggested that this is wrong, as commercial success is evidence of utility only (*r*), and a design may well be useful and therefore successful without being substantially novel (*s*).

*Co. v. Wright, &c. Co.*, above, p. 492 ; and  
cp. *per* Day, J., in *Heinrichs v. Basten-*  
*dorff*, 10 R. P. C. p. 163 ; and *per* Hall,  
V.-C., in *Nevill v. Bennett & Sons*, 15 R.  
P. C. p. 415.

(*q*) In *Tyler & Sons v. Sharpe Bros. &*  
*Co.*, 11 R. P. C. 35.

(*r*) See *per* Kekewich, J., in *Bach's*  
*Design*, 6 R. P. C. p. 377.

(*s*) See p. 32, *ante*.

## CHAPTER XIII.

## COSTS.

IN actions for infringement of a design, as in other actions, the costs are in the discretion of the Court or judge, though when the action is tried before a jury the costs follow the event, unless the judge or Court for good cause otherwise order (*a*).

But though, in the absence of special circumstances, costs will usually follow the event, a successful party may be deprived of the whole or part of his costs on various grounds.

**Improper conduct.**—In the case of *Sherwood & Cotton v. Decorative Art Tile Co.* (*b*), which was commenced before a special jury, but ultimately (after the opening speech) decided by the judge alone, the plaintiffs succeeded at the trial and were awarded 50*l.*; but the learned judge, on the ground that they had given some unscrupulous and improper evidence, and that there were many witnesses who ought never to have been called, only allowed them two-thirds of their taxed costs.

In the case of *Cooper v. Symington* (*c*), where the plaintiff moved for an injunction against the defendants, and the defendants moved to rectify the register by expunging the plaintiff's design, both motions were heard on the same day, and the defendants succeeded in both, on the ground that the plaintiff's design was not novel or original. But while the defendants' motion to expunge was granted with costs, the plaintiff's motion for an injunction was dismissed without costs, the learned judge saying that he did not like that part of the defendants' case, as they had filed affidavits denying

(*a*) R. S. C., Order 65, r. 1. As to  
scale of costs, see p. 146, *post*.

(*b*) 4 R. P. C. 267.

(*c*) 10 R. P. C. 264.

that they had copied the plaintiff's design, but at the trial admitted that they had copied.

In the case of *Proctor v. Bayley* (*d*) the Court of Appeal refused an injunction, reversing the decision of the Court below; but as the defendants had not given full information, which would probably have prevented litigation, they were allowed the costs of the appeal, but not any costs in the Court below (*e*).

**Partial failure.**—Where a party succeeds generally in the case, but fails on some of the issues, he is entitled to the general costs of the action; but he may be made to pay the costs of any distinct issues on which he has failed, though not the costs of any issues which have not been decided. In the case of *Blank v. Footman, Pretty & Co.* (*f*) the defendants raised seven defences, only two of which, the third and fourth, were argued out and decided, though the fifth and sixth were partly argued. The defendants failed on the third defence, but succeeded on the fourth, which was fatal to the plaintiff's case. The defendants were given the general costs of the action as well as the costs of the issue on which they had succeeded; but the plaintiff was given the costs of the third issue on which he had succeeded. Kekewich, J., in deciding the question of costs, said: "The defendant is entitled to fight all along the line. He is entitled to put his back against the wall and fight every available point of advantage. I think it would be extremely hard on defendants as a rule, if at the trial they were told: you have beaten the plaintiff, but, because you raised some points upon which you have not succeeded, therefore you shall not have all the costs of the action—and it is obvious that it might lead to lengthening trials, which are already long enough, if counsel understood that unless they fought out every point they would not be allowed their costs, even in a successful case. On the other hand, it is a useful rule that where there is a distinct issue upon which the generally successful party fails, and that issue can be separated from the others so that you may show that it has really no immediate connection with those upon which the party has succeeded, he ought not to

(*d*) 42 Ch. Div. 390.

(*f*) 5 R. P. C. 653.

(*e*) Cp. *Millington v. Fox*, 3 My. & Cr. 338.

have the costs of that issue on which he has failed, and which, presumably, ought never to have been raised. Now, applying that to the case before me, I am not disposed to think that the defendants ought to be deprived of their costs of any of these defences except the third. As regards the others to which reference has been made—the fifth and sixth—though, perhaps, in the event they might as well have been left out, still they were fair points for fighting defendants to raise, and on the principle already mentioned, I do not think they ought to be mulcted in costs because, succeeding in the whole, they have not succeeded in those. But as regards the marking (*g*), that issue has been argued out and there has been some evidence directed to it, and I have distinctly held in favour of the plaintiff on that point. I think the plaintiff, succeeding upon that entirely distinct issue, ought to have the costs of that one issue as against the general costs of the action” (*h*).

In *Demartial v. Booth* (*i*) the plaintiff moved for an interlocutory injunction against the defendant, and the defendant moved to expunge the plaintiff's design from the register. Kekewich, J., held that the plaintiff's registered design was valid and that the defendant had not infringed it, and he dismissed both motions with costs, the costs to be set off.

**In motions for injunction.**—The proprietor of a registered design is entitled to move for an injunction against even an innocent seller of piratical articles (*k*), or where an infringement is threatened even if not yet actually carried out (*l*). But if the defendant, on receiving notice that he is infringing, immediately discontinues doing so and offers a satisfactory undertaking not to do so in the future, and in short does anything which can reasonably be required to protect the plaintiff against further infringements and loss, then the plaintiff if he still presses for an injunction may, even if he obtains his injunction (*m*), be deprived of his costs. In

(*g*) The third defence.

(*h*) *Cp. Barkin & Co. v. Pratt, Hurst & Co.*, 12 R. P. C. p. 375; *Oliver & Co. v. Thornley & Co.*, 13 R. P. C. p. 501; *Winfield v. Snow*, 8 R. P. C. p. 17; *Pinto v. Radman*, 8 R. P. C. p. 192.

(*i*) 9 R. P. C. 499.

(*k*) See p. 90, note (*a*), *ante*.

(*l*) See p. 92, *ante*.

(*m*) Under such circumstances an injunction may be absolutely refused; see pp. 93, *seq.*, *ante*.



the case of *Wittman v. Oppenheim* (*u*), Pearson, J., somewhat unwillingly, but feeling bound by an earlier case (*o*), ordered the innocent infringer of a registered design to pay the costs of a successful motion for an injunction against him. But in the case of *The American Tobacco Co. v. Guest* (*p*), the plaintiffs, though granted an injunction, were not allowed their costs. Stirling, J., in his judgment said: "Although I agree that it is the right of the plaintiffs to obtain their injunction, yet I cannot think that it is the duty of the Court in every case in which a small retail dealer has innocently (and I think that the defendants in this case have innocently) happened to purchase a small quantity of the spurious goods, to fix him with the costs of an action." The learned judge distinguished *Upmann v. Forester* (*q*), in which case there had been a large consignment of goods. No definite rule can be laid down, but each case will be judged on its merits, and a plaintiff who presses for an injunction against an innocent infringer in the *bonâ fide* and reasonable belief that an injunction is necessary for his protection, will not in general be refused his costs (*r*).

The costs of a motion for an interlocutory injunction are usually made costs in the cause, unless the motion is by arrangement between the parties treated as the trial of the action. But in the case of *Walker & Son v. A. J. Scott & Co.* (*s*), the judge, being of opinion that the action could not in any event succeed, dismissed the motion with costs.

In appeals to the Board of Trade from the refusal of the Comptroller to register a design (*t*), the applicant must always pay his own costs, whether successful or not, as there is no provision in the Acts or Rules as to costs in these cases. On the other hand, he is not apparently liable in either event to pay the Comptroller's costs.

In an application to rectify the register under sect. 90, the Comptroller is usually allowed his taxed costs whether the

(*u*) 27 Ch. Div. 260.

(*o*) *Upmann v. Forester*, 24 Ch. Div.

231.

(*p*) 9 R. P. C. 218.

(*q*) Above.

K.

(*r*) See *per* Jessel, M. R., in *Cooper v. Whittingham*, 15 Ch. Div. p. 504.

(*s*) 9 R. P. C. 482.

(*t*) Sect. 47 (6); and see p. 119, *ante*.

applicant is successful or not (*u*); but the Court has full power to make such order with respect to costs as it thinks fit. If the registered proprietor is a respondent and is unsuccessful, he will usually have to pay the costs of the applicant as well as of the Comptroller (*v*).

**Scale of costs.**—As apparently actions for infringement can only be brought in the High Court, except by consent of both parties (*x*), the costs will always be on the High Court scale, whatever the amount recovered.

Order LXV. rule 9, of the Rules of the Supreme Court provides that costs on the higher scale may be allowed if, on special grounds arising out of the nature and importance, or the difficulty or urgency of the case, the Court or judge so order. The mere fact that the questions raised are of great importance or difficulty is not a sufficient ground for such an order, unless there are also special grounds arising from that fact (*y*).

An order giving costs on the higher scale may be appealed from on the ground that there are no "special grounds" which could give the judge a discretion in the matter; but if there are any special grounds, no appeal can be entertained as to the mode in which the judge has exercised his discretion (*z*).

There is no provision in the law of designs corresponding with sect. 31 of the Act of 1883, or sect. 18 of the Act of 1888, which provide that, in an action for infringement of a patent or trade mark, the Court may certify that the validity of the patent or the right to the exclusive use of the trade mark came in question, and that if the Court so certifies, then in any subsequent action for infringement, the plaintiff, if successful, will be entitled to solicitor and client costs unless the Court orders otherwise.

(*u*) See e.g., in *Re King & Co.'s Trade Mark*, 9 R. P. C. p. 354; *Pneumatic Tyre Co.'s Registered Designs*, 11 R. P. C. 636. But they are not always asked for; see e.g., *Re Batt & Co.'s Trade Marks*, 15 R. P. C. pp. 268, 549.

(*v*) See e.g., in *Richards v. Butcher*, 8 R. P. C. p. 49; *Re Batt & Co.'s Trade Marks*, above, pp. 267, 268; *Re Powell's Trade Mark*, 10 R. P. C. p. 68.

(*x*) See pp. 134, *sup.*, ante. As to

scale of costs in the county court in such cases, see County Court Rules, 1889, Order LA., rr. 9 and 11; and the Annual County Courts Practice, 1898, pp. 302, 303.

(*y*) See *Paine v. Chisholm*, [1891] 1 Q. B. 531; cp. *Grafton v. Watson*, 51 L. T. (N. S.) p. 145; *Gadd & Mason v. Mayor, &c. of Manchester*, 9 R. P. C. p. 535.

(*z*) See *Paine v. Chisholm*, above.

## CHAPTER XIV.

## OFFENCES.

UNDER sect. 93 of the Act of 1883, any person who makes or causes to be made a false entry in any register kept under the Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces, or tenders, or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, is guilty of a misdemeanour (*a*).

Under sect. 105, any person who describes any design applied to any article sold by him as registered which is not so, is liable for every offence (*b*) on summary conviction to a fine not exceeding £5; and for the purposes of that enactment a person is deemed to represent that a design is registered, if he sells the article with the word "registered," or any word or words expressing or implying that a registration has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to, the article. Under this section a person marking an article as "registered" and selling it before actually obtaining a certificate of registration is liable to conviction, even if he has already applied for registration (*c*). The section would probably apply also to the case of a person marking an article as "registered" after the copyright in the design has expired, if there was any intention to represent the registration as still subsisting (*d*).

Section 106 provides that any person who without proper

(*a*) As to the punishment for a misdemeanour in the Isle of Man, see p. 137, *ante*.

(*b*) *I.e.*, for every article sold under the false description; see *Reg. v. Crampton*, 3 R. P. C. p. 367.

(*c*) *Reg. v. Crampton*, above. This was a patent case, but the section applies

alike to patents and designs. See also *Law Journal*, 1894, p. 683.

(*d*) See in *Cheavin v. Walker*, 5 Ch. Div. p. 862. Sect. 11 of the Act of 1842 and sect. 4 of the Act of 1843 expressly provided for this; and the words of sect. 105 seem wide enough to cover such a case, as they were probably intended to do.

authority uses the royal arms, or any arms closely resembling them, in connection with any trade, business, calling, or profession, so as to lead people to believe that he is carrying on his trade, &c. under such authority, shall be liable on summary conviction to a fine not exceeding £20.

Under sect. 1 of the Act of 1888 any person knowingly describing himself as a patent agent in contravention of the provisions of that section is liable on summary conviction to a fine not exceeding £20.

In Scotland, any offence under the Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court (*e*).

In the application of the Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts there defined (*f*).

In the Isle of Man, any offence under the Act punishable on summary conviction may be prosecuted and the fine recovered in the manner applicable to offences punishable on summary conviction (*g*).

Under various Orders in Council (*h*) issued under the Foreign Jurisdiction Acts, penalties are imposed on British subjects doing any acts in certain places under British jurisdiction which, if done in the United Kingdom or a British Possession, would be an offence against the Patents, Designs, and Trade Marks Acts, 1883 to 1888, or any Act, Statute, or Order in Council for the time being in force relating to designs, or any statute amending or substituted for any of such statutes.

(*e*) Sect. 108.

(*f*) Sect. 117.

(*g*) Sect. 112 (3).

(*h*) For a list of these Orders in Council and the places to which they apply, see p. 192, *post*.

## Part II.

PATENTS, DESIGNS, AND TRADE MARKS ACTS,  
1883—1888*(So far as they relate to Designs).*

## PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

(46 &amp; 47 VICT. c. 57.)

*An Act to amend and consolidate the Law relating to Patents for  
Inventions, Registration of Designs, and of Trade Marks.*

[25th August 1883.]

BE IT ENACTED by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

## PART I.—PRELIMINARY.

1. This Act may be cited as the Patents, Designs, and Trade Marks Short title. Act, 1883.

2. This Act is divided into parts, as follows :—

Part I.—PRELIMINARY.

Part II.—PATENTS.

Part III.—DESIGNS.

Part IV.—TRADE MARKS.

Part V.—GENERAL.

Division of  
Act into parts.

3. This Act, except where it is otherwise expressed, shall com- Commence-  
mence from and immediately after the thirty-first day of December ment of Act.  
one thousand eight hundred and eighty-three.

## PART II.—PATENTS.

\* \* \* \* \*

## PART III.—DESIGNS.

*Registration of Designs.*

Application  
for regis-  
tration of  
designs.

47.—(1.) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this part of this Act.

(2.) The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the patent office in the prescribed manner.

(3.) The application must contain a statement of the nature of the design, and the class or classes of goods in which the applicant desires that the design be registered.

(4.) The same design may be registered in more than one class.

(5.) In case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

(6.) The comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal therefrom to the Board of Trade.

(7.) The Board of Trade shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

Drawings,  
&c., to be  
furnished on  
application.

48.—(1.) On application for registration of a design the applicant shall furnish to the comptroller the prescribed number of copies of drawings, photographs or tracings of the design sufficient, in the opinion of the comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design.

(2.) The comptroller may, if he thinks fit, refuse any drawing, photograph, tracing, representation or specimen which is not, in his opinion, suitable for the official records.

Certificate of  
registration.

49.—(1.) The comptroller shall grant a certificate of registration to the proprietor of the design when registered.

(2.) The comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, grant a copy or copies of the certificate.

*Copyright in registered Designs.*

Copyright on  
registration.

50.—(1.) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

(2.) Before delivery or sale of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration) furnish to the comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the comptroller may erase his name from the register, and thereupon his copyright in the design shall cease.

51. Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered; and if he fails to do so the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article.

Marking  
registered  
designs.

52.—(1.) During the existence of copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorised in writing by the proprietor, or a person authorised by the comptroller or by the court, and furnishing such information as may enable the comptroller to identify the design, nor except in the presence of the comptroller, or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof (a).

Inspection of  
registered  
designs.

(2.) When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

(a) By sect. 6 of the Act of 1888 the following words are here added: "Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered."

53. On the request of any person producing a particular design, together with its mark of registration, or producing only its mark of registration, or furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee, it shall be the duty of the comptroller to inform such person whether the registration still exists in respect of such design, and if so, in respect of what class or classes of goods, and stating also the date of registration, and the name and address of the registered proprietor.

Information  
as to exist-  
ence of copy-  
right.

54. If a registered design is used in manufacture in any foreign country and is not used in this country within six months of its registration in this country, the copyright in the design shall cease.

Cesser of  
copyright  
in certain  
events.

#### *Register of Designs.*

55.—(1.) There shall be kept at the Patent Office a book called the Register of Designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed.

Register of  
designs.

(2.) The Register of Designs shall be *prima facie* evidence of any matters by this Act directed or authorised to be entered therein.

#### *Fees.*

56. There shall be paid in respect of applications and registration and other matters under this part of this Act such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury shall from time to time direct.

Fees on regis-  
tration, &c.

*Industrial and International Exhibitions (a).*

Exhibition at industrial or international exhibition not to prevent or invalidate registration.

57. The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with; namely,—

- (a.) The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so; and
- (b.) The application for registration must be made before or within six months from the date of the opening of the exhibition.

(a) See also sect. 3 of the Act of 1886, p. 164, *post*.

*Legal Proceedings.*

Penalty on piracy of registered design.

58. During the existence of copyright in any design—

- (a.) It shall not be lawful for any person without the license or written consent of the registered proprietor to apply (a) such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural; and
- (b.) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor (b).

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any court of competent jurisdiction.

(a) By sect. 7 of the Act of 1888 the words "or cause to be applied" are added after "apply."

(b) By sect. 7 of the Act of 1888 the following words are here added: "Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds."

Action for damages.

59. Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication sale or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application.

*Definitions.*

Definition of "design," "copyright."

60. In and for the purposes of this Act—

"Design" means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and



partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six).

“Copyright” means the exclusive right to apply a design to any article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered.

61. The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise.

Definition of proprietor.

#### PART IV.—TRADE MARKS.

\* \* \* \* \*

#### PART V.—GENERAL.

##### *Patent Office and Proceedings thereat.*

82.—(1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

Patent Office.

(2.) Until a new patent office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

(3.) The patent office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

83.—(1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks,

Officers and clerks.

and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Seal of Patent Office.

84. There shall be a seal for the patent office, and impressions thereof shall be judicially noticed and admitted in evidence.

Trust not to be entered in registers.

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed implied or constructive.

Refusal to grant patent, &c. in certain cases.

86. The comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register of patents, designs or trade marks, as proprietor of a patent, copyright in a design or trade mark as the case may be, shall, subject to (a) any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, license, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.

By sect. 21 of the Act of 1888 the words "the provisions of this Act and to" are added after "subject to."

Inspection of and extracts from registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to (a) such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

(a) By sect. 22 of the Act of 1888 the same words as in the last note are here added.

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the patent office, of or from patents specifications disclaimers and other documents in the patent office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

**90.**—(1.) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person (*a*) from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making expunging or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

Rectification of registers by court.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

(*a*) By sect. 23 of the Act of 1888 the words "or of any other particulars" are added after "name of any person."

**91.** The comptroller may, on request in writing accompanied by the prescribed fee,—

Power for comptroller to correct clerical errors.

(*a*.) Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade mark; or

(*b*.) Correct any clerical error in the name style or address of the registered proprietor of a patent, design, or trade mark.

(*c*.) Cancel the entry or part of the entry of a trade mark on the register: Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.

(*d*.) (*a*).

(*a*) This sub-section, enabling an applicant for registration to amend his application, is added by sect. 24 of the Act of 1888, p. 165, *post*.

**92.** [Applies only to trade marks.]

**93.** If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

Falsification of entries in registers.

**94.** Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Exercise of discretionary power by comptroller.

**95.** The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

Power of comptroller to take directions of law officers.

Certificate of  
comptroller to  
be evidence.

96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Applications  
and notices  
by post.

97.—(1.) Any application, notice, or other document authorised or required to be left made or given at the patent office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Provision as  
to days for  
leaving  
documents  
at office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the patent office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.

Declaration  
by infant,  
lunatic, &c.

99. If any person is, by reason of infancy lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Transmission  
of certified  
printed copies  
of specifica-  
tions, &c.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for  
Board of  
Trade to make  
general rules  
for classifying

101.—(1.) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(a.) For regulating the practice of registration under this Act:

- (b.) For classifying goods for the purposes of designs and trade marks: goods and regulating business of Patent Office.
- (c.) For making or requiring duplicates of specifications, amendments, drawings, and other documents:
- (d.) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications drawings amendments and other documents:
- (e.) For securing and regulating the making printing publishing and selling of indexes to, and abridgments of, specifications and other documents in the patent office; and providing for the inspection of indexes and abridgments and other documents:
- (f.) For regulating (with the approval of the Treasury) the presentation of copies of patent office publications to patentees and to public authorities, bodies, and institutions at home and abroad:
- (g.) Generally for regulating the business of the patent office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

**102.** The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act. Annual reports of comptroller.

#### **102A. (a).**

(a) This section, dealing with the proceedings of the Board of Trade, is added by sect. 25 of the Act of 1888, p. 165, *post*.

*International and Colonial Arrangements.*

International  
arrangements  
for protection  
of inventions,  
designs, and  
trade marks.

103.—(1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade mark as the case may be under this Act, in priority to other applicants; and such patent or registration shall have the same date as the date of the protection obtained *a* in such foreign state.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication in the United Kingdom, or the Isle of Man during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark.

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act: Provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act:

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

*a* By sect. 6 of the Act of 1885 "application" is substituted for "protection obtained."

Provision for  
colonies and  
India.

104.—(1.) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

*Offences.*

**105.**—(1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds. Penalty on falsely representing articles to be patented.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word “patent,” “patented,” “registered,” or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

**106.** Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connexion with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds. Penalty on unauthorised assumption of Royal arms.

*Scotland; Ireland; &c.*

**107.** [Applies only to patents.]

**108.** In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the sheriff court. Summary proceedings in Scotland.

**109.** [Applies only to patents.]

**110.** [Applies only to patents.]

**111.**—(1.) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term “the Court” shall mean any Lord Ordinary of the Court of Session, and the term “Court of Appeal” shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms “the Court” and “the Court of Appeal” respectively mean the High Court of Justice in Ireland and Her Majesty’s Court of Appeal in Ireland. General saving for jurisdiction of courts.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly.

**112.** This Act shall extend to the Isle of Man, and—

(1.) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man, in proceedings for infringement or in any

*Isle of Man.*

action or proceeding respecting a patent, design, or trade mark competent to those courts :

- (2.) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court ;
- (3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

*Repeal ; Transitional Provisions ; Savings.*

Repeal and saving for past operation of repealed enactments, &c.

**113.** The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

- (a.) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act ; or
- (b.) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed ; or
- (c.) Take away or abridge any protection or benefit in relation to any such action or proceeding.

Former registers to be deemed continued.

**114.**—(1.) [Applies only to patents.]

(2.) The registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

Saving for existing rules.

**115.** All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal alteration or amendment shall take effect before the commencement of this Act ; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for prerogative.

**116.** Nothing in this Act shall take away abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.



*General Definitions.*

117.—(1.) In and for the purposes of this Act, unless the context General definitions.  
otherwise requires,—

“Person” includes a body corporate:

“The Court” means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty’s High Court of Justice in England:

“Law Officer” means Her Majesty’s Attorney-General or Solicitor-General for England:

“The Treasury” means the Commissioners of Her Majesty’s Treasury:

“Comptroller” means the Comptroller-General of Patents, Designs, and Trade Marks:

“Prescribed” means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act:

“British possession” means any territory or place situate within Her Majesty’s dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

“Legislature” includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, “summary conviction” means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

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## SCHEDULES.

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### THE FIRST SCHEDULE.

#### FORMS OF APPLICATION, &c.

##### Forms A—D. [Patents.]

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##### Form E.—FORM OF APPLICATION FOR REGISTRATION OF DESIGN.

\_\_\_\_\_ day of \_\_\_\_\_ 18—.

You are hereby requested to register the accompanying \_\_\_\_\_ design, in Class \_\_\_\_\_ in the name of \_\_\_\_\_ a/ of \_\_\_\_\_ who claims to be the proprietor thereof, and to return the same to \_\_\_\_\_.

Statement of nature of design \_\_\_\_\_.

Registration Fees enclosed, £\_\_\_\_\_, \_\_\_\_\_s.

To the Comptroller,

Patent Office, 25, Southampton Buildings, Chancery Lane, W.C.

(Signed) \_\_\_\_\_.

(a) Here insert legibly the name and address of the individual or firm.

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##### Form F. [Trade marks.]

## THE SECOND SCHEDULE.

[Patents only.]

Section 113.

## THE THIRD SCHEDULE.

*Enactments repealed* (which relate to designs).

5 & 6 Vict. c. 100 . . . [1842.]	An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
6 & 7 Vict. c. 65 . . . [1843.]	An Act to amend the laws relating to the copyright of designs.
13 & 14 Vict. c. 104 . . [1850.]	An Act to extend and amend the Acts relating to the copyright of designs.
21 & 22 Vict. c. 70 . . [1858.]	An Act to amend the Act of the fifth and sixth years of Her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
24 & 25 Vict. c. 73 . . [1861.]	An Act to amend the law relating to the copyright of designs.
28 & 29 Vict. c. 3 . . . [1865.]	The Industrial Exhibitions Act, 1865.
33 & 34 Vict. c. 97 . . [1870.]	The Stamp Act, 1870. In part; namely,— Section sixty-five, and in the Schedule, the words and figures, “Certificate of the registration of a design . . . . . £5 0 0 And see section 65.”
38 & 39 Vict. c. 93 . . [1875.]	The Copyright of Designs Act, 1875.

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PATENTS, DESIGNS, AND TRADE MARKS (AMENDMENT)  
ACT, 1885.

(48 & 49 VICT. c. 63.)

*An Act to amend the Patents, Designs, and Trade Marks Act, 1883.*  
[14th August, 1885.]

BE it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal Act). Construction and short title.

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

2—5. [Apply only to patents.]

6. In sub-section one of section one hundred and three of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained." Amendment of s. 103 of 46 & 47 Vict. c. 57.

PATENTS ACT, 1886.

(49 & 50 VICT. c. 37.)

*An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.* [25th June 1886.]

WHEREAS by section five of the Patents, Designs, and Trade Marks Act, 1883, specifications, whether provisional or complete, must be accompanied by drawings if required, and doubts have arisen as to whether it is sufficient that a complete specification refers to the drawings by which the provisional specification was accompanied, and it is expedient to remove such doubts: 46 & 47 Vict. c. 57.

BE it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

1. This Act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those Acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886. Short title and construction.

2. [Applies only to patents.]

Protection  
of patents  
and designs  
exhibited at  
international  
exhibitions.

3. Whereas by section thirty-nine of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by section fifty-seven of the same Act as respects designs, provision is made that the exhibition of an invention or design at an industrial or international exhibition, certified as such by the Board of Trade, shall not prejudice the rights of the inventor or proprietor thereof, subject to the conditions therein mentioned, one of which is that the exhibitor must, before exhibiting the invention, design, or article, or publishing a description of the design, give the Controller the prescribed notice of his intention to do so:

And whereas it is expedient to provide for the extension of the said sections to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

It shall be lawful for Her Majesty, by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the Controller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to Her Majesty in Council may seem fit.

## PATENTS, DESIGNS, AND TRADE MARKS ACT, 1888.

(51 & 52 Vict. c. 50.)

*An Act to amend the Patents, Designs, and Trade Marks Act, 1883.*  
[24th December, 1888.]

46 & 47 Vict.  
c. 57.

WHEREAS it is expedient to amend the Patents, Designs, and Trade Marks Act, 1883, hereinafter referred to as the principal Act:

Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Register of  
patent agents.

1.—(1. After the first day of July one thousand eight hundred and eighty-nine a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act.

2. The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules as are in the opinion of the Board required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3.) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been *bona fide* practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(4.) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds.

(5.) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

## 2—5. [Apply only to patents.]

6. After sub-section one of section fifty-two of the principal Act the following words shall be added; namely,

s. 52, as to inspection of designs.

"Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered."

7.—(1.) In section fifty-eight of the principal Act the words "or cause to be applied" shall be added after the word "apply."

s. 58, as to piracy of registered designs.

(2.) To the same section the following words shall be added: "Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds."

## 8—20. [Apply only to trade marks.]

21. In section eighty-seven of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

s. 87, as to entry of assignments, &c.

22. In section eighty-eight of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

s. 88, as to inspection.

23. In section ninety of the principal Act, after the words "of the name of any person," shall be added the words "or of any other particulars."

s. 90, as to rectification of register.

24. To section ninety-one of the principal Act the following sub-section shall be added; namely,

s. 91, as to correction of errors.

"(d.) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connexion with which he has desired the design or trade mark to be registered."

25. After section one hundred and two of the principal Act the following section shall be added and numbered 102A; namely,

Proceedings of Board of Trade.

"(1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

"(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or

by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

- “(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.”

26. [Applies only to trade marks.]

Construction  
of principal  
Act.

27. The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act.

Commence-  
ment of Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.

Short title.

29. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1888, and this Act and the Patents, Designs, and Trade Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

## DESIGNS RULES, 1890—1898.

### DESIGNS RULES, 1890.

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

#### PRELIMINARY.

1. These Rules may be cited as the Designs Rules, 1890, and shall come into operation from and immediately after the 31st day of March, 1890.

#### INTERPRETATION.

2. In the construction of these Rules any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively.

#### FEES.

3. The fees to be paid under the said Act, so far as it relates to applications for and registration of designs, shall be the fees specified in the First Schedule hereto.

#### FORMS.

4. *An application for the registration of a design shall be made in the Form E. or Form O. in the Second Schedule hereto. The remaining forms in such Schedule may be used in all cases to which they are applicable.*

For this rule another is substituted by Rule 3 of the Designs Rules, 1893. (See p. 174, *post.*)

#### CLASSIFICATION OF GOODS.

5. For the purposes of the registration of designs and of these Rules, goods are classified in the manner appearing in the Third Schedule hereto.

#### APPLICATION FOR REGISTRATION (a).

6. *All communications between an applicant for the registration of a design and the comptroller or the Board of Trade, as the case may be, may be made by or through an agent duly authorised to the satisfaction of the comptroller.*

For this rule another is substituted by Rule 2 of the Designs Rules, 1898. (See p. 176, *post.*)

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(a) See the chapter on "How to Register," pp. 117, *seq.*, *ante.*

7. An application for the registration of a design shall, with the prescribed fee, be left at the Patent Office, Designs Branch, or be sent prepaid by post, addressed to the Comptroller at the Patent Office (Designs Branch), 25, Southampton Buildings, Chancery Lane, London.

8. An application for the registration of a design, and all drawings, sketches, photographs, or tracings of a design, and all other documents sent to or left at the Patent Office (Designs Branch), or otherwise furnished to the Comptroller or to the Board of Trade, shall be written, printed, copied, or drawn upon strong wide-ruled foolscap paper (on one side only), of the size of 13 inches by 8 inches, leaving a margin of not less than one inch and a half on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand.

The Comptroller may in any particular case vary the requirements of this rule as he may think fit.

9. An application for the registration of a design shall be accompanied by a sketch or drawing, or by three exactly similar drawings, photographs, or tracings of the design, or by three specimens of the design, and shall, in describing the nature of the design, state whether it is applicable for the pattern or for the shape or configuration of the design, and the means by which it is applicable.

When sketches, drawings, or tracings are furnished they must be fixed.

When the articles to which designs are applied are not of a kind which can be pasted into books, drawings, photographs, or tracings of such designs shall be furnished.

10. If the Comptroller determines to register a design, he shall as soon as may be send to the applicant a certificate of such registration in the prescribed form, sealed with the seal of the Patent Office.

11. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the Comptroller or to any other person under these Rules may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

In proving such service or sending it shall be sufficient to prove that the letter was properly addressed and put into the post.

#### EXERCISE OF DISCRETIONARY POWERS.

12. Before exercising any discretionary power given to the Comptroller by the said Acts adversely to the applicant for registration of a design the Comptroller shall if so required by the applicant within one month from the date of the Comptroller's objection give the applicant an opportunity of being heard personally or by his agent by sending the applicant ten days' notice of a time when he may be so heard.

13. Within five days from the date when such notice would be delivered in the ordinary course of post, the applicant shall notify to



the Comptroller whether or not he intends to be heard upon the matter.

14. The decision or determination of the Comptroller in the exercise of any such discretionary power as aforesaid shall be notified to the applicant.

APPEAL TO THE BOARD OF TRADE (*a*).

15. Where the Comptroller refuses to register a design, and the applicant intends to appeal to the Board of Trade from such refusal, he shall, within one month from the date of the decision appealed against, leave at the Patent Office, Designs Branch, a notice of such his intention.

16. Such notice shall be accompanied by a statement of the grounds of appeal, and of the applicant's case in support thereof.

17. The applicant shall forthwith on leaving such notice send a copy thereof to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London.

18. The Board of Trade may thereupon give such directions (if any) as they may think fit for the purpose of the hearing of the appeal for the Board of Trade.

19. Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing of the appeal shall be given to the Comptroller and the applicant.

REGISTER OF DESIGNS (*b*).

20. Upon the sealing of a certificate of registration the Comptroller shall cause to be entered in the register of designs the name, address, and description of the registered proprietor, and the date upon which the application for registration was received by the Comptroller, which day shall be deemed to be the date of the registration.

21. Where a person becomes entitled to the copyright in a registered design, or to any share or interest therein, by assignment, transmission, or other operation of law, or where a person acquires any right to apply the design either exclusively or otherwise, a request for the entry of his name in the register as such proprietor of the design, or as having acquired such right, as the case may be (hereinafter called the claimant), shall be addressed to the Comptroller, and left at the Patent Office, Designs Branch.

22. Every such request shall, in the case of an individual, be made and signed by the person requiring to be registered as proprietor; and in the case of a firm or partnership, by some one or more members of such firm or partnership, or, in either case, by his or their agent respectively duly authorised to the satisfaction of the Comptroller; and in the case of a body corporate, by their agent authorised in like manner.

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(*a*) See pp. 119, 120, *ante*.

(*b*) See the chapter on "The Register," pp. 124, *seq.*, *ante*.

23. Every such request shall state the name, address, and description of the claimant, and the particulars of the assignment, transmission, or other operation of law by virtue of which the request is made, so as to show the manner in which and the person or persons to whom the design has been assigned or transmitted, or the person or persons who has or have acquired such right as aforesaid, as the case may be.

24. Every such request shall be accompanied by a statutory declaration to be thereunder written verifying the several statements therein, and declaring that the particulars above described comprise every material fact and document affecting the proprietorship of the design or the right to apply the same, as the case may be, as claimed by such request.

25. The claimant shall furnish to the Comptroller such other proof of title as he may require for his satisfaction.

26. A body corporate may be registered as proprietor by its corporate name.

27. Four clear days' notice of every application to the Court under section 90 of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, for rectification of the Register of Designs, shall be given to the Comptroller.

28. Where an order has been made by the Court, under section 90 of the said Acts, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified, or the purport of such order shall otherwise be duly entered in the register, as the case may be.

#### POWER TO DISPENSE WITH EVIDENCE.

29. Where under these Rules any person is required to do any act or thing, or to sign any document, or make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Comptroller or at the Patent Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

#### AMENDMENTS.

30. Any document, drawings, sketches, or tracings for the amending of which no special provision is made by the said Act may be amended, and any irregularity in procedure which, in the opinion of the Comptroller, may be obviated without detriment to the interests of any person may be corrected, if the Comptroller think fit, and upon such terms as he may direct.

## ENLARGEMENT OF TIME.

31. The time prescribed by these Rules for doing any act or taking any proceeding thereunder may be enlarged by the Comptroller, if he think fit, and upon such terms as he may direct.

## MARKING GOODS (a).

32. *Before the delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall, if such article is included in any of the classes one to twelve in the Third Schedule hereto, cause each such article to be marked with the abbreviation "R<sup>d</sup>" and the number appearing on the certificate of registration, and shall, if such article is included in the classes thirteen or fourteen in the Third Schedule hereto, cause each such article to be marked with the abbreviation "REG<sup>d</sup>."*

For this rule another is substituted by Rule 5 of the Designs Rules, 1893. (See p. 175, *post*.)

## INSPECTION.

33. On such days and during such hours as the Comptroller shall from time to time determine and notify by a placard posted at the Patent Office any person paying the prescribed fee may, on production of the number of any design of which the copyright has ceased, inspect such design, and any person paying the prescribed fee may take a copy or copies of such design.

## CERTIFICATE BY COMPTROLLER.

34. Where a certificate is required for the purpose of any legal proceeding or other special purpose as to any entry, matter, or thing which the Comptroller is authorised by the said Act or these Rules to make or do, the Comptroller may, on a request in writing and on payment of the prescribed fee, give such certificate, which shall also specify on the face of it the purpose for which it has been requested as aforesaid.

## SEARCHES ON PRODUCTION OF SKETCH OF DESIGN.

35. The Comptroller may, on receipt of the prescribed fee, make searches among the designs registered at the Patent Office, and inform any person requesting him so to do whether a particular design produced by such person, and to be applied to goods in any particular class, is or is not identical with or an obvious imitation of any registered design applied to such goods of which the copyright is still existing.

## INDUSTRIAL AND INTERNATIONAL EXHIBITIONS.

36. Any person desirous of exhibiting a design, or any article to which a design has been applied, at an industrial or international exhibition, or of publishing a description of a design during the period

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(a) See the chapter on "Marking," pp. 51, *seq.*, *ante*.

of the holding of the exhibition, shall, after having obtained (a) from the Board of Trade a certificate that the exhibition is an industrial or international one, give to the Comptroller seven days' notice in writing of his intention to exhibit the design or article, or to publish a description of the design, as the case may be.

For the purpose of identifying the design in the event of an application to register the same being subsequently made, the applicant shall furnish to the Comptroller a brief description of the nature of the design, accompanied by a sketch or drawing thereof, and such other information as the Comptroller may in each case require.

(a) This does not mean that *each* intending exhibitor must obtain a certificate, when once the exhibition has been certified by the Board of Trade. A list of the certified exhibitions is kept at the Patent Office.

#### REPEAL.

37. All general rules as to the registration of Designs heretofore made by the Board of Trade under the Patents, Designs, and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of March, 1890, shall be, and they are hereby, repealed, as from that date, without prejudice, nevertheless, to any proceeding which may have been taken under such Rules.

M. E. HICKS-BEACH,  
*President of the Board of Trade.*

31st March, 1890.

#### SCHEDULES.

##### FIRST SCHEDULE.

##### FEES. a).

	£	s.	d.
1. On application to register one design to be applied to single articles in each class except Classes 13 and 14 -	-	0 10	0
2. On application to register one design to be applied to single articles in Classes 13 and 14 -	-	0 1	0
3. On application to register one design to be applied to a set of articles for each class of registration -	-	1 0	0
4. On notice of appeal to Board of Trade against refusal of Comptroller to register -	-	1 0	0
5. Copy of certificate of registration, each copy -	-	0 1	0
6. On request for Certificate of Comptroller for legal proceedings or other special purpose -	-	0 5	0
7. On request to enter name of subsequent proprietor -	{ same as registration fee.		
8. On notice to Comptroller of intended exhibition of an unregistered design -	-	0 5	0

(a) For the Fees 1, 2, and 3, others are substituted by Rule 2 of the Designs Rules, 1893—see p. 174, *post*.

9. Inspection of design in any case in which inspection is permitted by the Patents, Designs, and Trade Marks Acts, 1883 to 1888, and the Designs Rules thereunder, for each quarter of an hour	-	-	-	-	0	1	0
10. Copy of one such design-	-	-	-	{ cost according to agreement.			
11. On request to correct clerical error	-	-	-		0	5	0
12. On request for search under section 53 (a)	-	-	-		0	5	0
13. On request to enter new address	-	-	-		0	5	0
14. For office copy, every 100 words	-	-	-		0	0	4
					(but never less than 1s.)		
15. For certifying office copies, MSS. or printed	-	-	-		0	1	0

NOTE.—The term “set” to include any number of articles ordinarily on sale together irrespective of the varieties of size and arrangement in which the particular design may be shown on each separate article.

M. E. HICKS-BEACH,  
*President of the Board of Trade.*

Approved,  
R. E. WELBY,  
For the Lords Commissioners of Her Majesty's Treasury.  
31st March, 1890.

(a) The same fee is payable on a request for search under Rule 35 of the Designs Rules, 1890 (see p. 197, *post*).

## SECOND SCHEDULE.

### FORMS.

- E. Form of Application to Register (see p. 177).
- F. „ Appeal to Board of Trade (see p. 178).
- G. „ Certificate of Registration (see p. 178).
- H. „ Application for Copy of Certificate of Registration (see p. 178).
- I. „ Request for Certificate for use in Legal Proceedings (see p. 179).
- J. „ Certificate for use in Legal Proceedings (see p. 179).
- K. „ Request to enter Name of Subsequent Proprietor (see p. 179).
- L. „ Notice of intending Exhibition of Unregistered Design (see p. 181).
- M. „ Request for Correction of Clerical Error or for entry of New Address (see p. 181).
- N. „ Request for search under section 53 (see p. 181).
- O. „ Application to Register for a set of Articles (see p. 182).

By Rule 4 of the Designs Rules, 1893, Forms E<sup>1</sup>, O<sup>1</sup>, and K<sup>1</sup> (applicable to lace designs), are added to the above forms.

## THIRD SCHEDULE.

## CLASSIFICATION OF ARTICLES OF MANUFACTURE AND SUBSTANCES.

## Classes.

1. Articles composed wholly or chiefly of metal, not included in Class 2.
2. Jewellery.
3. Articles composed wholly or chiefly of wood, bone, ivory, papier maché, or other solid substances not included in other classes.
4. Articles composed wholly or chiefly of glass, earthenware, or porcelain, bricks, tiles, or cement.
5. Articles composed wholly or chiefly of paper (except hangings).
6. Articles composed wholly or chiefly of leather, including book-binding, of all materials.
7. Paper hangings.
8. Carpets and rugs in all materials, floorcloths, and oilcloths.
9. Lace, hosiery.
10. Millinery and wearing apparel, including boots and shoes.
11. Ornamental needlework on muslin or other textile fabrics.
12. Goods not included in other classes.
13. Printed or woven designs on textile piece goods.
14. Printed or woven designs on handkerchiefs and shawls.

M. E. HICKS-BEACH,  
*President of the Board of Trade.*

31st March, 1890.

## DESIGNS RULES, 1893.

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883—1888, the Board of Trade do hereby make the following Rules:—

1. These Rules may be cited as the Designs Rules, 1893, and shall come into operation from and immediately after the 30th day of November, 1893.

2. For the fees numbered 1, 2 and 3 specified in the First Schedule to the Designs Rules, 1890, shall be substituted the fees specified in the First Schedule hereto.

3. For Rule 4 of the Designs Rules, 1890, shall be substituted the following Rule:—

4. An application for the registration of a design for articles not being lace shall be made in the Form E or Form O in the Second Schedule hereto. An application for one design to be applied to lace shall be made in the Form E1 in the Second Schedule hereto, and for one design to be applied to a set of lace articles shall be made in the Form O1 in the Second Schedule hereto. A request for registration of the name of any subsequent proprietor of a lace design or set of lace designs shall be made in the Form K1 in the Second Schedule hereto. The remaining forms in such Schedule may be used in all cases to which they are applicable.

4. To the forms specified in the Second Schedule to the Designs Rules, 1890, shall be added the forms specified in the Second Schedule hereto.

5. For Rule 32 of the Designs Rules, 1890, shall be substituted the following Rule :—

32. Before delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall, if such article is included in Class 13 or Class 14 in the Third Schedule hereto, cause each such article to be marked with the abbreviation Regd., and shall, if such article is included in any of the Classes 1 to 12 in the Third Schedule hereto, cause each such article to be marked with the abbreviation Id., and also, in the case of articles other than lace, with the number appearing on the certificate of registration.

A. J. MUNDELLA,

*President of the Board of Trade.*

18th November, 1893.

#### SCHEDULE I.

##### FEES.

	£	s.	d.
1. On application to register one design to be applied to single articles in each class not being lace and except articles in Classes 13 and 14 - - - - -	0	10	0
2. On application to register one design to be applied to lace, or to single articles in Classes 13 and 14 - - - - -	0	1	0
3. On application to register one design to be applied to a set of articles, not being lace, for each class of registration - - - - -	1	0	0
3a. On application to register one design to be applied to a set of lace articles - - - - -	0	2	0

A. J. MUNDELLA,

*President of the Board of Trade.*

Approved,

For the Lords Commissioners of Her Majesty's Treasury.

18th November, 1893.

FRANK MOWATT.

#### SCHEDULE II.

##### FORMS.

**E1.**—Application for Registration of a Lace Design in Class 9 (see p. 177).

**O1.**—Application for Registration of a Lace Design to be applied to a Set (see p. 182).

**K1.**—Request to enter name of Subsequent Proprietor of a Lace Design or Set of Lace Designs (see p. 180).

## DESIGNS RULES, 1898.

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883—1888, the Board of Trade do hereby make the following Rules:—

1. These Rules may be cited as the Designs Rules, 1898, and shall come into operation from and immediately after the date hereof.

2. For Rule 6 of the Designs Rules, 1890, shall be substituted the following Rule:—

All communications between an applicant for the registration of a design and the Comptroller or the Board of Trade, as the case may be, may be made by or through an agent duly authorised to the satisfaction of the Comptroller, but the Comptroller shall not be bound to recognise as such agent, or to receive further communications from, any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the Register of Patent Agents kept under the provisions of the Patents, Designs, and Trade Marks Act, 1888, relating to the registration of patent agents, and not since restored.

Dated this 15th day of September 1898.

CHAS. T. RITCHIE,  
*President of the Board of Trade.*



## FORMS

PRESCRIBED BY THE DESIGNS RULES, 1890 AND 1893 (*a*).



*Patents, Designs, and Trade Marks Acts, 1883 to 1888.*

(DESIGNS.)

### Form E.

APPLICATION FOR REGISTRATION OF DESIGN IN CLASSES ———.

You are hereby requested to register the accompanying design in Class ———, in the name of \*———, of ———, who claims to be the proprietor thereof, and to return the same to ———.

Statement of nature of design †———.

(Signed) ———‡.

Dated the ——— day of ——— 189—.

To the Comptroller,

Patent Office, Designs Branch,

25, Southampton Buildings,

Chancery Lane, London, W.C.

\* Here insert legibly the name, address, and description of the individual or firm.

† Such as whether it is applicable for the pattern or for the shape.

‡ To be signed by the applicant.



*Patents, Designs, and Trade Marks Acts, 1883 to 1888.*

(DESIGNS.)

### Form E 1.

APPLICATION FOR REGISTRATION OF A LACE DESIGN IN CLASS 9 (*b*).

You are hereby requested to register, without search, the accompanying Design in Class 9 in the name of \*———, who claims to be the proprietor thereof, and to return the same to ———.

The nature of the design is the pattern.

(Signed) †———.

Dated the ——— day of ——— 189—.

To the Comptroller,

The Patent Office, Designs Branch,

25, Southampton Buildings,

London, W.C.

\* Here insert legibly the name, address, and description of the individual or firm.

† To be signed by the applicant or his agent duly authorized. When signed by an agent, there should be added to the signature, "Agent duly authorized by authorization dated the ——— day of ———, 189—."

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(*a*) For list of places where the forms can be obtained, and the fees payable thereon, see "Instructions how to Register," pp. 194 and 195, *post*.

(*b*) This form is specially kept on sale at the Chief Post Office at Nottingham.

*Patents, Designs, and Trade Marks Acts, 1883 to 1888.*

(DESIGNS.)

**Form F.****APPEAL TO BOARD OF TRADE ON REFUSAL OF COMPTROLLER TO  
REGISTER A DESIGN.***[To be accompanied by an unstamped copy.]*

Sir,

I hereby appeal against your decision upon my application to register ———, and beg to submit my case \* for the decision of the Board of Trade.

I am, Sir,

Your obedient servant,

The Comptroller,

Patent Office, Designs Branch,

25, Southampton Buildings,

Chancery Lane, London, W.C.

\* The statement of the case to be written upon foolscap paper (on one side only), with a margin of two inches on the left-hand side thereof.

*Patents, Designs, and Trade Marks Acts, 1883 to 1888.*(SEAL OF  
PATENT OFFICE.)**Form G.****CERTIFICATE OF REGISTRATION OF DESIGN.**(R<sup>D</sup> No. —.)

Patent Office, Designs Branch,

25, Southampton Buildings,

Chancery Lane, London, W.C.

This is to certify that the Design of which this is a copy was registered this ——— day of ——— 189—, in pursuance of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, in respect of the application of such Design to articles in Class ———, for which a copyright of five years is granted.

*Patents, Designs, and Trade Marks Acts, 1883 to 1888.*

(DESIGNS.)

**Form H.****APPLICATION FOR COPY OF CERTIFICATE OF REGISTRATION OF DESIGN.**

Sir,

I hereby request you to furnish me with a Copy Certificate of Registration of Design No. ——— in Class ———.

(Signed) ———.

Dated the ——— day of ——— 189—.

To the Comptroller,

Patent Office, Designs Branch,

25, Southampton Buildings,

Chancery Lane, London, W.C.

*Patents, Designs, and Trade Marks Acts, 1883 to 1888.*

(DESIGNS.)

**Form I.**

REQUEST FOR CERTIFICATE FOR USE IN LEGAL PROCEEDINGS.

Sir,

I heroby request you to send me for the purpose of use in the suit of \*—— a certificate that the design of which a copy is herein enclosed was †——.

(Signed) ——.

—— day of —— 189—.

To the Comptroller,  
Patent Office, Designs Branch,  
25, Southampton Buildings,  
Chancery Lane, London, W.C.

\* Here state the title of the legal proceeding or the other purpose for which the certificate is required.

† Here state the entry, matter, or thing which the writer wishes certified.

*Patents, Designs, and Trade Marks Acts, 1883 to 1888.*

(DESIGNS.)

**Form J.**

CERTIFICATE FOR USE IN LEGAL PROCEEDINGS.

In the matter of ——.

No. ——.

I, —— Comptroller-General of Patents, Designs, and Trade Marks, hereby certify that ——.

Witness my hand and seal this —— day of —— 189—.

—— Comptroller.

Patent Office, Designs Branch,  
25, Southampton Buildings, (SEAL.)  
London.

*Patents, Designs, and Trade Marks Acts, 1883 to 1888.*

(DESIGNS.)

**Form K.**

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF DESIGN, WITH  
DECLARATION IN SUPPORT THEREOF.

I [*or We*], \*—— hereby request that you will enter my [*or our*] name [*or names*] in the Register of Designs as proprietor [*or proprietors*] of the Design No. —— in Class ——.

I am [*or We are*] entitled as to the said Design ——, †——.

And I do solemnly and sincerely declare that the above several statements are true, and the particulars above set out comprise every

material fact and document affecting the proprietorship of the said Design as above claimed.

† And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

§ ———.

Declared at ——— this ——— day of ——— 189—.

Before me,  
—————.

To the Comptroller,  
Patent Office, Designs Branch,  
25, Southampton Buildings,  
Chancery Lane, London, W.C.

• Here insert name, full address, and description.

† Here state whether design transmitted by death, marriage, bankruptcy, or other operation of law; and, if entitled by assignment, state the particulars thereof, as, *e.g.*, "by deed dated the ——— day of ———, 18—, made between So-and-so of the one part."

‡ This paragraph is not required when the declaration is made out of the United Kingdom.

§ To be signed here by the person making the declaration.

|| Signature and title of the authority before whom the declaration is made.

*Patents, Designs, and Trade Marks Acts, 1883 to 1888.*

(DESIGNS.)

**Form K 1.**

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR OF A LACE DESIGN  
OR SET OF LACE DESIGNS (a).

The Comptroller is requested to enter the name of \* ———, in respect of the proprietorship of the Registered Lace Design or set of Lace Designs No. ——— in Class 9, in place of the name of ——— at present appearing in the Register.

(Signed) † ———.

Dated the ——— day of ——— 189—.

To the Comptroller,  
The Patent Office, Designs Branch,  
25, Southampton Buildings,  
London, W.C.

A. J. MUNDELLA,  
*President of the Board of Trade.*

18th November, 1893.

• Here insert legibly the name, address, and description of the individual or firm.

† To be signed by the registered proprietor and by the assignee.

(a) It may be noticed that this form does not, like Form K, provide for any statement as to the method in which the applicant has become entitled to the design (see Rules 23, 24, and 25).

*Patents, Designs, and Trade Marks Acts, 1883 to 1888.*

(DESIGNS.)

**Form L.**

NOTICE OF INTENDED EXHIBITION OF AN UNREGISTERED DESIGN.

\* ——— hereby give notice of my intention to exhibit a ——— of ——— at the ——— Exhibition, which ——— of ——— 189—, under the provisions of the Patents, Designs, and Trade Marks Acts of 1883 to 1888 † ——— herewith enclose a ———.

(Signed) ———.

Dated the ——— day of ———, 189—.

To the Comptroller,

Patent Office, Designs Branch,

25, Southampton Buildings,

Chancery Lane, London, W.C.

\* Here state name and address of applicant.

† State "opened" or "is to open."

‡ Insert brief description of design, with drawing.

*Patents, Designs, and Trade Marks Acts, 1883 to 1888.*

(DESIGNS.)

**Form M.**

REQUEST FOR CORRECTION OF CLERICAL ERROR OR FOR ENTRY OF  
NEW ADDRESS.

Sir,

I hereby request that ———.

(Signed) ———.

Dated the ——— day of ——— 189—.

To the Comptroller,

Patent Office, Designs Branch,

25, Southampton Buildings,

Chancery Lane, London, W.C.

*Patents, Designs, and Trade Marks Acts, 1883 to 1888.*

(DESIGNS.)

**Form N.**

REQUEST FOR SEARCH UNDER SECTION 53 (a).

Sir,

I hereby request that a search may be made in Class ———.

(Signed) ———.

Dated the ——— day of ——— 189—.

To the Comptroller,

Patent Office, Designs Branch,

25, Southampton Buildings,

Chancery Lane, London, W.C.

(a) This is also the form for a request for search under Rule 35 of the Designs Rules, 1890 (see p. 197, *post*).

*Patents, Designs, and Trade Marks Acts, 1883 to 1888.*

(DESIGNS.)

**Form O.**

APPLICATION FOR REGISTRATION OF DESIGN TO BE APPLIED TO A SET.

You are hereby requested to register the accompanying Design for \*—— being a set of articles in Class —— in the name of †——, of ——, who claims to be the proprietor thereof, and to return the same to ——.

Statement of nature of design ‡——.

(Signed) —— §.

Dated the —— day of —— 189—.

To the Comptroller,

Patent Office, Designs Branch,

25, Southampton Buildings,

Chancery Lane, London, W.C.

\* Here set out the trade description of the articles in the set, as "A toilet set."

† Here insert legibly the name, address, and description of the individual or firm.

‡ Such as whether it is applicable for the pattern or for the shape.

§ To be signed by the applicant.

*Patents, Designs, and Trade Marks Acts, 1883 to 1888.*

(DESIGNS.)

**Form O 1.**

APPLICATION FOR REGISTRATION OF A LACE DESIGN TO BE APPLIED TO A SET (a).

You are hereby required to register, without search, the accompanying Design for a Set of Lace Articles in Class 9 in the name of \*——, who claims to be the proprietor thereof, and to return the same to ——.

The nature of the design is the pattern.

(Signed) †——.

Dated the —— day of —— 189—.

To the Comptroller,

The Patent Office, Designs Branch,

25, Southampton Buildings,

London, W.C.

\* Here insert legibly the name, address, and description of the individual or firm.

† To be signed by the applicant or his agent duly authorised. When signed by an agent there should be added to the signature, "Agent duly authorised by authorisation dated the —— day of ——, 189—."

(a) This form is specially kept on sale at the Chief Post Office at Nottingham.

## INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY (*a*).

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*Signed at Paris, March 20th, 1883.*

*Ratifications exchanged at Paris, June 6th, 1884.*

Her Majesty's Government acceded to this Convention on March 17th, 1884, on behalf of Great Britain and Ireland, power being reserved to Her Majesty to accede to the Convention on behalf of the Isle of Man and the Channel Islands and any of Her Majesty's possessions, on due notice being given. Consequently, any copyright granted to foreigners under the Convention would not extend to the Isle of Man. See p. 114, *ante*.

### ARTICLE I.

THE Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland constitute themselves into a Union for the Protection of Industrial Property.

Les Gouvernements de la Belgique, du Brésil, de l'Espagne, de la France, du Guatemala, de l'Italie, des Pays-Bas, du Portugal, du Salvador, de la Serbie et de la Suisse sont constitués à l'état d'Union pour la protection de la Propriété Industrielle.

For a list of the Orders in Council applying sect. 103 of the Act of 1883 to the above, and other countries, see pp. 191, 192, *post*. Salvador and Guatemala have now withdrawn from the Convention. See note to Article XVIII.

### ARTICLE II.

The subjects or citizens of each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade marks, and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

Les sujets ou citoyens de chacun des Etats Contractants jouiront, dans tous les autres Etats de l'Union, en ce qui concerne les brevets d'invention, les dessins ou modèles industriels, les marques de fabrique ou de commerce et le nom commercial, des avantages

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(*a*) The formal preliminaries are omitted. The whole text of the convention is given, but some of the Articles refer only to trade marks or patents.

que les lois respectives accordent actuellement ou accorderont par la suite aux nationaux.

En conséquence, ils auront la même protection que ceux-ci et le même recours légal contre toute atteinte portée à leurs droits, sous réserve de l'accomplissement des formalités et des conditions imposées aux nationaux par la législation intérieure de chaque Etat.

Clause 3 of the Final Protocol provides as follows:—"The last paragraph of Article II. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the Tribunals and the competence of those Tribunals."

3. "Il est entendu que la disposition finale de l'Article II. de la Convention ne porte aucune atteinte à la législation de chacun des Etats Contractants en ce qui concerne la procédure suivie devant les Tribunaux et la compétence de ces Tribunaux."

#### ARTICLE III.

Subjects or citizens of States not forming part of the Union, who are domiciled or have industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the Contracting States.

Sont assimilés aux sujets ou citoyens des Etats Contractants les sujets ou citoyens des Etats ne faisant pas partie de l'Union qui sont domiciliés ou ont des établissements industriels ou commerciaux sur le territoire de l'un des Etats de l'Union.

#### ARTICLE IV.

Any person who has duly applied for a patent, industrial design or model, or trade mark in one of the Contracting States shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other States of the Union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trade mark.

The above-mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and trade marks. A month longer is allowed for countries beyond sea.

Celui qui aura régulièrement fait le dépôt d'une demande de brevet d'invention, d'un dessin ou modèle industriel, d'une marque de fabrique ou de commerce, dans l'un des Etats Contractants, jouira, pour effectuer le dépôt dans les autres Etats, et sous réserve des droits des tiers, d'un droit de priorité pendant les délais déterminés ci-après.

En conséquence, le dépôt ultérieurement opéré dans l'un des autres Etats de l'Union avant l'expiration de ces délais ne pourra être invalidé par des faits accomplis dans l'intervalle, soit, notamment, par un autre dépôt, par la publication de l'invention ou son exploitation par un tiers, par la mise en vente d'exemplaires du dessin ou du modèle, par l'emploi de la marque.

Les délais de priorité mentionnés ci-dessus seront de six mois



pour les brevets d'invention et de trois mois pour les dessins ou modèles industriels, ainsi que pour les marques de fabrique ou de commerce. Ils seront augmentés d'un mois pour les pays d'outre-mer.

The provisions of this article are practically embodied in sect. 103 of the Act of 1883, as amended by sect. 6 of the Act of 1885. Under those sections the application over here must be made, in the case of designs, within four months of the first application for protection in a foreign State, and the copyright over here dates from the date of that foreign application. See pp. 49, 122, *ante*.

#### ARTICLE V.

The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

L'introduction par le breveté, dans le pays où le brevet a été délivré, d'objets fabriqués dans l'un ou l'autre des Etats de l'Union, n'entraînera pas la déchéance.

Toutefois le breveté restera soumis à l'obligation d'exploiter son brevet conformément aux lois du pays où il introduit les objets brevetés.

A foreigner registering a design in the United Kingdom under the provisions of the International Convention and sect. 103 would not be exempted from the requirements of sect. 54, sect. 50, sub-sect. (2), or sect. 51 (see p. 115, *ante*); and it should be remembered that the latter section applies also to articles sold abroad (see p. 57, *ante*).

#### ARTICLE VI.

Every trade mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

Toute marque de fabrique ou de commerce régulièrement déposée dans le pays d'origine sera admise au dépôt et protégée telle quelle dans les autres pays de l'Union.

Sera considéré comme pays d'origine le pays où le déposant a son principal établissement.

Si ce principal établissement n'est point situé dans un des pays de l'Union, sera considéré comme pays d'origine celui auquel appartient le déposant.

Le dépôt pourra être refusé, si l'objet pour lequel il est demandé est considéré comme contraire à la morale ou à l'ordre public.

## ARTICLE VII.

The nature of the goods on which the trade mark is to be used can, in no case, be an obstacle to the registration of the trade mark.

La nature du produit sur lequel la marque de fabrique ou de commerce doit être apposée ne peut, dans aucun cas, faire obstacle au dépôt de la marque.

## ARTICLE VIII.

A trade name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade mark.

Le nom commercial sera protégé dans tous les pays de l'Union sans obligation de dépôt, qu'il fasse ou non partie d'une marque de fabrique ou de commerce.

## ARTICLE IX.

All goods illegally bearing a trade mark or trade name may be seized on importation into those States of the Union where this mark or name has a right to legal protection.

The seizure shall be effected at the request of either the proper public department or of the interested party, pursuant to the internal legislation of each country.

Tout produit portant illicitement une marque de fabrique ou de commerce, ou un nom commercial, pourra être saisi à l'importation dans ceux des Etats de l'Union dans lesquels cette marque ou ce nom commercial ont droit à la protection légale.

La saisie aura lieu à la requête soit du Ministère Public, soit de la partie intéressée, conformément à la législation intérieure de chaque Etat.

## ARTICLE X.

The provisions of the preceding Article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade name of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

Les dispositions de l'Article précédent seront applicables à tout produit portant faussement, comme indication de provenance, le nom d'une localité déterminée, lorsque cette indication sera jointe à un nom commercial fictif ou emprunté dans une intention frauduleuse.

Est réputé partie intéressée tout fabricant ou commerçant engagé dans la fabrication ou le commerce de ce produit, et établi dans la localité faussement indiquée comme provenance.

## ARTICLE XI.

The High Contracting Parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade marks,

for articles exhibited at official or officially recognized International Exhibitions.

Les Hautes Parties Contractantes s'engagent à accorder une protection temporaire aux inventions brevetables, aux dessins ou modèles industriels, ainsi qu'aux marques de fabrique ou de commerce, pour les produits qui figureront aux Expositions Internationales officielles ou officiellement reconnues.

See sect. 57 of the Act of 1883 and sect. 3 of the Act of 1886.

#### ARTICLE XII.

Each of the High Contracting Parties agrees to establish a special Government Department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade marks.

Chacune des Hautes Parties Contractantes s'engage à établir un service spécial de la propriété industrielle et un dépôt central, pour la communication au public des brevets d'invention, des dessins ou modèles industriels et des marques de fabrique ou de commerce.

This is provided for in this country by the Patent Office.

#### ARTICLE XIII.

An international office shall be organised under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the Governments of all the Contracting States, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

Un office international sera organisé sous le titre de "Bureau International de l'Union pour la Protection de la Propriété Industrielle."

Ce bureau, dont les frais seront supportés par les Administrations de tous les Etats Contractants, sera placé sous la haute autorité de l'Administration Supérieure de la Confédération Suisse, et fonctionnera sous sa surveillance. Les attributions en seront déterminées d'un commun accord entre les Etats de l'Union.

This international office has been established at Berne, Switzerland. It supplies members of the Union with any special information they may need on questions relating to the international system of industrial property, and edits a periodical paper in French, called "La Propriété Industrielle," dealing with questions regarding the object of the Union. These and other provisions for the working of the Convention are contained in the Final Protocol.

#### ARTICLE XIV.

The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end Conferences shall be successively held in one of the Contracting States by Delegates of the said States.

The next meeting shall take place in 1885 at Rome.

La présente Convention sera soumise à des révisions périodiques en vue d'y introduire les améliorations de nature à perfectionner le système de l'Union.

A cet effet, des Conférences auront lieu successivement, dans l'un des Etats Contractants, entre les Délégués des dits Etats.

La prochaine réunion aura lieu en 1885 à Rome.

#### ARTICLE XV.

It is agreed that the High Contracting Parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of Industrial Property, in so far as such arrangements do not contravene the provisions of the present Convention.

Il est entendu que les Hautes Parties Contractantes se réservent respectivement le droit de prendre séparément, entre elles, des arrangements particuliers pour la protection de la Propriété Industrielle, en tant que ces arrangements ne contreviendraient point aux dispositions de la présente Convention.

#### ARTICLE XVI.

States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present Convention.

Les Etats qui n'ont point pris part à la présente Convention seront admis à y adhérer sur leur demande.

Cette adhésion sera notifiée par la voie diplomatique au Gouvernement de la Confédération Suisse, et par celui-ci à tous les autres. Elle importera, de plein droit, accession à toutes les clauses et admission à tous les avantages stipulés par la présente Convention.

Great Britain acceded to the Convention on March 17th, 1884, and there have been various other accessions. The countries which are now parties to it are marked with an asterisk in the list at pp. 194, 192, *post*.

#### ARTICLE XVII.

The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the High Contracting Parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

L'exécution des engagements réciproques contenus dans la présente Convention est subordonnée, en tant que de besoin, à

l'accomplissement des formalités et règles établies par les lois constitutionnelles de celles des Hautes Parties Contractantes qui sont tenues d'en provoquer l'application, ce qu'elles s'obligent à faire dans le plus bref délai possible.

When any foreign State or Colony adheres to the Convention it would seem that that adhesion has no effect as regards this country till an Order in Council has applied the provisions of sect. 103 to the adhering State or Colony.

#### ARTICLE XVIII.

The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other Contracting Parties.

La présente Convention sera mise à exécution dans le délai d'un mois à partir de l'échange des ratifications et demeurera en vigueur pendant un temps indéterminé, jusqu'à l'expiration d'une année à partir du jour où la dénonciation en sera faite. Cette dénonciation sera adressée au Gouvernement chargé de recevoir les adhésions. Elle ne produira son effet qu'à l'égard de l'Etat qui l'aura faite, la Convention restant exécutoire pour les autres Parties Contractantes.

Salvador withdrew from the Convention by notice dated August 17th, 1886, and Guatemala by notice dated November 8th, 1894. The application of sect. 103 to these countries was revoked by Orders in Council dated respectively September 24th, 1886 (*London Gazette*, 1886, p. 4726), and February 2nd, 1895 (*London Gazette*, 1895, p. 754).

#### ARTICLE XIX.

The present Convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

La présente Convention sera ratifiée, et les ratifications en seront échangées à Paris, dans le délai d'un an au plus tard.

The ratifications were exchanged at Paris on June 5th, 1884.

IN WITNESS whereof the respective Plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris the 20th March, 1883.

*[Here follow the signatures of the Plenipotentiaries.]*



## APPENDIX A.

1.—ORDERS IN COUNCIL *now (June 30th, 1899) in force applying the provisions of 46 & 47 Vict. c. 57, s. 103, to Foreign States.*

Foreign State.	Date of Order in Council.	Reference to London Gazette where O. in C. is published.
*Belgium .....	June 26, 1884.	July 1, 1884, p. 2993.
*Brazil .....	June 26, 1884.	July 1, 1884, p. 2993.
*Denmark (including the Faroe Islands) ..	Nov. 20, 1894.	Nov. 27, 1894, p. 6879.
*Dominican Republic .....	Oct. 21, 1890.	Oct. 28, 1890, p. 5661.
Ecuador [designs and trade marks only]	May 16, 1893.	May 19, 1893, p. 2899.
*France .....	June 26, 1884.	July 1, 1884, p. 2993.
Greece [designs and trade marks only] ..	Oct. 15, 1894.	Oct. 23, 1894, p. 5918.
*Italy .....	June 26, 1884.	July 1, 1884, p. 2993.
Mexico .....	May 28, 1889.	May 31, 1889, p. 2954.
*Netherlands .....	June 26, 1884.	July 1, 1884, p. 2993.
*Netherlands (East Indian Colonies) ....	Nov. 17, 1888.	Nov. 23, 1888, p. 6412.
*Netherlands (Curaçao and Surinam) ....	May 17, 1890.	May 20, 1890, p. 2891.
*Norway [see Sweden, below].	—	—
Paraguay .....	Sept. 24, 1886.	Sept. 28, 1886, p. 4725.
*Portugal .....	June 26, 1884.	July 1, 1884, p. 2993.
Roumania [designs and trade marks only]	Aug. 5, 1892.	Aug. 12, 1892, p. 4554.
*Servia .....	June 26, 1884.	July 1, 1884, p. 2993.
*Spain .....	June 26, 1884.	July 1, 1884, p. 2993.
*Sweden and Norway .....	July 9, 1885.	July 10, 1885, p. 3173.
*Switzerland .....	June 26, 1884.	July 1, 1884, p. 2993.
*Tunis .....	June 26, 1884.	July 1, 1884, p. 2993.
*United States .....	July 12, 1887.	July 15, 1887, p. 3827.
Uruguay .....	Sept. 24, 1886.	Sept. 28, 1886, p. 4725.

\* The countries marked with an asterisk are parties to the International Convention.

2.—ORDERS IN COUNCIL *now (June 30th, 1899) in force applying the provisions of 46 & 47 Viet. c. 57, s. 103, to British Possessions.*

Colony.	Date of Order in Council.	Reference to London Gazette where O. in C. is published.
*New Zealand.....	Feb. 8, 1890.	Feb. 11, 1890, p. 727.
*Queensland .....	Sept. 17, 1885.	Sept. 22, 1885, p. 4429.
Tasmania .....	April 30, 1894.	May 4, 1894, p. 2578.
Western Australia .....	May 11, 1895.	May 17, 1895, p. 2848.

\* The colonies marked with an asterisk are parties to the International Convention.

3.—ORDERS IN COUNCIL\* *imposing penalties on British subjects committing offences† in places under British jurisdiction against the Patents, Designs, and Trade Marks Acts, 1883—1888, or any Act, Statute, or Order in Council for the time being in force relating to Designs.*

Places under British Jurisdiction.	Date of Order in Council.	Reference to London Gazette where O. in C. is published.
Africa (certain parts of) .....	Oct. 15, 1889.	Oct. 22, 1889, p. 5557 (Art. 55).
Brunei .....	Nov. 22, 1890.	Nov. 28, 1890, p. 6671 (Art. 40).
Morocco .....	Nov. 28, 1889.	Dec. 13, 1889, p. 7163 (Art. 112).
Persia .....	Dec. 13, 1889.	Dec. 24, 1889, p. 7417 (Art. 292).
Persian Coast and Islands .....	Dec. 13, 1889.	Dec. 24, 1889, p. 7459 (Art. 50).
Somali Coast .....	Dec. 13, 1889.	Dec. 24, 1889, p. 7467 (Art. 4).

\* Issued under the provisions of the Foreign Jurisdiction Acts.

† See pp. 147, 148, *ante*.



## APPENDIX B.

INSTRUCTIONS TO PERSONS WHO WISH TO  
REGISTER DESIGNS (*a*).

## PRELIMINARY.

1. The Patents, Designs, and Trade Marks Acts, 1883 to 1888, and the Rules thereunder in relation to the Registration of Designs, should be carefully studied.

Copies of the Acts and Designs Rules can be purchased at the Patent Office, Sale Branch, 25, Southampton Buildings, London, W.C. Money sent by post should be remitted by Postal or Post Office Order.

Price of the Act of 1883, 1s. 7½*d.*; by post, 1s. 9*d.* Act of 1888, 1½*d.*; by post, 2*d.* Price of the Designs Rules, 1890, 6*d.*; by post, 6½*d.* Price of Lace Designs Rules, 1893, 1*d.*; by post, 1½*d.*

2. In order to obtain registration application must be made to the Comptroller in pursuance of Rules Nos. 6—11 of the Designs Rules, 1890.

Applications sent by post should be addressed—

The Comptroller,  
Patent Office,  
Designs Branch,  
25, Southampton Buildings,  
Chancery Lane,  
London, W.C.

3. A Design to be capable of registration must be *new or original*, and not previously published in the United Kingdom. *See* section 47 (1.) of the Act, 1883.

4. For the definition of a Design *see* section 60 of the Act of 1883.

NOTE.—As many inventors imagine that mechanical inventions can be protected by Registration as Designs, it may be stated that improvements in the construction, arrangement, or application of machinery can only be protected by a Patent.

## APPLICATIONS.

5. Stamped Forms of Application to register can be obtained at the following places:—

(*a*.) The Inland Revenue Office, Royal Courts of Justice, London.  
(Room No. 6.)

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(*a*) See also the chapter on "How to Register," pp. 117, *sup.*, *ante*. These instructions are issued by the Patent Office.

(b.) The following Post Offices in London :—

The General Post Office, E.C.

District Post Office, Lombard Street, E.C.

" 195, Whitechapel Road, E.

" 239, Borough High Street, S.E.

" Charing Cross, W.C.

" 28, Eversholt Street, Camden Town, N.W.

Post Office, 12, Parliament Street, S.W.

(c.) The chief Post Office of :—

ENGLAND AND WALES.				
Accrington.	Doncaster.	Nottingham.	Warrington.	
Altrincham.	Dorchester.	Nuneaton.	Wednesbury.	
Ashton-under-Lyne.	Driffield.	Oldbury.	West Bromwich.	
Barnsley.	Droitwich.	Oldham.	Whitby.	
Barrow-in-Furness.	Dudley.	Pattingham.	Widnes.	
Bath.	Durham.	Plymouth.	Wigan.	
Bedford.	Exeter.	Pontefract.	Wolverhampton.	
Beverley.	Gateshead.	Portsmouth.	Wolverton.	
Birkenhead.	Goole.	Prescot.	Woolwich.	
Birmingham.	Greenwich.	Preston.	York.	
Blackburn.	Guilford.	Reading.		
Bolton.	Halifax.	Redditch.		SCOTLAND.
Bradford.	Hartlepool.	Richmond (Yorks.).	Aberdeen.	
Brighton.	Huddersfield.	Ripon.	Dumbarton.	
Bristol.	Hull.	Rochdale.	Dundee.	
Bromsgrove.	Ipswich.	Rotherham.	Edinburgh.	
Burnley.	Keighley.	Rugby.	Glasgow.	
Burslem.	Kendal.	Salford.	Greenock.	
Burton-on-Trent.	Kildermminster.	St. Helen's.	Inverness.	
Bury.	Knaresboro'.	Scarborough.	Lanark.	
Cambridge.	Knatsford.	Sedgley.	Leith.	
Cardiff.	Lancaster.	Sheffield.	Paisley.	
Carlisle.	Leamington.	Southampton.	Perth.	
Chatham.	Leeds.	Stafford.	Renfrew.	
Chester.	Leicester.	Stalybridge.		
Clitheroe.	Lichfield.	Stockport.		IRELAND.
Congleton.	Lincoln.	Stoke-on-Trent.	Belfast.	
Coventry.	Liverpool.	Stourbridge.	Cork.	
Crewe.	Macclesfield.	Stourport.	Dublin.	
Croydon.	Manchester.	Sunderland.	Dundalk.	
Darlaston.	Middlesbrough.	Swansea.	Galway.	
Derby.	Nantwich.	Tamworth.	Limerick.	
Dewsbury.	Newcastle.	Truro.	Londonderry.	
	Newport (Mon.).	Tunstall.	Waterford.	
	Northallerton.	Wakefield.	Wexford.	
	Northampton.	Walsall.		

NOTE.—Forms are not supplied by the Patent Office, but can be purchased on personal application at the Inland Revenue Office, Royal Courts of Justice (Room No. 6), or at a few days' notice at any Money Order Office in the United Kingdom upon pre-payment of the value of the stamp.

If it should not be convenient to apply in person in either of the ways specified, the stamped forms can be ordered by applicants at home or abroad by post from the Controller of Stamps, Room 7, Inland Revenue Office, Somerset House, London, W.C. In that case a Banker's draft or a Money or Postal Order, payable to the Commissioners of Inland Revenue and crossed Bank of England, for the value of the stamp, and for the cost of postage and registration, to be forwarded with the application.

6. An application consists of the following:—

- (1.) The form of application, Form E, or Form O, properly filled up\* and signed by the applicant or his authorised Agent, and three exactly similar drawings, photographs, or specimens of the design.

In the case of a Lace Design the proper forms are Form E<sup>1</sup> (Single Design) and Form O<sup>1</sup> (Set).

- (a.) If it be desired to secure a date of registration at once, one sketch of the design (sufficiently definite to identify the same) may be sent with the application form. In this case the design, if accepted, will eventually be registered as of the date on which such sketch was received; but no certificate of registration can be issued until three exact drawings, photographs, or specimens have been sent in substitution for the sketch.

#### THE DRAWINGS OR PHOTOGRAPHS.

7. The drawings, &c., accompanying an application must be sent in triplicate, each representation of each design or set to be upon ordinary foolscap paper, and not on cardboard (on one side only), of the size of 13 in. by 8 in.

8. When sketches, drawings, or tracings are furnished, they should be in ink, or if in pencil they must be fixed. Drawings on tracing paper cannot be received, unless mounted on ordinary foolscap paper.

9. Rough sketches cannot be accepted.

10. When the design is to be applied to a set, each of the drawings accompanying the application, or the sketch, if a sketch is sent, should show all the various arrangements in which it is proposed to apply the design to the articles included in the set.

11. When specimens of the design are furnished in lieu of drawings or photographs, they must be of such a nature as can be pasted into books; the dimensions of each specimen must not exceed 12 in. by 21 in., and each must, when necessary, be mounted upon ordinary foolscap paper of the size above mentioned. Each representation of a design in Classes 13 and 14 should show the complete pattern and a portion of the repeat, and ought not to be of less size than 7 in. by 3 in.

12. Only two views of the same design can be accepted, unless in the case of a design for a set. Each view should be designated in writing (*i.e.*, front view, side view). Both views should be on one and the same half sheet of foolscap paper.

13. A request for search under Rule 35 of Designs Rules, 1890, must be accompanied by two representations of the design to be searched for.

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\* Applicants should be *specially careful* to give correctly their full name and address, with their trade, business, or occupation; also to fill in, after the words "Statement of nature of Design," the words "for the Pattern," "for the Shape or Configuration," or "for the Ornament," or for any two or more such purposes, as the case may be, adding, when necessary, a short technical description of the article with the part or parts claimed as new or original specially defined.

14. Before delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall, if such article is included in Class 13 or Class 14, cause each such article to be marked with the abbreviation "Regd.," and shall, if such article is included in any of the Classes 1 to 12, cause each such article to be marked with the abbreviation "Rd.," and also, in the case of articles other than lace, with the number appearing on the certificate of registration.

15. The attention of applicants is called to the fact that by section 58 of the Act of 1883, the protection afforded to a registered design is restricted to the particular class or classes of goods in which the design is registered.

By section 47 (sub-section 4) of the Act of 1883, the same design may be registered in more than one class. In such case a separate application, together with three representations, is necessary for each class.

#### 16. LIST OF CLASSES.

1. Articles composed wholly or chiefly of metal, not included in Class 2.
2. Jewellery.
3. Articles composed wholly or chiefly of wood, bone, ivory, papier maché, or other solid substances not included in other classes.
4. Articles composed wholly or chiefly of glass, earthenware or porcelain, bricks, tiles, or cement.
5. Articles composed wholly or chiefly of paper (except hangings).
6. Articles composed wholly or chiefly of leather, including book-binding, of all materials.
7. Paper hangings.
8. Carpets and rugs in all materials, floorcloths, and oilcloths.
9. Lace, hosiery.
10. Millinery and wearing apparel, including boots and shoes.
11. Ornamental needlework on muslin or other textile fabrics.
12. Goods not included in other classes.
13. Printed or woven designs on textile piece goods.
14. " " handkerchiefs and shawls.

17. The following is a list of the stamped forms to be had at the places mentioned in paragraph 5:—

#### DESIGNS.

Letter.	Title of Form.	Fee.		
		£	s.	d.
E	Application for Registration of Single Design in any one of the Classes 1 to 12, not being a Lace Design . . . . .	0	10	0
E	Application for Registration of Single Design in Class 13 or 14 . . . . .	0	1	0
E	Application for Registration of Single <i>Lace</i> Design in Class 9 . . . . .	0	1	0
F	Appeal to Board of Trade on Refusal of Comptroller to Register a Design . . . . .	1	0	0
H	Application for Copy of Certificate of Registration of Design . . . . .	0	1	0

Letter.	Title of Form.	Fee.
		£ s. d.
I	Request for Certificate for use in Legal Proceedings .....	0 5 0
K	Request to enter Name of subsequent Proprietor of Design, with Declaration in support thereof .....	Same as Regis- tration Fee.
K <sup>1</sup>	Request to enter Name of subsequent Proprietor of a <i>Lace</i> Design or set of <i>Lace</i> Designs .....	
L	Notice of intended Exhibition of an Unregistered Design ..	0 5 0
M	Request for Correction of Clerical Error or for Entry of New Address .....	0 5 0
N	Request for Search under Section 53 of Act of 1883, or Rule 35 of Designs Rules, 1890 .....	0 5 0
O	Application for Registration of Design for "Set" of articles, not being <i>Lace</i> .....	1 0 0
O <sup>1</sup>	Application for Registration of Design to be applied to a "Set" of <i>Lace</i> articles .....	0 2 0

N.B.—Forms E and O are kept on sale at the places named in paragraph 5. The other Forms must be bespoken of the Postmasters at those places.

Forms E<sup>1</sup> and O<sup>1</sup> are specially kept on sale at the Chief Post Office at Nottingham.

The Patent Office, Designs Branch, is open from 10 a.m. to 4 p.m.

C. N. DALTON,  
Comptroller-General.

The Patent Office, Designs Branch,  
London.

## APPENDIX C.

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### STATUTES, 1842—1875.

[*These Statutes are all now repealed by the Act of 1883.*]

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#### DESIGNS ACT, 1842.

5 & 6 VICT. c. 100.

*An Act to consolidate and amend the Laws relating to the Copyright of Designs for ornamenting Articles of Manufacture.*

[10th August, 1842.]

WHEREAS by the several Acts mentioned in the Schedule (A.) to this Act annexed, there was granted, in respect of the woven fabrics therein mentioned, the sole right to use any new and original pattern for printing the same during the period of three calendar months : and whereas by the Act mentioned in the Schedule (B.) to this Act annexed, there was granted in respect of all articles, except lace, and except the articles within the meaning of the Acts hereinbefore referred to, the sole right of using any new and original design, for certain purposes, during the respective periods therein mentioned ; but forasmuch as the protection afforded by the said Acts in respect of the application of designs to certain articles of manufacture is insufficient, it is expedient to extend the same, but upon the conditions hereinafter expressed : now, for that purpose, and for the purpose of consolidating the provisions of the said Acts, be it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, that this Act shall come into operation on the first day of September, one thousand eight hundred and forty-two, and that thereupon all the said Acts mentioned in the said Schedules (A. and (B.) to this Act annexed shall be and they are hereby repealed.

2. Provided always, and be it enacted, that, notwithstanding such repeal of the said Acts, every copyright in force under the same shall continue in force till the expiration of such copyright ; and with regard to all offences or injuries committed against any such copyright before this Act shall come into operation, every penalty imposed and every remedy given by the said Acts in relation to any such offence or injury,

shall be applicable as if such Acts had not been repealed : but with regard to such offences or injuries committed against any such copyright after this Act shall come into operation, every penalty imposed and every remedy given by this Act in relation to any such offence or injury shall be applicable as if such copyright had been conferred by this Act.

3. And with regard to any new and original design (except for sculpture and other things within the provisions of the several Acts mentioned in the Schedule (C.) to this Act annexed), whether such design be applicable to the ornamenting of any article of manufacture, or of any substance, artificial or natural, or partly artificial and partly natural, and that whether such design be so applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means such design may be so applicable, whether by printing, or by painting, or by embroidery, or by weaving, or by sewing, or by modelling, or by casting, or by embossing, or by engraving, or by staining, or by any other means whatsoever, manual, mechanical or chemical, separate or combined ; be it enacted, that the proprietor of every such design, not previously published either within the United Kingdom of Great Britain and Ireland, or elsewhere, shall have the sole right to apply the same to any articles of manufacture, or to any such substances as aforesaid, provided the same be done within the United Kingdom of Great Britain and Ireland, for the respective terms hereinafter mentioned, such respective terms to be computed from the time of such design being registered according to this Act ; (that is to say,)

In respect of the application of any such design to ornamenting any article of manufacture contained in the first, second, third, fourth, fifth, sixth, eighth or eleventh of the classes following, for the term of three years :

In respect of the application of any such design to ornamenting any article of manufacture contained in the seventh, ninth or tenth of the classes following, for the term of nine calendar months :

In respect of the application of any such design to ornamenting any article of manufacture or substance contained in the twelfth or thirteenth of the classes following, for the term of twelve calendar months :

Class 1.—Articles of manufacture composed wholly or chiefly of any metal or fixed metals :

Class 2.—Articles of manufacture composed wholly or chiefly of wood :

Class 3.—Articles of manufacture composed wholly or chiefly of glass :

Class 4.—Articles of manufacture composed wholly or chiefly of earthenware :

Class 5.—Paper hangings :

Class 6.—Carpets :

Class 7.—Shawls, if the design be applied solely by printing, or by any other process by which colours are or may hereafter be produced upon tissue or textile fabrics :

Class 8.—Shawls not comprised in Class 7 :

Class 9.—Yarn, thread or warp, if the design be applied by

printing, or by any other process by which colours are or may hereafter be produced :

Class 10.—Woven fabrics, composed of linen, cotton, wool, silk or hair, or of any two or more of such materials, if the design be applied by printing, or by any other process by which colours are or may hereafter be produced upon tissue or textile fabrics; excepting the articles included in Class 11 :

Class 11.—Woven fabrics, composed of linen, cotton, wool, silk or hair, or of any two or more of such materials, if the design be applied by printing, or by any other process by which colours are or may hereafter be produced upon tissue or textile fabrics, such woven fabrics being or coming within the description technically called furnitures, and the repeat of the design whereof shall be more than twelve inches by eight inches :

Class 12.—Woven fabrics, not comprised in any preceding class :

Class 13.—Lace, and any article of manufacture or substance not comprised in any preceding class :

4. Provided always, and be it enacted, that no person shall be entitled to the benefit of this Act, with regard to any design in respect of the application thereof to ornamenting any article of manufacture, or any such substance, unless such design have before publication thereof been registered according to this Act, and unless at the time of such registration such design have been registered in respect of the application thereof to some or one of the articles of manufacture or substances comprised in the above-mentioned classes, by specifying the number of the class in respect of which such registration is made, and unless the name of such person shall be registered according to this Act as a proprietor of such design, and unless after publication of such design every such article of manufacture, or such substance to which the same shall be so applied, published by him, hath thereon, if the article of manufacture be a woven fabric for printing, at one end thereof, or, if of any other kind or such substance as aforesaid, at the end or edge thereof, or other convenient place thereon, the letters " Rd," together with such number or letter, or number and letter, and in such form as shall correspond with the date of the registration of such design according to the registry of designs in that behalf; and such marks may be put on any such article of manufacture or such substance, either by making the same in or on the material itself of which such article or such substance shall consist, or by attaching thereto a label containing such marks.

5. And be it enacted, that the author of any such new and original design shall be considered the proprietor thereof, unless he have executed the work on behalf of another person for a good or a valuable consideration, in which case such person shall be considered the proprietor, and shall be entitled to be registered in the place of the author; and every person acquiring for a good or a valuable consideration a new and original design, or the right to apply the same to ornamenting any one or more articles of manufacture, or any one or more such substances as aforesaid, either exclusively of any other person or otherwise, and also every person upon whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise.



6. And be it enacted, that every person purchasing or otherwise acquiring the right to the entire or partial use of any such design may enter his title in the register hereby provided, and any writing purporting to be a transfer of such design and signed by the proprietor thereof shall operate as an effectual transfer; and the registrar shall, on request, and the production of such writing, or in the case of acquiring such right by any other mode than that of purchase on the production of any evidence to the satisfaction of the registrar, insert the name of the new proprietor in the register; and the following may be the form of such transfer, and of such request to the registrar:

*Form of Transfer, and Authority to register.*

"I, A. B., author [*or proprietor*] of design, No. ———, having transferred my right thereto, [*or, if such transfer be partial,*] so far as regards the ornamenting of ——— [*describe the articles of manufacture or substances, or the locality with respect to which the right is transferred,*] to B. C. of ———, do hereby authorize you to insert his name on the register of designs accordingly."

*Form of Request to register.*

"I, B. C., the person mentioned in the above transfer, do request you to register my name and property in the said design as entitled [*if to the entire use*] to the entire use of such design, [*or, if to the partial use,*] to the partial use of such design, so far as regards the application thereof [*describe the articles of manufacture, or the locality in relation to which the right is transferred*]."

But if such request to register be made by any person to whom any such design shall devolve otherwise than by transfer, such request may be in the following form:

"I, C. D., in whom is vested by [*state bankruptcy or otherwise*] the design, No. ———, [*or, if such devolution be of a partial right,* so far as regards the application thereof] to [*describe the articles of manufacture or substance, or the locality in relation to which the right has devolved*]."

7. And for preventing the piracy of registered designs, be it enacted, that during the existence of any such right to the entire or partial use of any such design no person shall either do or cause to be done any of the following acts with regard to any articles of manufacture or substances, in respect of which the copyright of such design shall be in force, without the licence or consent in writing of the registered proprietor thereof; (that is to say,)

No person shall apply any such design, or any fraudulent imitation thereof for the purpose of sale, to the ornamenting of any article of manufacture, or any substance, artificial or natural, or partly artificial and partly natural:

No person shall publish, sell or expose for sale any article of manufacture, or any substance, to which such design, or any fraudulent imitation thereof, shall have been so applied, after having received, either verbally or in writing, or otherwise from any source other than the proprietor of such design, knowledge that his consent has not been given to such application, or after having been served with or had left at his premises a written notice signed by such proprietor or his agent to the same effect.

8. And be it enacted, that if any person commit any such act he shall for every offence forfeit a sum not less than five pounds and not exceeding thirty pounds to the proprietor of the design in respect of whose right such offence has been committed; and such proprietor may recover such penalty as follows:

In England, either by an action of debt or on the case against the party offending, or by summary proceeding before two justices having jurisdiction where the party offending resides; and if such proprietor proceed by such summary proceeding, any justice of the peace acting for the county, riding, division, city or borough where the party offending resides, and not being concerned either in the sale or manufacture of the article of manufacture, or in the design to which such summary proceeding relates, may issue a summons requiring such party to appear on a day and at a time and place to be named in such summons, such time not being less than eight days from the date thereof; and every such summons shall be served on the party offending either in person or at his usual place of abode; and either upon the appearance or upon the default to appear of the party offending, any two or more of such justices may proceed to the hearing of the complaint, and upon proof of the offence, either by the confession of the party offending, or upon the oath or affirmation of one or more credible witnesses, which such justices are hereby authorised to administer, may convict the offender in a penalty of not less than five pounds or more than thirty pounds, as aforesaid, for each offence, as to such justices doth seem fit; but the aggregate amount of penalties for offences in respect of any one design committed by any one person, up to the time at which any of the proceedings herein mentioned shall be instituted, shall not exceed the sum of one hundred pounds; and if the amount of such penalty or of such penalties, and the costs attending the conviction, so assessed by such justices, be not forthwith paid, the amount of the penalty or of the penalties, and of the costs, together with the costs of the distress and sale, shall be levied by distress and sale of the goods and chattels of the offender, wherever the same happen to be in England; and the justices before whom the party has been convicted, or, on proof of the conviction, any two justices acting for any county, riding, division, city or borough in England, where goods and chattels of the person offending happen to be, may grant a warrant for such distress and sale; and the overplus, if any, shall be returned to the owner of the goods and chattels, on demand; and every information and conviction which shall be respectively laid or made in such summary proceeding before two justices under this Act may be drawn or made out in the following forms respectively, or to the effect thereof, *mutatis mutandis*, as the case may require:

*Form of Information.*

"Be it remembered, that on the ———, at ———, in the county of ———, A. B. of ———, in the county of ———, [or C. D. of ———, in the county of ———, at the instance and on the behalf of A. B. of ———, in the county of ———,] cometh before us ——— and ———, two of her Majesty's justices of the peace in and for the county of ———, and giveth us to

understand that the said A. B., before and at the time when the offence hereinafter mentioned was committed, was the proprietor of a new and original design for [*here describe the design,*] and that within twelve calendar months last past, to wit, on the ———, at ———, in the county of ———, E. F. of ———, in the county of ———, did [*here describe the offence*], contrary to the form of the Act passed in the ——— year of the reign of her present Majesty, intituled ‘An Act to consolidate and amend the Laws relating to the Copyright of Designs for ornamenting Articles of Manufacture.’”

*Form of Conviction.*

“Be it remembered, that on the ——— day of ———, in the year of our Lord ———, at ———, in the county of ———, E. F. of ———, in the county aforesaid, is convicted before us ——— and ———, two of her Majesty’s justices of the peace for the said county, for that he the said E. F., on the ——— day of ———, in the year ———, at ———, in the county of ———, did [*here describe the offence*] contrary to the form of the statute in that case made and provided; and we the said justices do adjudge that the said E. F. for his offence aforesaid hath forfeited the sum of ——— to the said A. B.”

In Scotland, by action before the Court of Session in ordinary form, or by summary action before the sheriff of the county where the offence may be committed or the offender resides, who, upon proof of the offence or offences, either by confession of the party offending or by the oath or affirmation of one or more credible witnesses, shall convict the offender and find him liable in the penalty or penalties aforesaid, as also in expenses; and it shall be lawful for the sheriff, in pronouncing such judgment for the penalty or penalties and costs, to insert in such judgment a warrant, in the event of such penalty or penalties and costs not being paid, to levy and recover the amount of the same by poinding: Provided always, that it shall be lawful to the sheriff, in the event of his dismissing the action and assailing the defender, to find the complainer liable in expenses; and any judgment so to be pronounced by the sheriff in such summary application shall be final and conclusive, and not subject to review by advocacy, suspension, reduction or otherwise:

In Ireland, either by action in a superior court of law at Dublin or by civil bill in the Civil Bill Court of the county or place where the offence was committed.

9. Provided always, and be it enacted, that, notwithstanding the remedies hereby given for the recovery of any such penalty as aforesaid, it shall be lawful for the proprietor in respect of whose right such penalty shall have been incurred (if he shall elect to do so) to bring such action as he may be entitled to for the recovery of any damages which he shall have sustained, either by the application of any such design or of a fraudulent imitation thereof, for the purpose of sale, to any articles of manufacture or substances, or by the publication, sale or exposure to sale, as aforesaid, by any person, of any article or substance to which such design or any fraudulent imitation thereof shall have been so applied, such person knowing

that the proprietor of such design had not given his consent to such application.

10. And be it enacted, that in any suit in equity which may be instituted by the proprietor of any design or the person lawfully entitled thereto, relative to such design, if it shall appear to the satisfaction of the judge having cognizance of such suit that the design has been registered in the name of a person not being the proprietor or lawfully entitled thereto, it shall be competent for such judge, in his discretion, by a decree or order in such suit to direct either that such registration be cancelled (in which case the same shall thenceforth be wholly void), or that the name of the proprietor of such design, or other person lawfully entitled thereto, be substituted in the register for the name of such wrongful proprietor or claimant, in like manner as is hereinbefore directed in case of the transfer of a design, and to make such order respecting the costs of such cancellation or substitution, and of all proceedings to procure and effect the same, as he shall think fit; and the registrar is hereby authorized and required, upon being served with an official copy of such decree, or order, and upon payment of the proper fee, to comply with the tenor of such decree or order, and either cancel such registration or substitute such new name, as the case may be.

11. And be it enacted, that unless a design applied to ornamenting any article of manufacture or any such substance as aforesaid be so registered as aforesaid, and unless such design so registered shall have been applied to the ornamenting such article or substance within the United Kingdom of Great Britain and Ireland, and also after the copyright of such design in relation to such article or substance shall have expired, it shall be unlawful to put on any such article or such substance, in the manner hereinbefore required with respect to articles or substances whereto shall be applied a registered design, the marks hereinbefore required to be so applied, or any marks corresponding therewith or similar thereto; and if any person shall so unlawfully apply any such marks, or shall publish, sell or expose for sale any article of manufacture, or any substance, with any such marks so unlawfully applied, knowing that any such marks have been unlawfully applied, he shall forfeit for every such offence a sum not exceeding five pounds, which may be recovered by any person proceeding for the same by any of the ways hereinbefore directed with respect to penalties for pirating any such design.

12. And be it enacted, that no action or other proceeding for any offence or injury under this Act shall be brought after the expiration of twelve calendar months from the commission of the offence; and in every such action or other proceeding the party who shall prevail shall recover his full costs of suit or of such other proceeding.

13. And be it enacted, that in the case of any summary proceeding before any two justices in England such justices are hereby authorized to award payment of costs to the party prevailing, and to grant a warrant for enforcing payment thereof against the summoning party, if unsuccessful, in the like manner as is hereinbefore provided for recovering any penalty with costs against any offender under this Act.

14. And for the purpose of registering designs for articles of manufacture, in order to obtain the protection of this Act, be it enacted,

that the Lords of the Committee of Privy Council for the consideration of all matters of trade and plantations may appoint a person to be a registrar of designs for ornamenting articles of manufacture, and, if the Lords of the said Committee see fit, a deputy registrar, clerks and other necessary officers and servants; and such registrar, deputy registrar, clerks, officers and servants shall hold their offices during the pleasure of the Lords of the said Committee; and the Commissioners of the Treasury may from time to time fix the salary or remuneration of such registrar, deputy registrar, clerks, officers and servants; and, subject to the provisions of this Act, the Lords of the said Committee may make rules for regulating the execution of the duties of the office of the said registrar; and such registrar shall have a seal of office.

15. And be it enacted, that the said registrar shall not register any design in respect of any application thereof to ornamenting any articles of manufacture or substances, unless he be furnished, in respect of each such application, with two copies, drawings or prints of such design, accompanied with the name of every person who shall claim to be proprietor, or of the style or title of the firm under which such proprietor may be trading, with his place of abode or place of carrying on his business, or other place of address, and the number of the class in respect of which such registration is made; and the registrar shall register all such copies, drawings, or prints, from time to time successively, as they are received by him for that purpose; and on every such copy, drawing or print he shall affix a number corresponding to such succession; and he shall retain one copy, drawing or print, which he shall file in his office, and the other he shall return to the person by whom the same has been forwarded to him; and, in order to give ready access to the copies of designs so registered, he shall class such copies of designs, and keep a proper index of each class.

16. And be it enacted, that upon every copy, drawing or print of an original design so returned to the person registering as aforesaid, or attached thereto, and upon every copy, drawing or print thereof received for the purpose of such registration, or of the transfer of such design being certified thereon or attached thereto, the registrar shall certify under his hand that the design has been so registered, the date of such registration, and the name of the registered proprietor or the style or title of the firm under which such proprietor may be trading, with his place of abode or place of carrying on his business, or other place of address, and also the number of such design, together with such number or letter, or number and letter, and in such form as shall be employed by him to denote or correspond with the date of such registration; and such certificate made on every such original design, or on such copy thereof, and purporting to be signed by the registrar or deputy registrar, and purporting to have the seal of office of such registrar affixed thereto, shall, in the absence of evidence to the contrary, be sufficient proof, as follows:

Of the design, and of the name of the proprietor therein mentioned, having been duly registered; and

Of the commencement of the period of registry; and

Of the person named therein as proprietor being the proprietor; and

Of the originality of the design; and

Of the provisions of this Act, and of any rule under which the certificate appears to be made, having been complied with:

and any such writing purporting to be such certificate shall, in the absence of evidence to the contrary, be received as evidence, without proof of the handwriting of the signature thereto, or of the seal of office affixed thereto, or of the person signing the name being the registrar or the deputy registrar.

17. And be it enacted, that every person shall be at liberty to inspect any design whereof the copyright shall have expired, paying only such fee as shall be appointed by virtue of this Act in that behalf; but with regard to designs whereof the copyright shall not have expired, no such design shall be open to inspection, except by a proprietor of such design or by any person authorized by him in writing, or by any person specially authorized by the registrar, and then only in the presence of such registrar or in the presence of some person holding an appointment under this Act, and not so as to take a copy of any such design or of any part thereof, nor without paying for every such inspection such fee as aforesaid: provided always, that it shall be lawful for the said registrar to give to any person applying to him, and producing a particular design, together with the registration mark thereof, or producing such registration mark only, a certificate stating whether of such design there be any copyright existing, and if there be, in respect to what particular article of manufacture or substance such copyright exists, and the term of such copyright, and the date of registration, and also the name and address of the registered proprietor thereof.

18. And be it enacted, that the Commissioners of the Treasury shall from time to time fix fees to be paid for the services to be performed by the registrar, as they shall deem requisite, to defray the expenses of the said office, and the salaries or other remuneration of the said registrar, and of any other person employed under him, with the sanction of the Commissioners of the Treasury, in the execution of this Act; and the balance, if any, shall be carried to the Consolidated Fund of the United Kingdom, and be paid accordingly into the receipt of Her Majesty's Exchequer at Westminster; and the Commissioners of the Treasury may regulate the manner in which such fees are to be received, and in which they are to be kept, and in which they are to be accounted for, and they may also remit or dispense with the payment of such fees in any cases where they may think it expedient so to do: provided always, that the fee for registering a design to be applied to any woven fabric, mentioned or comprised in Classes 7, 9, or 10, shall not exceed the sum of one shilling; that the fee for registering a design to be applied to a paper hanging shall not exceed the sum of ten shillings; and that the fee to be received by the registrar for giving a certificate relative to the existence or expiration of any copyright in any design printed on any woven fabric, yarn, thread, or warp, or printed, embossed, or worked on any paper hanging, to any person exhibiting a piece end of a registered pattern, with the registration mark thereon, shall not exceed the sum of two shillings and sixpence.

19. And be it enacted, that if either the registrar or any person employed under him either demand or receive any gratuity or reward, whether in money or otherwise, except the salary or remuneration authorized by the Commissioners of the Treasury, he shall forfeit for every such offence fifty pounds to any person suing for the same by

action of debt in the Court of Exchequer at Westminster; and he shall also be liable to be either suspended or dismissed from his office, and rendered incapable of holding any situation in the said office, as the Commissioners of the Treasury see fit.

20. And for the interpretation of this Act, be it enacted, that the following terms and expressions, as far as they are not repugnant to the context of this Act, shall be construed as follows: (that is to say,) the expression "Commissioners of the Treasury" shall mean the Lord High Treasurer for the time being, or the Commissioners of Her Majesty's Treasury for the time being, or any three or more of them; and the singular number shall include the plural as well as the singular number; and the masculine gender shall include the feminine gender as well as the masculine gender.

21. And be it enacted, that this Act may be amended or repealed by any Act to be passed in the present session of Parliament.

### SCHEDULES referred to by the foregoing Act.

#### SCHEDULE (A).

Date of Acts.	Title.
27 Geo. III. c. 38. (1787.)	An Act for the Encouragement of the Arts of designing and printing Linens, Cottons, Calicoes, and Muslins, by vesting the Properties thereof in the Designers, Printers, and Proprietors for a limited Time.
29 Geo. III. c. 19. (1789.)	An Act for continuing an Act for the Encouragement of the Arts of designing and printing Linens, Cottons, Calicoes, and Muslins, by vesting the Properties thereof in the Designers, Printers, and Proprietors for a limited Time.
34 Geo. III. c. 23. (1794.)	An Act for amending and making perpetual an Act for the Encouragement of the Arts of designing and printing Linens, Cottons, Calicoes, and Muslins, by vesting the Properties thereof in the Designers, Printers, and Proprietors for a limited Time.
2 Vict. c. 13. (1839.)	An Act for extending the Copyright of Designs for Calico Printing to Designs for printing other woven Fabrics.

#### SCHEDULE (B).

Date of Act.	Title.
2 Vict. c. 17. (1839.)	An Act to secure to Proprietors of Designs for Articles of Manufacture the Copyright of such Designs for a limited Time.

## SCHEDULE (C').

Date of Acts.	Title.
38 Geo. III. c. 71. (1798)	An Act for encouraging the Art of making new Models and Casts of Busts and other Things therein mentioned.
54 Geo. III. c. 56. (1811.)	An Act to amend and render more effectual an Act for encouraging the Art of making new Models and Casts of Busts and other Things therein mentioned, and for giving further Encouragement to such Arts.

## DESIGNS ACT, 1843.

6 &amp; 7 VICT. c. 65.

*An Act to amend the Laws relating to the Copyright of Designs.*  
[22nd August, 1843.]

WHEREAS by an Act passed in the fifth and sixth years of the reign of Her present Majesty, intituled "An Act to consolidate and amend the Laws relating to the Copyright of Designs for ornamenting Articles of Manufacture," there was granted to the proprietor of any new and original design, with the exceptions therein mentioned, the sole right to apply the same to the ornamenting of any article of manufacture or any such substance as therein described during the respective periods therein mentioned: and whereas it is expedient to extend the protection afforded by the said Act to such designs hereinafter mentioned, not being of an ornamental character, as are not included therein: be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, That this Act shall come into operation on the first day of September, one thousand eight hundred and forty-three.

2. And with regard to any new or original design for any article of manufacture having reference to some purpose of utility, so far as such design shall be for the shape or configuration of such article, and that whether it be for the whole of such shape or configuration, or only for a part thereof, be it enacted, that the proprietor of such design not previously published within the United Kingdom of Great Britain and Ireland, or elsewhere, shall have the sole right to apply such design to any article, or make or sell any article according to such design, for the term of three years, to be computed from the time of such design being registered according to this Act: provided always, that this enactment shall not extend to such designs as are within the provisions of the said Act, or of two other Acts passed respectively in the thirty-eighth and fifty-fourth years of the reign of his late majesty King George the Third, and intituled respectively "An Act for encouraging the Art of making new Models and Casts of Busts, and other Things therein



mentioned;" and "An Act to amend and render more effectual an Act for encouraging the Art of making new Models and Casts of Busts, and other Things therein mentioned."

3. Provided always, and be it enacted, that no person shall be entitled to the benefit of this Act unless such design have, before publication thereof, been registered according to this Act, and unless the name of such person shall be registered according to this Act as a proprietor of such design, and unless after publication of such design every article of manufacture made by him according to such design, or on which such design is used, hath thereon the word "registered," with the date of registration.

4. And be it enacted, that unless a design applied to any article of manufacture be registered, either as aforesaid or according to the provisions of the said first-mentioned Act, and also after the copyright of such design shall have expired, it shall be unlawful to put on any such article the word "registered," or to advertise the same for sale as a registered article; and if any person shall so unlawfully publish, sell or expose or advertise for sale any such article of manufacture, he shall forfeit for every such offence a sum not exceeding five pounds nor less than one pound, which may be recovered by any person proceeding for the same by any of the remedies hereby given for the recovery of penalties for pirating any such design.

5. And be it enacted, that all such articles of manufacture as are commonly known by the name of floor cloths or oil cloths shall henceforth be considered as included in class six in the said first-mentioned Act in that behalf mentioned, and be registered accordingly.

6. And be it enacted, that all and every the clauses and provisions contained in the said first-mentioned Act, so far as they are not repugnant to the provisions contained in this Act, relating respectively to the explanation of the term proprietor, to the transfer of designs, to the piracy of designs, to the mode of recovering penalties, to actions for damages, to cancelling and amending registrations, to the limitation of actions, to the awarding of costs, to the certificate of registration, to the fixing and application of fees of registration, and to the penalty for extortion, shall be applied and extended to this present Act as fully and effectually, and to all intents and purposes, as if the said several clauses and provisos had been particularly repeated and re-enacted in the body of this Act.

7. And be it enacted, that so much of the said first-mentioned Act as relates to the appointment of a registrar of designs for ornamenting articles of manufacture, and other officers, as well as to the fixing of the salaries for the payment of the same, shall be and the same is hereby repealed; and for the purpose of carrying into effect the provisions as well of this Act as of the said first-mentioned Act, the Lords of the Committee of the Privy Council for the consideration of all matters of trade and plantations may appoint a person to be registrar of designs for articles of manufacture, and, if the Lords of the said Committee see fit, an assistant registrar and other necessary officers and servants; and such registrar, assistant registrar, officers and servants shall hold their offices during the pleasure of the Lords of the said Committee; and such registrar shall have a seal of office; and the Commissioners of Her Majesty's Treasury may from time to

time fix the salary or other remuneration of such registrar, assistant registrar and other officers and servants; and all the provisions contained in the said first-mentioned Act, and not hereby repealed, relating to the registrar, deputy registrar, clerks and other officers and servants thereby appointed and therein named, shall be construed and held to apply respectively to the registrar, assistant registrar and other officers and servants to be appointed under this Act.

8. And be it enacted, that the said registrar shall not register any design for the shape or configuration of any article of manufacture as aforesaid, unless he be furnished with two exactly similar drawings or prints of such design, with such description in writing as may be necessary to render the same intelligible according to the judgment of the said registrar, together with the title of the said design, and the name of every person who shall claim to be proprietor, or of the style or title of the firm under which such proprietor may be trading, with his place of abode, or place of carrying on business, or other place of address; and every such drawing or print, together with the title and description of such design, and the name and address of the proprietor aforesaid, shall be on one sheet of paper or parchment, and on the same side thereof; and the size of the said sheet shall not exceed twenty-four inches by fifteen inches; and there shall be left on one of the said sheets a blank space on the same side on which are the said drawings, title, description, name and address, of the size of six inches by four inches, for the certificate herein mentioned; and the said drawings or prints shall be made on a proper geometric scale; and the said description shall set forth such part or parts of the said design (if any) as shall not be new or original; and the said registrar shall register all such drawings or prints from time to time as they are received by him for that purpose; and on every such drawing or print he shall affix a number corresponding to the order of succession in the register, and he shall retain one drawing or print, which he shall file at his office, and the other he shall return to the person by whom the same has been forwarded to him; and, in order to give a ready access to the designs so registered, he shall keep a proper index of the titles thereof.

9. And be it enacted, that if any design be brought to the said registrar to be registered under the said first-mentioned Act, and it shall appear to him that the same ought to be registered under this present Act, it shall be lawful for the said registrar to refuse to register such design otherwise than under the present Act and in the manner hereby provided; and if it shall appear to the said registrar that the design brought to be registered under the said first-mentioned Act or this Act is not intended to be applied to any article of manufacture, but only to some label, wrapper or other covering, in which such article might be exposed for sale, or that such design is contrary to public morality or order, it shall be lawful for the said registrar, in his discretion, wholly to refuse to register such design: provided always, that the Lords of the said Committee of Privy Council may, on representation made to them by the proprietor of any design so wholly refused to be registered as aforesaid, if they shall see fit, direct the said registrar to register such design; whereupon and in such case the said registrar shall be and is hereby required to register the same accordingly.

10. And be it enacted, that every person shall be at liberty to inspect the index of the titles of the designs, not being ornamental designs, registered under this Act, and to take copies from the same, paying only such fees as shall be appointed by virtue of this Act in that behalf; and every person shall be at liberty to inspect any such design, and to take copies thereof, paying such fee as aforesaid; but no design, whereof the copyright shall not have expired, shall be open to inspection, except in the presence of such registrar, or in the presence of some person holding an appointment under this Act, and not so as to take a copy of such design, nor without paying such fee as aforesaid.

11. And, for the interpretation of this Act, be it enacted, that the following terms and expressions, so far as they are not repugnant to the context of this Act, shall be construed as follows: (that is to say,) the expression "Commissioners of the Treasury" shall mean the Lord High Treasurer for the time being, or the Commissioners of Her Majesty's Treasury of the United Kingdom of Great Britain and Ireland for the time being, or any three or more of them; and the singular number shall include the plural as well as the singular number, and the masculine gender shall include the feminine gender as well as the masculine gender.

12. And be it enacted, that this Act may be amended or repealed by any Act to be passed in the present session of Parliament.

## DESIGNS ACT, 1850.

13 & 14 VICT. c. 104.

*An Act to extend and amend the Acts relating to the Copyright of Designs.* [14th August, 1850.]

WHEREAS it is expedient to extend and amend the Acts relating to the Copyright of Designs: Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same:

1. That the registrar of designs, upon application by or on behalf of the proprietor of any design not previously published within the United Kingdom of Great Britain and Ireland, or elsewhere, and which may be registered under the Designs Act, 1842, or under the Designs Act, 1843, for the provisional registration of such design under this Act, and upon being furnished with such copy, drawing, print, or description in writing or in print as in the judgment of the said registrar shall be sufficient to identify the particular design in respect of which such registration is desired, and the name of the person claiming to be proprietor, together with his place of abode or business, or other place of address, or the style or title of the firm

under which he may be trading, shall register such design in such manner and form as shall from time to time be prescribed or approved by the Board of Trade; and any design so registered shall be deemed "provisionally registered," and the registration thereof shall continue in force for the term of one year from the time of the same being registered as aforesaid; and the said registrar shall certify, under his hand and seal of office, in such form as the said board shall direct or approve, that the design has been provisionally registered, the date of such registration, and the name of the registered proprietor, together with his place of abode or business, or other place of address.

2. That the proprietor of any design which shall have been provisionally registered shall, during the continuance of such registration, have the sole right and property in such design; and the penalties and provisions of the said Designs Act, 1842, for preventing the piracy of designs, shall extend to the acts, matters and things next hereinafter enumerated, as fully as if those penalties and provisions had been re-enacted in this Act, and expressly extended to such acts, matters and things respectively: that is to say,

1. To the application of any provisionally registered design, or any fraudulent imitation thereof, to any article of manufacture, or to any substance.

2. To the publication, sale, or exposure for sale of any article of manufacture or any substance to which any provisionally registered design shall have been applied.

3. That during the continuance of such provisional registration, neither such registration, nor the exhibition or exposure of any design provisionally registered, or of any article to which any such design may have been or be intended to be applied, in any place, whether public or private, in which articles are not sold, or exposed or exhibited for sale, and to which the public are not admitted gratuitously, or in any place which shall have been previously certified by the Board of Trade to be a place of public exhibition within the meaning of this Act, nor the publication of any account or description of any provisionally registered design exhibited or exposed, or intended to be exhibited or exposed, in any such place of exhibition or exposure in any catalogue, paper, newspaper, periodical, or otherwise, shall prevent the proprietor thereof from registering any such design under the said Designs Acts at any time during the continuance of the provisional registration, in the same manner and as fully and effectually as if no such registration, exhibition, exposure or publication had been made: provided that every article to which any such design shall be applied, and which shall be exhibited or exposed by or with the licence or consent of the proprietor of such design, shall have thereon or attached thereto the words "provisionally registered," with the date of registration.

4. That if during the continuance of such provisional registration the proprietor of any design provisionally registered shall sell, expose, or offer for sale any article, substance or thing, to which any such design has been applied, such provisional registration shall be deemed to have been null and void immediately before any such sale, offer or exposure shall have been first made: but nothing herein contained shall be construed to hinder or prevent such proprietor from selling or transferring the right and property in any such design.

5. That the Board of Trade may, by order in writing, with respect to any particular class of designs, or any particular design, extend the period for which any design may be provisionally registered under this Act, for such term, not exceeding the additional term of six months, as to the said Board may seem fit; and whenever any such order shall be made, the same shall be registered in the office for the registration of designs, and during the extended term the protection and benefits conferred by this Act, in case of provisional registration, shall continue as fully as if the original term of one year had not expired.

6. That the registrar of designs, upon application by or on behalf of the proprietor of any sculpture, model, copy or cast, within the protection of the Sculpture Copyright Acts, and upon being furnished with such copy, drawing, print or description, in writing or in print, as in the judgment of the said registrar shall be sufficient to identify the particular sculpture, model, copy or cast, in respect of which registration is desired, and the name of the person claiming to be proprietor, together with his place of abode or business, or other place of address, or the name, style or title of the firm under which he may be trading, shall register such sculpture, model, copy or cast, in such manner and form as shall from time to time be prescribed or approved by the Board of Trade, for the whole or any part of the term during which copyright in such sculpture, model, copy or cast, may or shall exist under the Sculpture Copyright Acts; and whenever any such registration shall be made, the said registrar shall certify under his hand and seal of office, in such form as the said Board shall direct or approve, the fact of such registration, and the date of the same, and the name of the registered proprietor, or the style or title of the firm under which such proprietor may be trading, together with his place of abode or business, or other place of address.

7. That if any person shall, during the continuance of the copyright in any sculpture, model, copy or cast, which shall have been so registered as aforesaid, make, import, or cause to be made, imported, exposed for sale, or otherwise disposed of, any pirated copy or pirated cast of any such sculpture, model, copy or cast, in such manner and under such circumstances as would entitle the proprietor to a special action on the case under the Sculpture Copyright Acts, the person so offending shall forfeit for every such offence a sum not less than five pounds and not exceeding thirty pounds, to the proprietor of the sculpture, model, copy or cast, whereof the copyright shall have been infringed; and for the recovery of any such penalty, the proprietor of the sculpture, model, copy or cast, which shall have been so pirated, shall have and be entitled to the same remedies as are provided for the recovery of penalties incurred under the Designs Act, 1842: provided always, that the proprietor of any sculpture, model, copy or cast, which shall be registered under this Act, shall not be entitled to the benefit of this Act, unless every copy or cast of such sculpture, model, copy or cast, which shall be published by him after such registration shall be marked with the word "registered," and with the date of registration.

8. That designs for the ornamenting of ivory, bone, papier maché, and other solid substances not already comprised in the classes numbered 1, 2 or 3, in the Designs Act, 1842, shall be deemed and

taken to be comprised within the class numbered 4 in that Act, and such designs shall be so registered accordingly.

9. That the Board of Trade may from time to time order that the copyright of any class of designs, or any particular design registered, or which may be registered under the Designs Act, 1842, may be extended for such term, not exceeding the additional term of three years, as the said Board may think fit, and the said Board shall have power to revoke or alter any such order as may from time to time appear necessary; and whenever any order shall be made by the said Board under this provision, the same shall be registered in the office for the registration of designs; and during the extended term the protection and benefits conferred by the said Designs Acts shall continue as fully as if the original term had not expired.

10. That the Board of Trade may from time to time make, alter and revoke rules and regulations with respect to the mode of registration, and the documents and other matters and particulars to be furnished by persons effecting registration and provisional registration under the said Acts and this Act: provided always, that all such rules and regulations shall be published in the "London Gazette," and shall forthwith, upon the issuing thereof, be laid before Parliament, if Parliament be sitting; and if Parliament be not sitting, then within fourteen days after the commencement of the then next session; and such rules and regulations, or any of them, shall be published or notified by the registrar of designs, in such other manner as the Board of Trade shall think fit to direct.

11. That if, in any case in which the registration of a design is required to be made under either of the said Designs Acts, it shall appear to the registrar that copies, drawings or prints, as required by those Acts, cannot be furnished, or that it is unreasonable or unnecessary to require the same, the said registrar may dispense with such copies, drawings or prints, and may allow in lieu thereof such specification or description in writing or in print as may be sufficient to identify and render intelligible the design in respect of which registration is desired; and whenever registration shall be so made in the absence of such copies, drawings or prints, the registration shall be as valid and effectual, to all intents and purposes, as if such copies, drawings or prints had been furnished.

12. That, in order to prevent the frequent and unnecessary removal of the public books and documents in the office for the registration of designs, no book or document in the said office shall be removed for the purpose of being produced in any court, or before any justice of the peace, without a special order of a judge of the Court of Chancery, or one of her Majesty's superior courts of law, first had and obtained by the party who shall desire the production of the same.

13. That if application shall be made to a judge of any of her Majesty's courts of law at Westminster, by any person desiring to obtain a copy of any registration, entry, drawing, print or document, of which such person is not entitled as of right to have a copy, for the purpose of being used in evidence in any cause, or otherwise howsoever, and if such judge shall be satisfied that such copy is bona fide intended for such purpose as aforesaid, such judge shall order the registrar of designs to deliver such copy to the party applying, and

the registrar of designs shall, upon payment for the same of such fee or fees as may be fixed according to the provisions of the said Designs Acts in this behalf, deliver such copy accordingly.

14. That every copy of any registration, entry, drawing, print or document, delivered by the registrar of designs to any person requiring the same, shall be signed by the said registrar, and sealed with his seal of office; and every document sealed with the said seal, purporting to be a copy of any registration, entry, drawing, print or document, shall be deemed to be a true copy of such registration, entry, drawing, print or document, and shall, without further proof, be received in evidence before all Courts, in like manner, and to the same extent and effect, as the original book, registration, entry, drawing, print or document would or might be received if tendered in evidence, as well for the purpose of proving the contents, purport and effect of such book, registration, entry, drawing, print or document, as also proving the same to be a book, registration, entry, drawing, print or document of or belonging to the said office, and in the custody of the registrar of designs.

15. That the several provisions contained in the said Designs Acts (so far as they are not repugnant to the provisions of this Act), relating to the transfer of designs, to cancelling and amending registration, to the refusal of registration in certain cases, to the mode of recovering penalties, to the awarding and recovery of costs, to actions for damages, to the limitation of actions, to the certificate of registration, to penalties for wrongfully using marks, to the fixing and application of fees for registration and to the penalty for extortion, shall apply to the registration, provisional registration, and transfer of designs, sculptures, models, copies and casts, and to the designs, sculptures, models, copies and casts entitled to protection under this Act, and to matters under this Act, as fully and effectually as if those provisions had been re-enacted in this Act with respect to designs, sculptures, models, copies and casts registered and provisionally registered under this Act; and the forms contained in the Designs Act, 1842, may for the purposes of this Act be varied so as to meet the circumstances of the case.

16. That in the interpretation of this Act the following terms and expressions shall have the meanings hereinafter assigned to them, unless such meanings shall be repugnant to or inconsistent with the context or subject-matter; that is to say,

The expression "Designs Act, 1842," shall mean an Act passed in the sixth year of the reign of her present Majesty, intituled "An Act to consolidate and amend the Laws relating to the Copyright of Designs for ornamenting Articles of Manufacture:"

The expression "Designs Act, 1843," shall mean an Act passed in the seventh year of her present Majesty, intituled "An Act to amend the Laws relating to the Copyright of Designs:"

The expression "Sculpture Copyright Acts" shall mean two Acts passed respectively in the thirty-eighth and fifty-fourth years of the reign of King George the Third, and intituled respectively "An Act for encouraging the Art of making new Models and Casts of Busts and other Things herein mentioned," and "An Act to amend and render more effectual an Act for encouraging the Art of making new Models and Casts of Busts and other Things therein mentioned:"

The expression "the Board of Trade" shall mean the Lords of the Committee of Privy Council, for the consideration of all matters of trade and plantations:

The expression "registrar of designs" shall mean the registrar or assistant registrar of designs for articles of manufacture:

The expression "proprietor" shall be construed according to the interpretation of that word in the said Designs Act, 1842:

And words in the singular number shall include the plural, and words applicable to males shall include females.

17. That in citing this Act in other Acts of Parliament, and in any instrument, document or proceeding, it shall be sufficient to use the words and figures following, that is to say, "The Designs Act, 1850."

## DESIGNS ACT, 1858.

21 & 22 VICT. c. 70.

*An Act to amend the Act of the Fifth and Sixth Years of Her present Majesty, to consolidate and amend the Laws relating to the Copyright of Designs for ornamenting Articles of Manufacture.*

[2nd August, 1858.]

WHEREAS by an Act passed in the fifth and sixth years of the reign of her present Majesty, intituled "An Act to consolidate and amend the Laws relating to the Copyright of Designs for ornamenting Articles of Manufacture," hereinafter called "The Copyright of Designs Act, 1842," there was granted to the proprietor of any new and original design in respect of the application of any such design to ornamenting any article of manufacture contained in the tenth class therein mentioned, with the exceptions therein mentioned, the sole right to apply the same to any articles of manufacture, or any such substances as therein mentioned, for the term of nine calendar months, to be computed from the time of such design being registered according to the said Act: and whereas it is expedient that the term of copyright, in respect of the application of designs to the ornamenting of articles of manufacture comprised in the said tenth class, should be extended, and that some of the provisions of the said Act should be altered, and that further provision should be made for the prevention of piracy, and for the protection of copyright in designs under the Acts in the schedule hereto annexed, and hereinafter called "The Copyright of Designs Acts:" Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows; that is to say,

1. In citing this Act for any purpose whatsoever it shall be sufficient to use the expression "The Copyright of Designs Act, 1858."



2. The said Copyright of Designs Acts and this Act shall be construed together as one Act.

3. In respect of the application of any new and original design for ornamenting any article of manufacture contained in the tenth class mentioned in "The Copyright of Designs Act, 1842," the term of copyright shall be three years, to be computed from the time of such design being registered, in pursuance of the provisions of "The Copyright of Designs Acts," and of this Act: provided nevertheless, that the term of such copyright shall expire on the thirty-first of December in the second year after the year in which such design was registered, whatever may be the day of such registration.

4. Nothing in the fourth section of "The Copyright of Designs Act, 1842," shall extend or be construed to extend to deprive the proprietor of any new and original design applied to ornamenting any article of manufacture contained in the said tenth class of the benefits of "The Copyright of Designs Acts," or of this Act: provided there shall have been printed on such articles at each end of the original piece thereof the name and address of such proprietor, and the word "registered," together with the years for which such design was registered.

5. And be it declared, that the registration of any pattern or portion of an article of manufacture to which a design is applied, instead or in lieu of a copy, drawing, print, specification, or description in writing, shall be as valid and effectual to all intents and purposes as if such copy, drawing, print, specification, or description in writing had been furnished to the registrar under "The Copyright of Designs Acts."

6. The proprietor of such extended copyright shall, on application by or on behalf of any person producing or vending any article of manufacture so marked, give the number and the date of the registration of any article of manufacture so marked; and any proprietor so applied to who shall not give the number and date of such registration shall be subject to a penalty of ten pounds, to be recovered by the applicant, with full costs of suit, in any Court of competent jurisdiction.

7. Any person who shall wilfully apply any mark of registration to any article of manufacture in respect whereof the application of the design thereto shall not have been registered, or after the term of copyright shall have expired, or who shall, during the term of copyright, without the authority of the proprietor of any registered design, wilfully apply the mark printed on the piece of any article of manufacture, or who shall knowingly sell or issue any article of manufacture to which such mark has been wilfully and without due authority applied, shall be subject to a penalty of ten pounds, to be recovered by the proprietor of such design, with full costs of suit, in any court of competent jurisdiction.

8. Notwithstanding anything in "The Copyright of Designs Acts," it shall be lawful for the proprietor of copyright in any design under "The Copyright of Designs Acts," or this Act, to institute proceedings in the County Court of the district within which the piracy is alleged to have been committed, for the recovery of damages which he may have sustained by reason of such piracy: provided always, that in any such proceedings the plaintiff shall deliver with his plaint a statement of particulars as to the date and title or other description of the

registration whereof the copyright is alleged to be pirated, and as to the alleged piracy; and the defendant, if he intends at the trial to rely as a defence on any objection to such copyright, or to the title of the proprietor therein, shall give notice in the manner provided in the seventy-sixth section of the Act of the ninth and tenth Victoria, Chapter ninety-five, of his intention to rely on such special defence, and shall state in such notice the date of publication and other particulars of any designs whereof prior publication is alleged, or of any objection to such copyright, or to the title of the proprietor to such copyright; and it shall be lawful for the judge of the County Court, at the instance of the defendant or plaintiff respectively, to require any statement or notice so delivered by the plaintiff or by the defendant respectively to be amended in such manner as the said judge may think fit.

9. The provisions of an Act of the ninth and tenth Victoria, Chapter ninety-five, and of the twelfth and thirteenth Victoria, Chapter one hundred, as to proceedings in any plaint, and as to appeal, and as to writs of prohibition, shall so far as they are not inconsistent with or repugnant to the provisions of this Act, be applicable to any proceedings for piracy of copyright of designs under the said Copyright of Designs Act or this Act.

#### SCHEDULE referred to in the foregoing Act.

5 & 6 Vict. c. 100 . . . [10 Aug. 1842.]	An Act to consolidate and amend the Laws relating to the Copyright of Designs for ornamenting Articles of Manufacture.
6 & 7 Vict. c. 65 . . . [22 Aug. 1843.]	An Act to amend the Laws relating to the Copyright of Designs.
13 & 14 Vict. c. 101 . . [14 Aug. 1850.]	An Act to extend and amend the Acts relating to the Copyright of Designs.
14 Vict. c. 8 . . . . . [11 April, 1851.]	An Act to extend the provisions of the Designs Act, 1850, and to give Protection from Piracy to Persons exhibiting new Inventions in the Exhibition of the Works of Industry of all Nations in One thousand eight hundred and fifty-one.

#### DESIGNS ACT, 1861.

24 & 25 VICT. c. 73.

*An Act to amend the Law relating to the Copyright of Designs.*

[6th August, 1861.]

WHEREAS by an Act passed in the session holden in the fifth and sixth years of the reign of her present Majesty, Chapter one hundred, intituled "An Act to consolidate and amend the Laws relating to the Copyright of Designs for ornamenting Articles of Manufacture," it was enacted, that the proprietor of every such design as therein

mentioned, not previously published either within the United Kingdom of Great Britain and Ireland or elsewhere, should have the sole right to apply the same to any articles of manufacture, or to any such substances as therein mentioned, provided the same were done within the United Kingdom of Great Britain and Ireland, for the respective terms therein mentioned, and should have such copyright in such designs as therein provided: And whereas divers Acts have since been passed extending or amending the said recited Acts: And whereas it is expedient that the provisions of the said recited Act, and of all Acts extending or amending the same, should apply to designs, and to the application of such designs, within the meaning of the said Acts, whether such application be effected within the United Kingdom or elsewhere: Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

1. That the said recited Act, and all Acts extending or amending the same, shall be construed as if the words "provided the same be done within the United Kingdom of Great Britain and Ireland" had not been contained in the said recited Act: and the said recited Act, and all Acts extending or amending the same, shall apply to every such design as therein referred to, whether the application thereof be done within the United Kingdom or elsewhere, and whether the inventor or proprietor of such design be or be not a subject of Her Majesty.

2. That the said several Acts shall not be construed to apply to the subjects of Her Majesty only.

## INDUSTRIAL EXHIBITIONS ACT, 1865.

28 & 29 VICT. c. 3.

*An Act for the protection of Inventions and Designs exhibited at certain Industrial Exhibitions in the United Kingdom.*

[27th March, 1865.]

WHEREAS exhibitions of objects of Art and Industry manufactured or contributed wholly or in part by members of the industrious classes of her Majesty's subjects have lately been held, and may be from time to time hereafter held, in divers parts of the United Kingdom; and it is expedient to encourage such exhibitions by granting to persons desirous of exhibiting at the same new inventions or new designs such protection as is hereinafter mentioned: Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

1. This Act may be cited as the "Industrial Exhibitions Act, 1865."

2. It shall be lawful for the Lords of the Committee of Her Majesty's Privy Council for Trade and Foreign Plantations, upon the application of any persons desirous of holding any such exhibition as aforesaid in any part of the United Kingdom, to certify, if they shall think fit, that the exhibition so proposed to be held is in their judgment calculated to promote British art and industry, and to prove beneficial to the industrious classes of her Majesty's subjects, either generally or in or near the place where such exhibition is proposed to be held; and every such certificate shall mention the place at which and the time during which such exhibition is proposed to be held; and the time mentioned in any such certificate may afterwards, if the Lords of the said Committee shall so think fit, be enlarged and extended by a further certificate, but so that the whole time allowed and certified for the holding of the same exhibition shall in no case exceed the total period of six months; and every such exhibition so certified, if and so long as the same shall be held at the place and within the time mentioned in any such certificate, shall be deemed to be an Industrial Exhibition entitled to the benefit of this Act.

3. [Relates only to Patents.]

4. The exhibition at any Industrial Exhibition entitled to the benefit of this Act of any new design capable of being registered provisionally under the "Designs Act, 1850," or of any article to which such design is applied, shall not, nor shall the publication during the period of the holding of such exhibition of any description of such design, prejudice the right of any person to register, provisionally or otherwise, such design, or invalidate any provisional or other registration which may be granted for such design.

## DESIGNS ACT, 1875.

35 & 39 VICT. c. 93.

*An Act to amend the Copyright of Designs Acts.*

[13th August, 1875.]

BE it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

1. This Act shall come into operation on the first day of January one thousand eight hundred and seventy-six, which day is in this Act referred to as the commencement of this Act.

2. On and after the commencement of this Act all powers, duties, and authorities vested in, imposed on, or to be exercised by the Board of Trade under the Acts mentioned in the schedule to this Act shall be transferred to, vested in, and imposed on the Commissioners of Patents for Inventions, and the said Acts shall be construed as if the said

Commissioners of Patents were throughout substituted for the Board of Trade or the Lords of the Committee of the Privy Council for the consideration of all matters of trade and plantations.

3. The said Commissioners of Patents may from time to time make, and when made revoke and alter general rules for regulating registration under the Acts mentioned in the schedule hereto, and this Act, and on and after the commencement of this Act any discretion or power vested in the registrar under the said Acts shall be subject to the control of the Commissioners of Patents and shall be exercised by him in such manner and with such limitations and restrictions (if any) as may be prescribed by the said general rules, and any provisions contained in the said Acts as to the copies, drawings, prints, descriptions, information, matters, and particulars to be furnished to the registrar prior to registration, and as to the mode in which registration is to be conducted by the registrar, and generally as to any act or thing to be done by the registrar, may be modified by such general rules in such manner as the said Commissioners of Patents may think expedient.

General rules made in pursuance of this section shall be laid before Parliament within one month after they are made if Parliament be then sitting, or if not within one month after the commencement of the then next session; and if either House of Parliament resolve within one month after such rules have been laid before such House that any of such rules ought not to continue in force, any rule in respect of which such resolution has been passed shall, after the date of such resolution, cease to be of any force, without prejudice nevertheless to the making of any other rule in its place, or to anything done in pursuance of any such rules before the date of such resolution.

4. The office of registrar under the Acts mentioned in the schedule to this Act shall cease to exist as a separate paid office, and the Commissioners of Patents may from time to time make arrangements as to the mode in which and the person or persons by whom the duties of registrar and other duties under the said Acts are to be performed, and may from time to time delegate to any such person or persons all or any of the duties of the registrar, and any person or persons to whom such duties may be delegated shall, in so far as such delegation extends, be deemed to be the registrar within the meaning of the said Acts.

Any arrangement or delegation of duties to the clerk or other officer of the Commissioners of Patents made by the Board of Trade shall be as valid as it would have been if this Act had been passed at the date of such arrangement or delegation, and the same had been made by the Commissioners of Patents.

5. Each of the Acts mentioned in the schedule to this Act may be cited as the Copyright of Designs Act of the year in which it was passed, and the said Acts may, together with this Act, be cited as the Copyright of Designs Acts, 1842 to 1875, and this Act may be cited as the Copyright of Designs Act, 1875.

## SCHEDULE.

## COPYRIGHT OF DESIGNS ACTS.

Session and Chapter.	Title.
5 & 6 Viet. c. 100 . . . [1842.]	An Act to consolidate and amend the Laws relating to the Copyright of Designs for ornamenting Articles of Manufacture.
6 & 7 Viet. c. 65 . . . [1843.]	An Act to amend the Laws relating to the Copyright of Designs.
13 & 14 Viet. c. 104 . . [1850.]	An Act to extend and amend the Acts relating to the Copyright of Designs.
21 & 22 Viet. c. 70 . . [1858.]	An Act to amend the Act of the fifth and sixth years of Her present Majesty to consolidate and amend the Laws relating to the Copyright of Designs for ornamenting Articles of Manufacture.
24 & 25 Viet. c. 73 . . [1861.]	An Act to amend the Law relating to the Copyright of Designs.

## APPENDIX D.

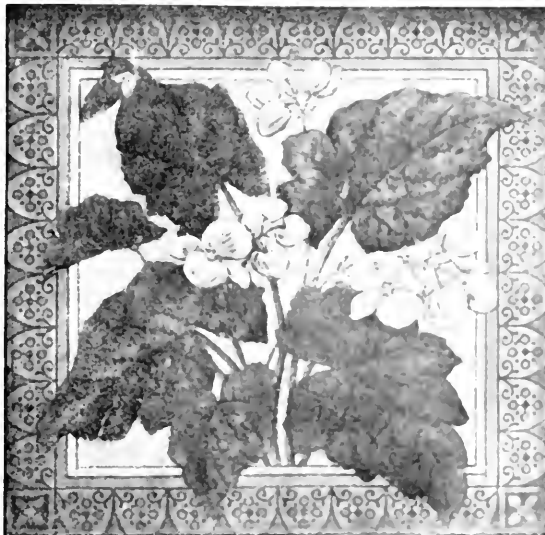


PLAINTIFFS' AND DEFENDANTS' DESIGNS IN THE  
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